

In the Privy Council.

UNIVERSITY OF LONDON
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ON APPEAL

FROM THE HIGH COURT OF AUSTRALIA.

BETWEEN

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

AND

SCRIBAL PROPRIETARY LIMITED (Defendant) *Respondent.*

Case for the Respondent.

RECORD.

10 1. This is an appeal in an action brought in the Supreme Court of Victoria (No. 58 of 1951) for infringement of the Appellant's Letters Patent No. 133,163 from a Judgment of the High Court of Australia (Sir Owen Dixon C.J., Fullagar and Taylor J.J.). By such judgment of the High Court the said letters patent was held to be invalid unless the Appellant gave notice within two months that he desired a new trial upon the issue whether he was in possession of the invention at the date of the original application. The Appellant did give such notice but has now withdrawn it. This case is submitted on the footing that the issue is the validity of the said letters patent. The appeal to the High Court of Australia was from a judgment of Mr. Justice Sholl by which he held 20 the said letters patent invalid. The judgment of the High Court was delivered on 14th September 1954 and the final judgment by Sholl J. was delivered on 28th July 1953. Mr. Justice Sholl also delivered interlocutory judgments in the action on the 15th and 22nd June 1953. The action was heard concurrently with an action by the Plaintiff for infringement of his patent 122,073, which patent Sholl J. and the High Court have held was not infringed by the Respondent. There is no appeal in relation to the alleged infringement of Letters Patent 122,073.

30 2. The application for Letters Patent 133,163 was made by the Appellant on 31st December 1943. In his application the Appellant declared that he was the assignee of Laszlo Josef Biro the actual inventor of the invention and that "I am in possession of the said invention." Together with that application the Appellant filed at the Patent Office a complete specification accompanied by drawings, which described and ascertained the invention claimed. The action was commenced by Writ issued 24th January 1951 and in the Particulars of Breaches the Appellant complained of the manufacture by the Respondent of writing instruments

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known as the "Scribal Secretary Pen" made between the 19th February 1948 and the date of the Writ, and also complained of the sale by the Respondent of such pens. The Respondent denied infringement and contended that the patent was invalid for the reasons set out in the Particulars of Objections. Mr. Justice Sholl held that the patent was not infringed and also that it was invalid for ambiguity. The Respondent does not in this appeal seek to support the finding that the patent was not infringed.

ISSUES ON THIS APPEAL

3. In this appeal the Respondent contends that the Letters Patent 10 is invalid upon the grounds set out in their amended Particulars of Objections paragraphs 3, 4, 5 and 6 which are as follows, omitting certain allegations of prior claiming which were abandoned at the hearing:—

"(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.

(4) (i) On the 8th day of December 1943 the Plaintiff made an application for a patent accompanied by a Complete Specification 20 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 122,073 was made.

Vol. II, pp. 247, 249.

(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 further specified in the said complete specification, and after the happening of the events hereinafter 30 set forth Australian Letters Patent Numbered 133,163 were purported to be granted on the said application.

(iii) The Complete Specification of Australian Letters Patent Numbered 122,073 was published on the 5th day of September 1946.

(iiiA) The unamended Complete Specification of United Kingdom Letters Patent Numbered 573,747 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.

Vol. II, p. 291.

(iv) On or about the 18th day of December 1946 the Plaintiff 40 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 the invention something which was not the invention described and claimed in the Complete Specification previously lodged on the 31st December

1943 as aforesaid but something substantially different therefrom which 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.

10 (v) On the 19th day of February 1948 the Complete Specification 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 December 1943 as aforesaid but something substantially different therefrom which was not new by reason of the matters alleged in sub-paragraph (iii) hereof.

Vol. II, pp. 291-306.

(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 31st December 1943, and on the said 14th June 1949 the Deputy Commissioner of Patents purported to accept the Complete Specification in respect of the said Australian Letters Patent Numbered 133,163, which purported acceptance was advertised in the Australian Official Journal of Patents Trade Marks and Designs on 30th June 1949.

30 (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 Defendants or any other member of the public.

40 (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* contrary to law invalid and of no effect, and no grant of Australian Letters Patent Numbered 133,163 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 31st 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.

(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 (if any) the subject matter of the Letters Patent ultimately granted.”

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Vol. I, pp. 99-101.

