[HIGH COURT OF AUSTRALIA.]

MOORE AND HESKETH . . . . . APPELLANTS;
OPPONENTS,

AND

PHILLIPS . . . . . RESPONDENT.
APPLICANT,

ON APPEAL FROM THE COMMISSIONER OF PATENTS.

H. C. OF A. 1907.

MELBOURNE, *June* 11, 12, 13, 14, 17, 18.

Griffith C.J., Barton, Isaacs and Higgins JJ.

Patent— Application— Opposition— Invention already in possession of public — Description in specification of State patent—Construction of claim—Opportunity for applicant to amend—Claim for combination—Patents Act 1903 (*No.* 21 *of* 1903), *secs.* 56, 78.

An application for letters patent for a method of treating ores, including iron oxide ores, was opposed by the holder of a patent granted in one of the States for a method of treating iron oxide ores. The Court having found on the evidence that the applicant's invention, as described in his specification and claim, had, so far as it applied to iron oxide ores, been described in the specification of the opponent's patent:

Held, that the applicant's invention was "otherwise in the possession of the public" within the meaning of sec. 56 (*f*) of the *Patents Act* 1903, and that a patent should not be granted to the respondent, unless he should within a limited time amend his specification so as to claim any new invention that might be disclosed in his specification.

Although in construing a claim the whole specification must be taken into account, yet the applicant for a patent is not entitled to protection for anything which is not claimed.

Where a patent is sought for a combination of subordinate processes, and also for some of those subordinate processes themselves, the applicant must make it plain that he intends to claim protection, not only for the combination, but also for those subordinate processes.

Clark v. *Adie*, 2 App. Cas., 315, applied.

H. C. OF A. 1907.

MOORE AND HESKETH v. PHILLIPS.

APPEAL from the Commissioner of Patents.

On 4th January 1906, Edwin Phillips applied, under the *Patents Act* 1903, for a patent for a "method of treating ores," and lodged therewith a complete specification.

On 10th April 1906, notice of opposition to the grant of patent was duly given by Montague Moore and Thomas James Heskett. The grounds of opposition were :—

1. That the invention had been patented in each of the States of Australia.

2. That the invention was not novel.

3. That the invention had been described in a book or other printed publication published in the Commonwealth before the date of application or was otherwise in the possession of the public.

The material parts of the applicant's specification and of the specification of the opponents' Queensland patent are sufficiently set out in the judgment of *Griffith* C.J. hereunder.

On the hearing of the opposition, the Commissioner of Patents dismissed the opposition and awarded costs to the applicant.

From this decision the opponents now appealed to the High Court.

Irvine K.C. (with him *Levinson*), for the appellants. The objections to the respondent's patent are taken under paragraphs (*c*), (*e*) and (*f*) of sec. 56 of the *Patents Act* 1903, and are that the invention has been previously patented in Australia, that it is not novel, and that it has been described in a publication published in the Commonwealth, that is to say, in the specification of the appellants' Queensland patent. It is only so far as the respondent's specification and claim relate to iron oxide ores that the objections really go. If the patent is granted as the specification and claim stand, the appellants will be prevented from exercising their patented invention throughout Australia. As to the respondent's claims (1), (4) and (5), they are not novel having regard to the facts. As to those claims the invention has been already patented in Australia because those claims are identical with claims in the appellants' specification. That question depends on a comparison of what the respondent claims

with what the appellants claim. If there is not that identity, then, at any rate, what the respondent claims has been described in the appellants' specification. That questions turns on a comparison of the respondent's claim and the appellants' specification.

[Counsel referred to *Terrell on Patents*, 4th ed., p. 157; *Corrigal* v. *Armstrong, Whitworth & Co. Ltd.* (1); *British Motor Traction Co. Ltd.* v. *Friswell* (2).]