The matters set out above in paragraph 4 of these Particulars of Objections are not in dispute with the exception of (iv) (ivA) (vi) (ix) and (x). As to (iv) and (ivA), it is not disputed that the Plaintiff lodged at the Patent Office a specification on the 18th December 1946 which was in substance the same as the specification of United Kingdom Letters Patent 573,747 which had become available for inspection in Australia on 29th May 1946. It is further not disputed that that specification as lodged on 18th December 1946 was in many respects different from that accompanying the original application, but the extent of these differences will be dealt with later.

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THE PATENTS ACT.

4. The issues involved in this Appeal require a consideration of a number of sections of the Patents Act 1903-1946 of the Commonwealth of Australia. This Act is divided into four parts and only Part IV is material in this Appeal. Part IV is divided into seven divisions of which Division 1 is concerned with applications for patents. The following are the material sections, omitting immaterial words :—

“ 33.—(1) An application for a Patent shall be for one invention only, and must be accompanied by either a provisional specification or a complete specification.

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(2) The application must contain a declaration in the form prescribed setting out the facts relied on to support the application and must be signed by the applicant and attested by a witness.

(3) Subject to this Act, the application shall date from the time when it is lodged in the Patent Office.

36. A complete specification must fully describe and ascertain the invention and the manner in which it is to be performed, and must end with a distinct statement of the invention claimed.

38A. (1) After a complete specification has been lodged, the Commissioner shall publish in The Australian Official Journal of Patents Trade Marks and Designs a notification that the complete specification is open to public inspection and thereupon the application, complete specification and provisional specification (if any) shall be open to public inspection.

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(2) When a complete specification has become open to public inspection in pursuance of the last preceding subsection it shall be deemed to have been published.

41. In the case of all complete specifications the examiner shall also—

(A) Ascertain and report whether to the best of his knowledge 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 ;

(B) Report whether to the best of his knowledge the invention is or is not novel.

10 45. If the examiner reports adversely to the Complete Specification the applicant shall be informed thereof and the applicant may within such time as may be prescribed amend the specification, and the amended specification shall be again reported on by the examiner under Section 41.

20 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 he shall in the absence of any other lawful ground of objection 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.

30 54. After the publication of a complete specification and until the date of sealing a patent in respect thereof or the expiration of the time for sealing the applicant shall have 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 : Provided that an applicant shall not be entitled to institute any proceedings for infringement unless and until a patent for the invention has been granted to him."

MATTERS OF COMMON GROUND.

40 5. It is common ground that the lodging at the Patent Office by the Appellant of his " amended " specification and other " amendments " was in purported pursuance of Section 45 and not under those sections grouped together in Division 4 of Part IV of the Act. Under Section 71 of Division 4 an applicant or a patentee may by request in writing left at the Patent Office seek leave to amend his complete specification by way of disclaimer correction or explanation, stating the nature of the amendment and the reasons for it. There are provisions for appeal to the High Court or the Supreme Court and every amendment of the specification has to be advertised in the prescribed manner. By Section 79 it is enacted that leave to amend shall be conclusive as to the right of the party to make the amendment allowed except in the case of fraud and the amendment

shall in all Courts and for all purposes be deemed to form part of the specification. However Section 79 only applies to amendments made under Division 4 and has no application to this appeal. There is no corresponding provision in Division 1.

6. It seems to be common ground that a valid patent cannot be obtained for an invention which is not in the possession of the applicant when he makes his application. It seems also to be common ground that a valid patent cannot be obtained for an invention not disclosed by the applicant at the date of his application. The Appellant's Counsel in the High Court of Australia on the 10th March 1954 put the matter as follows :— 10

“ My friend seeks to get my concession and that of my predecessor out of the circumstances that it was conceded—and it is conceded that of course the scheme of the Act does not contemplate that a man shall get a grant for an invention he has not got when he makes his application.

It is conceded that the scheme of the Act does not contemplate that he will get a grant for an invention he does not disclose at the date of his application, but from that it does not follow that in this limited area of amendment that Section 45 has to be qualified 20 in some way as to the nature of the amendments which it authorises.

Let it be supposed that an applicant, having made an application for a bicycle, subsequently after an adverse report, makes an amendment which converts it into a tricycle, if that is a sufficiently different instrument for these purposes, and let me suppose that the Commissioner accepts the amended specification.

That grantee is subject to attack not because of the amendment he made but because he did not have the invention at the time of his application or because he did not disclose it at the time of his application. His amendment is good and the acceptance of it is 30 good in our submission. But it may be that on an examination of a wider and different question it is found that in reality he did not have the invention so in reality he did not disclose it at the time of his application.

The Court remembers that is why I said that 5 and 6 I suppose in one sense—as defences in this matter—are not concerned with the activities in the Office. That, of course, if I may so say with respect, is a much more satisfactory way in which those sorts of questions can be litigated than to throw open for examination in the Courts not merely the question of amendments, but, take the very last 40 point my friend takes, the question of the responsiveness of some amendment.

Can one imagine that suits hereafter are going to involve inquiry, just by what standards you could do it I do not know, that the amendment was not responsive.

So that arising out of what I have attempted to say in relation to Division 1 is this :—

Section 45 gives a right to amend, as it were, at the applicant's own risk. He goes and he makes an amendment. After that, the Commissioner does not trouble about it as an amendment *per se*. He then looks at the new document—the amended specification—and he decides whether he will accept the amended specification or not. If the grant that follows is for a patent that at the time of application was not disclosed, it will resolve in invalidity of the grant, but not because of what took place in the Office.

Of course, it is still conceivable that what took place in the Office, if you can evidence it, might afford some evidence for the proving of the other issue.”

7. Accordingly upon the footing of what is common ground the questions for determination in this appeal are as follows :—

(1) Was the Appellant in possession of the invention claimed in the specification of patent 133,163 as finally accepted at the date of his application 27th November 1943 ?

(2) Was the invention claimed in the specification of patent 133,163 as finally accepted disclosed in the complete specification which accompanied the application ?

RESPONDENT'S CONTENTIONS.

8. The contentions of the Respondent are as follows : —

(1) That the answer to the first question set out in paragraph 7 is in the negative and that accordingly the patent ought not to have been granted and is invalid. This was the judgment of the High Court which the Respondent submits is correct.

(2) That the answer to the second question set out in paragraph 7 is in the negative and that accordingly the patent ought not to have been granted and is invalid. This was not considered by Dixon C.J. or Fullagar J. but Taylor J. expressed the view that the contention was not open to the Respondent because of the Commissioner's acceptance of the amended specification. The Respondent submits that this is not so.

(3) That the letters patent is invalid because the amendments made by the Appellant to the specification originally lodged were unlawful and the acceptance by the Commissioner of the amended specification does not preclude reliance upon the unlawfulness of the amendments. Sholl J. decided that acceptance did not preclude reliance upon unlawful amendments but the High Court, wrongly as the Respondent submits, decided that it did. Sholl J. decided that the amendments were authorised by Section 45. This the Respondent submits was wrong.

(4) That the letters patent is void for ambiguity. Sholl J. so decided but the High Court decided the other way. The Respondent submits that on this point the decision of Sholl J. is to be preferred.

9. The third contention that the "amendments" were not amendments within the scope of Section 45 and that the acceptance of the "application and specification" by the Commissioner under Section 46 does not preclude objection to the unauthorised amendment may be elaborated as follows:—

(A) It is submitted that no amendment is authorised by Section 45 which substantially alters and enlarges the invention originally applied for by the specification accompanying the application. This is derived from the context. The specification which must be filed with the application must define the applicant's invention in the manner prescribed by Section 36 which provides that the specification must "describe ascertain and claim" the invention. The application must be for one invention only (Section 33 (1)). The specification as finally accepted must be a specification which defines the invention originally defined and accordingly no amendment of an original specification is permissible which has the result of substituting for the invention there defined another and a larger invention. It is submitted that Section 45 does not permit an amendment of such a kind that the amended specification claims an invention which is wider than and substantially different from the invention originally described in the specification accompanying the application. 10

(B) In the present case the specification which was published in accordance with Section 38 (A) was the complete specification as originally lodged. Accordingly under Section 54 of the Patents Act the Appellant obtained 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. The purpose of publication of the specification is so that members of the public may be able to read that specification and the claims and can thereafter cease from carrying on an infringing manufacture. The legislature could not have envisaged the possibility that an applicant could enlarge the scope of his claims so that the patent as finally granted would include within it articles not falling within the claims of the specification as published. If such were to be possible, then a manufacturer, who had read the published specification and had ascertained that his manufacture did not fall within any of its claims, might continue with his manufacture only to find subsequently that an amendment had been permitted by the Commissioner which rendered his manufacture an infringement. This position would not arise if an applicant is not permitted to make an amendment under Section 45 which enlarges and substantially changes the scope of the invention for which he claims the monopoly. 30 40

(C) In the present case the complete specification as originally lodged was published on 19th February 1948 and the Plaintiffs

have sued in respect of manufacture by the Respondent as from 19th February 1948. The manufacture by the Respondent was not an infringement and could not be alleged to be an infringement of any of the claims of the complete specification as so published. It was not until 14th June 1949 that the Commissioner of Patents accepted the complete specification in its final form which contained claims of such a character that the Defendant's construction was an infringement.