Coldham and *Mann*, for the respondent. The appellants' patent is for a process consisting of a combination of old and well known processes. In that respect it resembles the respondent's claim. Unless it can be said that these two combinations are so alike that no reasonable man could say that they are not identical, the patent should be granted. A patent should not be refused unless the objections are proved beyond possibility of doubt, because irremediable harm is not done by granting it, whereas such damage is done by refusing it: *Tolson's Patent* (3); *In re Russell's Patent* (4); *In re Spence's Patent* (5); *Ex parte Sheffield* (6); *Stubbs' Patent* (7); *Newman's Application* (8); *In re Stuart's Application* (9). The proceedings on an opposition to the grant of a patent are not the same as those in an action for infringement. It was not intended that the examiner, in preparing for a report under sec. 41 (*b*) as to whether an invention is novel, should go into such inquiries as would be made in an action for infringement. The word "novel" in sec. 56 (*e*), is used in the same sense as in sec. 41 (*b*) and refers to user of the invention, and there is no evidence that the respondent's invention had been previously used. Both as to the questions of novelty and prior publication the evidence is not such as to lead to the conclusion that the two combinations of processes are identical. The respondent's combination includes processes not included in the combination of the appellants, and those processes which are common to both are not used in the same order. In construing the claim the whole specification

(1) 22 R.P.C., 268.
(2) 18 R.P.C., 497.
(3) 6 DeG. M. & G., 422.
(4) 2 DeG. & J., 130.
(5) 3 DeG. & J., 523.
(6) L.R. 8 Ch., 237, at p. 240.
(7) Griffin's Pat. Cas., 298.
(8) Griffin's Pat. Off. Rep., 40.
(9) 9 R.P.C., 452.

H. C. OF A. 1907.

MOORE AND HESKETH v. PHILLIPS.

should be read with it. *Westinghouse* v. *Lancashire and Yorkshire Railway Co.* (1); *Terrell on Patents*, 4th ed., p. 31.

[ISAACS J. referred to *Brooks* v. *Lamplugh* (2).]

See also *Arnold* v. *Bradbury* (3); *Edison Bell Phonograph Corporation Ltd.* v. *Smith* (4). The Court may impose conditions on the grant of patent: *In re Todd's Application* (5); *In re Welch's Patent* (6); *Frost on Patent Law*, 3rd ed., vol. II., p. 28.

Irvine K.C. in reply. The question is, has the respondent taken the pith and substance of the appellants' invention: *Clark* v. *Adie* (7).

[GRIFFITH C.J. referred to *Consolidated Car Heating Co.* v. *Came* (8).]

The application should be refused, but leave might be given to the respondent to amend: *Deeley* v. *Perkes* (9).

[Counsel also referred to *Harrison* v. *Anderston Foundry Co.* (10); *Kynoch & Co. Ltd.* v. *Webb* (11); *British United Shoe Machinery Co. Ltd.* v. *Hugh Claughton Ltd.* (12).]

Cur. adv. vult.

GRIFFITH C.J. This is an appeal from a decision of the Commissioner of Patents allowing an application for a patent made by the respondent. The *Patents Act* 1903 provides in sec. 56 that:—"Any person may within three months from the advertisement of the acceptance of a complete specification, or within such further time not exceeding one month as the Commissioner on application made within such three months allows, give notice at the Patent Office of opposition to the grant of the patent" on certain grounds, of which it is only necessary to mention three, viz., "(*c*) That the invention has been patented . . . in a State; (*e*) That the invention is

(1) 1 R.P.C., 229.
(2) 15 R.P.C., 33.
(3) L.R. 6 Ch., 706.
(4) 11 R.P.C., 389, at p. 395.
(5) 9 R.P.C., 487.
(6) 8 R.P.C., 442.
(7) 2 App. Cas., 315.
(8) (1903) A.C., 509.
(9) (1896) A.C., 496; 13 R.P.C., 581.
(10) 1 App. Cas., 574.
(11) 17 R.P.C., 100.
(12) 23 R.P.C., 321, at p. 334; 24 R.P.C., 33.