10 (D) If an application for letters patent accompanied by specification in the form in which it was finally amended had been made on the 18th December 1946, the day on which the amended specification was lodged, no valid patent could have been granted because the complete specification of United Kingdom Letters Patent 573,747 had become available for public inspection in the Patent Office Library Canberra on 29th May 1946 and because as early as 5th September 1946 the Respondent had manufactured pens the same as those which are alleged as the infringements. It is not consistent with the scheme of the Patents Act that a power of amendment would have been conferred that would in such circumstances enable the applicant to obtain a patent pre-dating both dates.

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10. The above contentions (1) (2) and (3) of paragraph 8 depend upon an examination of (A) the specification as originally filed and (B) the specification as finally accepted. So far as the issue is concerned, viz. : whether the Plaintiff was in possession of the invention the subject of the specification as accepted at the date of the first application, the Appellant has elected not to seek to establish this point affirmatively by evidence. Accordingly this issue has to be decided by an examination of the specifications and amendments lodged at the Patent Office by the

30 Appellant.

SPECIFICATION AS ORIGINALLY FILED.

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260.

11. It is submitted that the specification as originally filed is limited to an invention in which there is an ink reservoir which consists of a series or group of duct sections communicating one with the other so as to form a duct extending from an inlet open to the air to the feed channel of the writing point with the air intake positioned to project towards the writing point of the pen. It is submitted that it would be the antithesis of this invention to have the ink reservoir consisting of one duct section only whose length did not exceed that of the holder with the air intake projecting

40 away from the writing point. The specification as originally lodged commenced with a general statement of the invention 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, which should duly be taken into account when considering the further development of the industry.

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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.

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. 10

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 the said sections are longitudinal and preferably parallel to the axis of the pen, the whole of the sections will be of a length several times that of the holder. 20

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. 30

Besides the objects above stated, this invention also has other aims in view, among which it is to be noted 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 fountain pen.

A further object consists in simplifying the construction of the instrument by arranging the ink reservoir as a channel which by forming an extension of the feed duct for the stylographic ball or point, will constitute the longitudinal sections by simply bending or folding the same into a block. 40

Another object tends to secure a simple arrangement of the reservoir, by the provision of simple boring designed to form the ducts which communicate in series, one a continuation of the other.

A further object of the invention consists in using the very material of the holder of the pen as a basis in which to provide the channels or longitudinal sections which form the ink reservoir.

A still further object consists in preventing gravitation from influencing the reversed position of the instrument, for which purpose the end of the air intake of the duct is positioned to project toward the writing point of the pen."

The specification then describes the preferred embodiments, in which the reservoir consists of a number of ducts folded backwards and forwards with respect to one another and extending longitudinally of the holder with the air intake positioned towards the writing point. In some of the figures the reservoir consists of a tube and in others of a duct bored within
 10 the holder. The specification ends with 11 claims of which the first claim is in the broadest scope and is as follows:—

" 1. Fountain pen, of the type in which the ink reservoir is an extension duct of the feed channel for the stylographic point, characterised 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."

Vol. II, p. 253.

Mr. Justice Sholl who, in the interlocutory judgment of the 22nd June,
 20 decided that, although the power to amend conferred by Section 45 did not authorise the substitution of a specification claiming an invention substantially different from that described and disclosed in the specification originally lodged, the amendments made were within the scope of Section 45, relied especially on Claim 11 which is as follows:—

" 11. 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."

Vol. II, p. 255.

12. It is submitted that the invention disclosed in this specification and claimed in each claim was one concerned with having a reservoir consisting of a number of sections of duct so disposed in the holder that their total length would be several times that of the holder. It is submitted that it would be the antithesis of the invention disclosed in this specification to have as the reservoir a straight duct of a length not more than and
 40 possibly less than that of the holder. The Respondent sold in Australia between 5th September 1946 and 9th May 1947 pens having a ball point and a straight capillary tube reservoir of a length less than that of the holder, and the Appellants complain in this action that such a pen with such a reservoir is an infringement of the claims of the specification of patent 133,163 in its final form.