not novel or has been already in possession of the public with the consent or allowance of the inventor; (*f*) That the invention has been described in a book or other printed publication published in the Commonwealth before the date of the application or is otherwise in the possession of the public." There was some discussion as to the meaning of the words "not novel" in sub-sec. (*e*), having regard to the provision in sub-sec. (*f*) which refers to a state of things under which it might be said that an invention was not novel. It has been held in the United States, where a similar objection that the invention is not novel may be made, that the words "not novel" do not refer to a paper anticipation, but to a thing which is not absolutely new in the ordinary sense of that term. For the present purpose, however, for reasons that will appear, it is not necessary to refer further to the particular terms of sec. 56. The objection which is relied on by the appellants substantially comes within the last words of sub-sec. (*f*), that is, that the invention "is otherwise in the possession of the public." The manner in which the invention is alleged to be in the possession of the public is that the invention has been substantially described by the complete specifications of a patent granted in Queensland on 28th December 1903 to the present appellants. The invention now in question relates to a method of treating sulphide and oxide ores finely divided. There are some facts well known to metallurgists, which appear sufficiently upon the documents before us, and to which it is necessary to refer for the purpose of making the proposed patent and the objections to it intelligible. It is a well known fact that sulphide ores cannot be reduced to metal until the sulphur is got rid of by oxidization, that is, by oxidizing the ore, and for that purpose it is a common thing to subject the ore to what is called an oxidizing atmosphere under conditions of great heat. With respect to oxide ores, it is well known that it is extremely difficult to reduce them to a state of fusion without deoxidizing them, and for that purpose it is a known process to subject the ore to a reducing or deoxidizing atmosphere consisting of carbonic oxide or some hydro-carbon gas, and it is recognized that the greater the heat the more efficacious the reduction will be. For both purposes it is desirable that the ore to be treated should be

H. C. OF A. 1907.

MOORE AND HESKETH v. PHILLIPS.

Griffith C.J.

finely divided, and for obvious reasons. Those being the facts with which we start, the applicant describes his invention as being "for a novel method of treating sulphide ores . . and also oxide ores," and "the method consists essentially in showering the ore, in a finely divided state, downward through a stack, in which it is subjected, while in suspension, to a suitable fusing atmosphere moving in the same direction, then discharging the fused ore from the lower end of the stack into a reverberatory chamber, or forehearth, wherein the molten metal is caused to separate by gravity from the slag." That is the preliminary statement of his invention which the applicant makes in his specification. But in considering whether the invention is already in the possession of the public, it is necessary to ascertain what is the invention which is claimed, and for that we must look to the claim at the end of the complete specification, which, by the Statute, is required to end with a formal definite statement of the applicant's claim. The applicant formulates his claim thus:—"Having now fully described and ascertained my said invention and the manner in which it is performed, I declare that what I claim is:—(1) The process of treating finely divided ore, which consists"—that is, the particular process which he claims consists—"in showering the ore downward in a stack and subjecting it for initial treatment, while in suspension, to a highly heated atmosphere moving in the same direction, and causing the ore thus initially treated to discharge from the stack into a reverberatory chamber wherein the unvolatilized molten metal constituent of the ore is caused to separate by gravity from the slag producing constituents." The second and third claims relate only to sulphide ores, and it is not necessary to refer to them. "(4) The process of treating finely divided iron, lead or copper oxides according to claiming clause (1), characterized by employing, as the highly treated atmosphere supplied to the stack, a reducing atmosphere. (5) The process of treating finely divided ore according to claiming clause (4), characterized by introducing the reduced metallic constituent of the ore, discharged from the stack, into the reverberatory chamber beneath a covering of molten slag, thereby to protect the metal against oxidization and thus prevent interference with its separation from the slag-making constituents."

That being the claim, the appellants object to it on the ground that this invention is already in the possession of the public by virtue of the description in the Queensland patent of their invention. That Queensland patent relates only to iron oxide ores, whereas the respondent's invention apparently relates to all sulphide and oxide ores. I say "apparently" because the respondent gives illustrations which may, perhaps, operate as limitations of his claim. It is however not necessary to consider which they are. With respect to sulphide ores, the object is to get rid of the sulphur, and this being done, and the metal being in a metallic condition, to subject it at once to the action of heat in a furnace without its becoming oxidized. In the case of oxide ores, the object is to get rid of the oxygen, and to subject the metal to the action of heat in a furnace before it has had time to become again oxidized.

It appears that the appellants' Queensland patent claims a process. The claim is for:—"(1) Our improved process of treating ferruginous ore for the manufacture of iron and steel therefrom, consisting in concentrating and separating such ore, subjecting it to the action of heat, and then to the reducing action of carbonic-oxide or hydro-carbon gas, and finally passing it without coming in contact with an oxidizing atmosphere into a Siemens or other gas furnace, where it is fused and 'balled up' as wrought iron or converted into steel, substantially as herein described and explained. (2) Our improved process of treating ferruginous ore for the manufacture of iron or steel therefrom, consisting in concentrating and separating such ore, subjecting it whilst passing through a chamber to the action of heat produced by the combustion of waste carbonic-oxide or hydro-carbon gas issuing from another chamber with air, and, subsequently, to the progressive reducing action of such gas or gases alone, whilst passing through such latter chamber, and finally passing it without coming into contact with an oxidizing atmosphere into a Siemens or other gas furnace, where it is fused and 'balled up' as wrought iron or converted into steel, substantially as herein described and explained." The difference between the claim of the respondent and that of the appellants is that in the former the process is described as taking place while the ore is passing

H. C. OF A. 1907.

MOORE AND HESKETH v. PHILLIPS.

Griffith C.J.

through one chamber into another chamber, whereas in the latter the manner in which the process or series of operations is applied to the material is described in detail. It cannot be said with any degree of certainty that the appellants' patent is for the very same invention as that described in the respondent's claim, that is to say, that the claims are identical. The important question is whether the process or series of operations in the method of treating oxide ores described in the respondent's claim has been described by the specification of the Queensland patent so as to be in the possession of the public.

Before referring again to the Queensland patent I must go back to the respondent's patent. It is argued, and correctly, that the Court is bound to have regard to the whole of the specification in construing the claim. The specification may clear up ambiguities, or may have the effect of limiting general words in the claim, especially where the claim is for a particular apparatus, or where the claim is for an invention to be performed substantially as described, or for an apparatus substantially as described. In the present case, however, there is no reference in the claim to any particular form of apparatus. The claim, therefore, is for a process of treatment, which of necessity must be carried out in some special apparatus. If the process were novel, it would not be sufficient to make a claim in that general way without describing some practicable mode of carrying it out. It is contended that, having regard to the specification, the claim must be limited so as to be, not for a method in the abstract, but for carrying out the method in a particular way. That is negatived by the very words of the specification itself in which the applicant says:—"In the accompanying drawings I have shown, for the purposes of illustration, what may be termed a universal furnace, of my invention, adapted for carrying out my improved method in the treatment of either sulphide or oxide ores. It is to be understood, of course, that the furnace in commercial practice would not be provided with all the features shown, because it would be usual so to construct furnaces as to adapt them for use only in the treatment of certain particular classes of ores. Thus, it would not be the usual practice to provide a furnace constructed with all the necessary features for treating

both sulphide and oxide ores, and generally the furnace would be devised in each instance simply to treat in the most economical manner a certain particular class of ore." Again, immediately before the claim, the applicant repeats in substance what he had stated at the opening of the specification :—"It will be understood from the foregoing description that the gist of my invention, so far as the treatment of metallic oxides is concerned, consists in subjecting the ore, while in atmospheric suspension, to reducing fusing atmosphere, or first to highly heating and then to a reducing atmosphere, then causing the reduced metal to enter beneath the protecting surface of a molten bath without subjection to an oxidizing or re-oxidizing influence, and causing the reducing gas, which descends through the stack with the ore, to expand and mingle over the bath with a highly heated oxidizing atmosphere to promote further combustion and heat the bath while separation of the metal from its slag-producing impurities is taking place beneath said protecting covering."

If, then, the process described by the respondent has been described by the Queensland patent, which applies only to iron oxide ores, it is clear that it is not new so far as iron oxide ores are concerned, and therefore the objection of the appellants is, I think, good; and if the respondent's invention is not new as to iron oxide ores, a valid patent cannot be granted including iron oxide ores. For, in that point of view, the claim being for the treatment of all ores, if it includes iron oxide ores it would not be new as regards them. If the claim were only for ores other than iron oxide ores different considerations would apply. The question, then, would be whether the application of a process, which was not new so far as iron oxide ores were concerned, to sulphide ores was so analogous to the process for which a patent was already granted as to warrant the refusal of another patent. That question, however, does not arise. If the applicant's claim does include what is described by the Queensland patent, a patent for it ought not to be granted.

It appears that the process described in the specification of the appellants' Queensland patent consists in taking finely pulverized ore, which has been separated from other materials as far as possible by a concentrating process, and introducing it at the top

H. C. OF A. 1907.

MOORE AND HESKETH v. PHILLIPS.