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 II. 30-34.

SPECIFICATION AS ACCEPTED.

13. The specification of patent 133,163 in its final form was drafted so as to include within the monopoly claimed a straight capillary tube reservoir of a length less than the length of the holder. The six figures of the drawings of the final specification were the same as the first six drawings accompanying the specification which was lodged with the application. But the description in the specification of the invention and the claims were entirely different. The general statement of the invention was as follows :—

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“ This invention relates to writing instruments of the type 10 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 present invention is to improve the construction of instruments of the aforesaid type. According to this invention, I provide an instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in 20 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 expression a vented tube of capillary size is employed herein 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 30 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.

The tube 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 term tube as used herein where the context so permits includes a tube like duct formed in a 40 body.”

The specification then contains a description of the drawings and ends with nine claims of which the first is the broadest in scope and is as follows :—

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“ 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 area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir.” 50

CONCLUSION TO BE DRAWN.

14. The specification as finally accepted accordingly included within the invention for which a monopoly was claimed a straight reservoir of length less than that of the holder, which construction was not disclosed in the original specification and indeed was plainly not included or intended to be included within the original invention. It is submitted that the proper inference to be drawn in all the circumstances of this case is that the Appellant was not in possession at the date of his application of the invention claimed by the claims of his final specification. It is also submitted
 10 that the specification originally lodged did not disclose or define the invention disclosed and defined by the specification as finally accepted. It is submitted therefore that on either of these grounds the patent is invalid. It is also submitted that the invention described by the specification as accepted is substantially larger than and different from that defined by the specification originally lodged.

EFFECT OF ACCEPTANCE OF SPECIFICATION.

15. If the Respondent's contention that the invention defined by the specification as accepted is substantially larger and different from that defined by the specification originally lodged is correct and the Respon-
 20 dent's further contention as set out in paragraph 9 above as to the limits of the power under Section 45 to amend is also accepted then it follows that, unless the Commissioner's acceptance of the amended specification precludes objection to the amendments, they were unlawfully made and the letters patent granted upon the amended specification is invalid. As to the effect of the Commissioner's acceptance of the specification as amended there was a difference between Sholl J. and the High Court. Sholl J. decided that acceptance did not preclude reliance by the Respon-
 30 dent upon the Appellant's unauthorised amendments. It is the contention of the Respondent that the view of Sholl J. should be preferred for the following reasons :—

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121.

(1) That the Act does not expressly provide that acceptance should preclude objection to unlawful amendments.

(2) That it is well established as Fullagar J. pointed out that,
 in general and in the absence of special provision, acceptance does not preclude an attack on the patent on any ground on which a patent may be held to be invalid.

Vol. I, p. 208,
ll. 29-31.

(3) That it is a mistake to treat the power to amend conferred by Section 45 as a power exercised by or with the leave of the Commissioner. It is a power to be exercised by the applicant at
 40 his own risk.

(4) That the provisions of the Act as to oppositions and the established rule that an unsuccessful opposition does not preclude an attack upon the validity of a patent indicate that what happens in the course of the passage of the application through the Patents Office does not preclude a challenge to its validity when granted.

(5) That the Commissioner in accepting a specification amended or otherwise is performing an administrative function.

(6) That there is not in Division 1 any provision corresponding to Section 79 in Division 4 to preclude an attack after acceptance upon amendments made under Section 45 and there is established authority that in the absence of a provision such as Section 79 amendment may be challenged even if made with leave.

AMBIGUITY.

16. Sholl J. decided that the patent was void for ambiguity but the High Court decided otherwise. The Respondent submits that the claims are ambiguous particularly with reference to the positions of the "ink reservoir" the "feed duct" and the "ball" in relation to one another and the dimensions of that part of the "feed duct" or "reservoir," whichever it may be, adjacent to the "ball." 10

JUDGMENTS IN COURTS BELOW.