Griffith C.J.

of a stack through which it falls to the bottom, being treated on the way in the manner I will directly describe. At the bottom the ore falls into a Siemens or other gas furnace, where it is hoped that it will be turned into molten iron which can be converted either into wrought iron or steel. In its progress down the stack the ore is subjected to the action of heat and also to a reducing atmosphere, that is, a hydro-carbon or carbonic-oxide gas. That is done in this way. The stack is divided into two parts. The upper part is heated by an ascending current of heated gas, the waste product of combustion from the furnace, which has the effect of heating the ore falling through it to a red heat. The whole stack from top to bottom is furnished with shelves placed alternately on opposite sides and sloping downward at an angle of about 45 degrees, their object being to intercept and retard the falling ore in its course, and cause it to fall slowly down through the stack, and so to be longer subjected to the action of the heated atmosphere through which it is falling, and also to cause the particles of ore to become separated from one another and so to be subjected more thoroughly to the action of the heated atmosphere. While falling through the upper part of the stack the ore is subjected to an oxidizing atmosphere, and is merely heated. Half way down the stack there is an obstruction which causes the heated ore to be collected together, and it is then introduced by mechanical means into the lower half of the stack, which is furnished with shelves in the same way as the upper part. At the top of the lower half of the stack a reducing gas is introduced consisting of carbonic-oxide or hydro-carbon gas, which, coming into contact with the heated particles of ore, operates upon them as a reducing atmosphere. This reducing gas there introduced follows the ore downward to the furnace and through it, and is mixed in the furnace with atmospheric air, which causes combustion, and then passes away and is otherwise disposed of. The object of this, as pointed out in the specification, is first to get the ore in a fit state to be acted upon by the reducing atmosphere, and then to cause the reducing atmosphere to follow the falling particles of ore downwards to the furnace, so that the particles shall at once enter the furnace without coming into contact with

an oxidizing atmosphere. That is the purpose, and in order to facilitate it, the hydro-carbon or carbonic-oxide gas is introduced into the lower part of the stack in a highly heated condition, being brought down in a tube through the upper portion of the stack, which is in a heated state as I have said. The process then is a process for deoxidizing or reducing iron oxide ores, by subjecting them in a state of great heat to the action of a deoxidizing atmosphere, through which it falls into the furnace without being again subjected to an oxidizing atmosphere.

That being the appellants' process, what is there in the respondent's claim which is different? He says he treats finely divided ore. So do the appellants. He says his process "consists in showering the ore downward in a stack." The appellants say the same thing of their process. I have described one way in which the appellants do that. Another way described in their specifications is by means of an inclined revolving cylinder through which the ore falls as the cylinder is revolved. A third way is also described in the appellants' patent. Returning to the respondent's process, it continues "and subjecting it for initial treatment"—that means the whole treatment from the top of the stack to the furnace—"while in suspension, to a highly heated atmosphere." That is exactly what the appellants do in their process. Objection was taken that the term "in suspension" is not properly applicable to the description of the process given in the appellants' specification. That is a singular objection to come from the respondent. The whole object of the appellants' process is to cause the particles of ore to fall slowly through the stack so as to be subject as long as possible to the action of heat, and that is clearly the way in which the words "in suspension" are used in the respondent's claim. The next words of the respondent's claim are "moving in the same direction"—that is exactly what is described in the appellants' patent—"and causing the ore thus initially treated to discharge from the stack into a reverberatory chamber." The passage I have read from the appellants' claim describes exactly the same thing. There the words are "passing it without coming into contact with an oxidizing atmosphere into a Siemens or other gas furnace." The remaining words of the respondent's first claim are "wherein the unvola-

H. C. OF A. 1907.

MOORE AND HESKETH v. PHILLIPS.

Griffith C.J.

tilized molten metal constituent of the ore is caused to separate by gravity from the slag producing constituents." In that nothing is said about a reducing atmosphere, but in the fourth claim the process is differentiated with regard to iron, lead or copper oxide ores, and the differentiation is in the employment of a reducing atmosphere. That is exactly the same as the Queensland specification.

So far it would appear that the two processes are substantially the same, and that the respondent's claim is for the very process for which the Queensland patent was granted. It is said, however that there are differences, that the respondent does not cause the suspension or retardation of the ore in the same way. His method is by introducing the hydro-carbon gas in such a way as to cause a circular blast in the stack which is enlarged in one part for that purpose. That, it is said, causes a whirling motion which keeps the particles of ore in suspension. Possibly it does, but as soon as that suspension ends, the ore must be carried down to the furnace. That difference in the mode of producing the suspension may be a difference of apparatus, but certainly it is not mentioned in the claim.