17. Dixon C.J. accepted the argument for the Appellant as set out above in paragraph 6 and rejected, wrongly as the Respondent submits, the Respondent's contentions set out in paragraphs 8 (3) and 9 hereof relating to the authority to amend conferred by Section 45:—

"There is in my opinion no sufficient justification for introducing into Section 45 an implication restricting the scope of amendments that can be made thereunder so as to make an amendment in excess of the restrictions 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. 20

Section 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 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 recognised ground for avoiding a patent although one that can rarely arise." 30

It is submitted for reasons already stated that Dixon C.J. should not have regarded the course of amendment as ceasing to have any importance after acceptance.

It is further submitted that Dixon C.J. ought in the above passage to have taken into account the alternative included in the argument for the Appellant set out in paragraph 6 that a patent would be invalid if the invention finally claimed was not disclosed in the first application. It is possible that Dixon C.J. did not refer to this alternative because in the circumstances of the appeal it appeared to him that there was little 40

difference between the two alternatives, as the Appellant had not adduced any evidence to show that in fact he was in possession of the invention at the date of his original application. After comparing the specifications as first lodged and as finally accepted, Dixon C.J. came to the following conclusion :—

10 “ 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 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. 133,163 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. 133,163. But it 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 (*sic*) 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 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 6th 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 question of what this Court should do.”

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Vol. I, p. 191,
ll. 17-40.

The Respondent submits that this is correct but that Dixon C.J. should have further come to the conclusion that, as the invention as finally claimed was not disclosed in the Appellant's specification as first lodged, therefore the patent was invalid on that ground too.

18. In the High Court, Fullagar J. came to the same conclusion that the defence that the Appellant was not in possession of the invention had been made out and resulted in invalidity of the letters patent as follows :—

40 “ 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 3 years before.”

Vol. I, p. 206,
ll. 18-25.

Fullagar J. then proceeded to examine what had taken place at the Patent Office and concluded as follows :—

Vol. I, p. 207,
ll. 15-30.

“ 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 (3 years after 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 10 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 7 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 was the essence of the invention described in the original specification. The truth is also that the 20 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.” 30

Fullagar J. then decided, wrongly in the Respondent’s submission, that the Respondent’s contentions as set out in paragraphs 8 (3) and 9 above relating to the authority to amend conferred by Section 45 were incorrect. He concluded his judgment as follows :—

Vol. I, p. 208,
l. 29-p. 209, l. 30.

“ Clearly however—and this brings us to the final argument for the Respondent—acceptance does not preclude an attack upon 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 40 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 50

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 had 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 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.

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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."

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The Respondent relies upon this statement, but, as in the case of the judgment of Dixon C.J., submits that Fullagar J. should have further held the patent to be invalid upon the grounds that the invention as finally claimed was not disclosed in the specification which accompanied the application and that the amendments were not authorised by the Act. The Respondent also submits that both Dixon C.J. and Fullagar J. ought to have held the patent invalid upon the ground of ambiguity.

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19. Taylor J. held that under Section 46 of the Patents Act the Commissioner had a discretion to refuse or to accept a specification and that it was not suggested that he had not used his discretion bona fide. He therefore concluded (wrongly in the submission of the Respondent) that the propriety of the amendments could not now be criticised.

It is submitted that although the Commissioner accepted the specification bona fide, it does not follow that a person is prevented from submitting that the specification was wrongly amended and as amended and accepted did describe and claim an invention substantially different from that originally described and disclosed.

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Taylor J. also said that the issue raised by paragraphs 5 and 6 of the Particulars of Objection assumed an artificial aspect and held that, having regard to the pleadings :—

"Strictly speaking, the Respondent could not succeed upon it unless it appeared that the specification in its finally amended

Vol. I, p. 222,
l. 34—p. 223, l. 12.

form claimed then as the invention something which was substantially different from the invention described and disclosed by the specification originally lodged. On this view of the matter the primary allegation that the Appellant was not, at the time when the original specification was lodged, in possession of the invention as finally described and disclosed would become immaterial and the only matter of importance would be, in effect, whether the invention finally described and claimed was substantially different from that originally described and disclosed. A conclusion favourable to the Respondent on this point would, of course, be precisely tantamount to holding that the amendments which resulted in the specification in its final form were improperly allowed by the Commissioner and this conclusion, it seems to me is, for the reasons already given, not open to us. 10

What the Defendant really sought to establish on the trial, however, was that the Plaintiff was not, *in fact*, in possession of the patented invention at the time when he made his original application and he sought to do this, in effect by contending that the successive specifications described two different but related inventions and that a close examination of the terms of the original specification tended to show that at the time of the Plaintiff's application he did not appreciate or understand the principle of the second invention. To my mind this represents a doubtful approach to the determination of the question of fact which the Defendant sought to raise and an approach which, were it not for the contrary view held by the majority of the Court, I should be prepared to hold was precluded by the allowance of the amendments in question and the acceptance of the specification in its final form. The matter, however, is by no means free from doubt and I am not prepared to dissent from the Orders proposed in the Plaintiff's appeal and the Defendant's Appeal." 20 30

It is submitted that in this the judgment of Taylor J. is erroneous in that the question of fact, namely whether the Plaintiff was in possession of the invention as finally claimed at the date of the application, could not be decided by whether or not the Commissioner had exercised his discretion properly or otherwise. Furthermore there was not, apart from the acceptance of the specification, any allowance of the amendments by the Commissioner.

20. (A) Sholl J. in the interlocutory judgment of the 15th June, held, wrongly in the Respondent's submission, that it was not open to the Respondent upon the pleadings to allege that the Appellant was not in possession at the date of his application of the invention as finally claimed. The Appellant did not seek to support this finding before the High Court. 40

(B) Sholl J. in the same judgment held, rightly in the Respondent's submission except in so far as he deals with Division 4 amendments which are not material in this appeal :—

“ 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."

(c) Sholl J. in the same judgment held, rightly in the Respondent's submission, that the Commissioner's acceptance of the specification as
10 amended by the Appellant did not preclude reliance by the Respondent upon the unlawfulness of the amendments.

(D) In a further interlocutory judgment delivered on 22nd June 1953 Sholl J. reading the original specification up to page 4 line 12, held as follows :—

" 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." Vol. I, p. 138,
ll. 4-6.

But Sholl J. considered that Claim 11 and a sentence commencing on page 6 line 20 of the original specification raised a possible ambiguity.
20 He found, erroneously in the Respondent's submission, that " all the elements claimed in Claim 1 of the final document are disclosed and referred to " in the original specification. It is submitted that Sholl J. was in error in not deciding that the original specification made it plain that a straight capillary tube reservoir of length not greater than that of the holder was excluded from the original invention. Further there was no suggestion in the specification as originally filed that it was any part of the invention to have the feed duct near the ball of a narrower cross-section than that of the reservoir. Vol. I, p. 139,
ll. 21-22.

(E) Sholl J. in his final judgment held that the letters patent is void
30 for ambiguity.

21. It is submitted that this Appeal should be dismissed for the following among other

REASONS

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- (1) BECAUSE patent 133,163 is invalid for the reason that the Appellant did not possess the invention claimed by the specification as accepted at the date of his application.
 - (2) BECAUSE the said patent is invalid for the reason that its complete specification as accepted claimed a monopoly for an invention which was not disclosed in, but was substantially larger than and different from that the subject of, the specification accompanying the application.
 - (3) BECAUSE the said patent is invalid for the reason that the invention disclosed by the specification accompanying the application, which was that alone possessed

by the Appellant at the date of his application, did not include and was the antithesis of an invention for a reservoir consisting of one straight capillary tube of a length not greater than that of the holder and because the specification as finally accepted claimed a monopoly which included such a reservoir.

- (4) BECAUSE the patent is invalid for the reason that the amendments made were not authorised by and were contrary to the provisions of the Patents Act and the patent ought not to have been granted upon the 10 amended specification.
- (5) BECAUSE acceptance of an amended complete specification by the Commissioner does not preclude an attack upon the lawfulness of the amendments made.
- (6) BECAUSE, if the specification upon which the patent had been granted had been limited to or were to be construed as being limited to the invention as disclosed in and the subject of the original specification, then the Respondent's pen would not infringe.
- (7) BECAUSE the decisions of Dixon C.J. and Fullagar J. 20 were right in so far as they held that the Appellant did not on the evidence possess, at the date of his application for a patent, the invention the subject of his final specification.
- (8) BECAUSE the said patent is invalid for ambiguity.

DOUGLAS I. MENZIES.

GUY ALDOUS.

In the Privy Council.

ON APPEAL

from the High Court of Australia.

BETWEEN

HENRY GEORGE MARTIN

(Plaintiff). . . . *Appellant*

AND

SCRIBAL PROPRIETARY

LIMITED (Defendant) . *Respondent.*

Case for the Respondent.

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