Then it is said that the respondent does not first concentrate the ore, but carries up to the top of the stack lime or some other flux and mixes it with the ore, hoping that in its progress down the stack the metal will actually become fused. That, no doubt, would be the case with lead or copper ore, but it is not so likely to be the case with iron ore.

I pass to the fifth claim of the respondent's specification, which is for "the process of treating finely divided ore according to claiming clause (4), characterized by introducing the reduced metallic constituent of the ore, discharged from the stack, into the reverberatory chamber beneath a covering of molten slag, thereby to protect the metal against oxidization and thus prevent interference with its separation from the slag-making constituents." The only difference between that and the fourth claim is that the reduced metal, whether molten or not, is introduced to the furnace beneath a covering of molten slag. It may be that there is some novelty in that. There is nothing in the Queensland patent about introducing the metal beneath a covering of molten slag, because,

according to that patent, there is as little slag as possible, the object being to bring the metallic iron in a deoxidized state into immediate contact with the molten iron without a chance of its being reoxidized. That is very much the same thing as the respondent's claim.

It was suggested that the respondent's claim might be supported as a claim for a combination. In the case of a combination it is no objection that all the elements are old, but there must be something new in the combination itself. The invention is the combination. On this point I will read a passage from *Clark* v. *Adie* (1). After speaking of the different ways in which a patent for a combination may be infringed, Lord *Cairns* L.C. said:— "But, my Lords, there is a third way in which it is possible to conceive an infringement of a patent of the kind to which I have referred. In a patent claiming an entire instrument made by a consecutive number of steps, there may at the same time be what I will term, as perhaps the most convenient term I can think of, an invention which is a subordinate integer in the larger invention. Inside the whole invention there may be that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now, again, that subordinate integer may be a step, or a number of steps in the whole, which is or are perfectly new, or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term 'combination.' In that case you may have to try a further question; you may have then to look at the patent, not merely as a patent for the whole instrument described, but as a patent which, in addition to claiming protection for the whole instrument so made, claims protection also for the subordinate invention, the subordinate integer, which enters into the combination of the whole. Suppose, my Lords, that in a patent you have a patentee claiming protection for an invention consisting of the parts which I will designate as A, B, C and D; he may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a

(1) 2 App. Cas., 315, at p. 320.

H. C. OF A. 1907.

MOORE AND HESKETH v. PHILLIPS.

Griffith C.J.

combination of things which possibly were old in themselves, but which, put together and used as he puts together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would or might be held to be granted, not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then, my Lords, the invention must be described in that way; it must be made plain to ordinary apprehension upon the ordinary rules of construction, that the patentee has had in his mind, and has intended to claim, protection for those subordinate integers; and moreover he is, as was said by the Lords Justices, at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention." I understand the learned Lord Chancellor to be speaking there of an apparatus, but I apprehend that the same principle must apply if the patentee claims a combination of a number of processes well known. It may be that one of the respondent's claims, viz., the claim in respect of introducing the reduced metal beneath a covering of slag, is new, but if so the invention must be described in that way.

It appears, then, that the three claims of the respondent—taking them in the form in which they are set out—claim an invention which as to part of the subject matter was already in the possession of the public by virtue of the Queensland specification, except, possibly, as to the part of the fifth claim I have referred to. It may be that within the specification the respondent is entitled to claim something for which a patent should be granted, but in the present form of the claim the objection has been sustained.

The question, then, is whether the patent should be refused absolutely, or whether the respondent should be allowed an opportunity of mending his hand. The *Patents Act* 1903 allows amendments of specifications so long as the application is not granted, subject to the limit that the patent must be sealed within 16 months after the date of the application unless the time has been extended as provided by sec. 67. Sec. 78 provides that:—"No amendment shall be allowed that would make the specification as amended claim an invention substantially larger than or

substantially different from the invention claimed by the specification before amendment." So far as the respondent's claim is for an invention in respect of iron oxide ore, it has been described before. There may be something other than that which is asked for which is new even in respect of iron oxide ore, but, as the claim stands, it claims protection for an invention which is already in possession of the public. For these reasons I think the appeal should be allowed, and that, with respect to the application that the respondent should have an opportunity to mend his hand, the Court may properly follow the decision in the case of *Deeley* v. *Perkes* (1).

BARTON J. I concur in the judgment just delivered.

ISAACS J. I concur in the judgment which has been delivered, and I find it necessary to add a very few words. I have no doubt whatever that the appeal should be allowed. I agree to the indulgence which has been extended to the respondent. The principle involved in the cases referred to is that, so far as possible, at a stage like the present, the grant of a patent should not be intercepted if there is possibly any merit at all in the applicant's invention. At one stage of the argument I was considerably impressed with the possibility that there was a meritorious invention contained in the specification though not properly embodied in the claim, but as the argument proceeded, —it would not be right for me to say more at present—that impression became weakened. And I should like to say that, as far as I am concerned, the granting of this opportunity of asking leave to amend should not be taken as any encouragement to the applicant. The Commissioner will have to deal with the application irrespective of any opinion that I may have formed, and I shall not express any. But I desire to advert to two matters which are not based on the facts, but which are matters of law, and as to which I think the Commissioner is entitled to the opinion of the Court. One is the statement of the law in *Reynolds* v. *Herbert Smith & Co. Ltd.* (2). *Buckley* J., in relation to that particular case, the facts of which

(1) 13 R.P.C., 581. (2) 20 R.P.C., 123, at p. 126; affirmed 20 R.P.C., 410.

H. C. OF A. 1907.

MOORE AND HESKETH v. PHILLIPS.

ISAACS J.

are immaterial to the present purpose, said :—"In my opinion the plaintiff fails on subject-matter, and fails on novelty. Of course the difference between discovery and invention is very familiar. Discovery adds to the amount of human knowledge, but it does so only by lifting the veil and disclosing something which before had been unseen or dimly seen. Invention also adds to human knowledge, but not merely by disclosing something. Invention necessarily involves also the suggestion of an act to be done, and it must be an act which results in a new product, or a new result, or a new process, or a new combination for producing an old product or an old result." Unless, therefore, the applicant can show that the alleged invention answers to that description, he ought not to get a patent for it. Again, if the applicant's claim rests on combination, one case deserves reference, viz., *Richards* v. *Chase Elevator Co.* (1), which presents some features of analogy to the present case, or, possible features, according to the way the case may be presented to the Commissioner. In that case the alleged invention was in connection with the loading of grain, and the object was to do away with elevators by omitting an initial process, and to obtain better results, because the identity of the grain was not lost in shipment. The Court held the patent invalid. They found that there was no novelty in result, and none in the individual steps by which the result was obtained, and two rules were laid down which appear to me to accurately represent the law on the subject. One is—to take the second first because it seems to me to come first in logical order—as follows:—Mr. Justice *Brown* gave the judgment of the Court and he said (2):—"To make a combination of old elements patentable, there must be some new result accomplished, and as the result in this case is a mere aggregation of the several functions of the different elements of the combination, each performing its old function in the old way, we see nothing upon which a claim to invention can be based. The device is undoubtedly a convenient one, and appears to have proven profitable to the patentee; but we are unanimously of opinion that it lacks the necessary quality of invention." The other rule is stated thus (3):—"The novelty,

(1) 159 U.S., 477.

(2) 159 U.S., 477, at p. 487.

(3) 159 U.S., 477, at p. 486.

then, must be in the combination, which differs from the combination of an ordinary elevator only in the omission of the storage feature, by which grain is housed in transit, and its identity lost. While the omission of an element in a combination may constitute invention, if the result of the new combination be the same as before; yet if the omission of an element is attended by a corresponding omission of the function performed by that element, there is no invention, if the elements retained performed the same function as before."

These statements raise questions which may be very important for the Commissioner to consider, should the application to amend be made, and they lay down the rule correctly which may have to be applied in relation to those facts.

HIGGINS J. I am of the same opinion. The case is clear to my mind unless you can add to the claim by reading into it parts of the rest of the specification. Under sec. 36 of the *Patents Act* 1903 the claim is made an essential part of the specification. I fully accept the position, put by counsel for the respondent, that the whole of the specification is to be regarded for the purpose of construing and understanding the claim. It is also clear, I think, that a patentee is not entitled to protection for anything but that which, according to the proper construction of the claim, is claimed. *E converso*, he has the benefit of this rule, for his patent is not to be held void for anything which his claim does not comprehend.

Appeal allowed. Decision appealed from reversed. Declare that the grant ought not to be made unless the respondent within four months asks for leave to amend his specification. The time for sealing the patent to be extended until one day after the time for appealing from the decision on that application. Respondent to pay appellants' costs of opposition, to be taxed upon the lower scale of the Supreme Court, and the costs of this appeal.