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[HIGH COURT OF AUSTRALIA.

DUNLOP . . . . . APPELLANT;

AND

COOPER AND ANOTHER . . . . . RESPONDENTS.

ON APPEAL FROM THE COMMISSIONER OF PATENTS.

H. C. OF A. *Patent—Application—Opposition—Disconformity between provisional and complete specifications—Construction of specification—Patents Act 1903 (No. 21 of 1903), sec. 56.*

MELBOURNE,  
October 1, 2,  
6, 7, 8, 9, 21.

Griffith C.J.,  
O'Connor,  
Isaacs and  
Higgins JJ.

The respondents lodged an application for a patent for an “improved earth scoop,” and at a later hour on the same day the appellant lodged an application for “improvements in method and machinery for excavating.” The appellant opposed the respondents’ application on the grounds that the respondents obtained their invention from him, and that their complete specification described an invention other than that described in their provisional specification. The respondents opposed the appellant’s application on the ground that the appellant obtained his invention from them. The complete specification in both cases described the same machine. The Commissioner of Patents dismissed the opposition of the appellant and upheld the opposition of the respondents. On appeal to the High Court,

*Held*, on the evidence, that the respondents did not obtain their invention from the appellant, and that the appellant did not obtain his invention from the respondents.

*Held* further, on the evidence (*Isaacs J.* dissenting), that the complete specification of the respondents described an invention other than that described in their provisional specification, and, therefore, that the appellant’s application, which was not open to that objection, should have been granted and that of the respondents refused.

*Per Griffith C.J.*—(1) A provisional specification must describe an invention of which the applicant is in actual possession at the time of his applica-

tion, and, although his words may convey to others the idea of an invention of which he has not himself conceived the idea, yet, if in fact he has not then conceived the idea he is not in possession of the invention.

H. C. OF A.  
1908.

DUNLOP  
v.  
COOPER.

(2) If a provisional specification is ambiguous in the sense that the language is apt to describe two different things, evidence is admissible to show of which the applicant was actually speaking.

*Per O'Connor, Isaacs and Higgins JJ.*—On an opposition to an application for a patent the construction of the provisional specification is to be determined by a consideration of what meaning is conveyed by its words alone aided by such evidence as will enable those words to be understood, but the state of mind of the applicant at the time he lodges his provisional specification is irrelevant for the purpose of its construction.

*Per Isaacs J.*—The fact that an invention is not fairly described in a provisional specification is not admissible under sec. 56 of the *Patents Act* 1903 as an objection to an application for a patent.

*Per Higgins J.*—On an opposition to an application for a patent the Court is not entitled to consider objections not included in sec. 56 of the *Patents Act* 1903.

APPEAL from the Commissioner of Patents.

On 2nd April 1906 an application (No. 5585) for a patent in respect of "improved earth scoops" was lodged with the Commissioner of Patents by Walter Ernest Cooper and David John McClelland. On the same day, but at a later hour, an application (No. 5588) for a patent in respect of "improvements in method and machinery for excavating" was lodged by George Henry Dunlop. The former application was opposed by Dunlop, and the latter by Cooper and McClelland. The Commissioner having dismissed Dunlop's opposition and allowed that of Cooper and McClelland, Dunlop now appealed to the High Court from both decisions.

The material parts of the provisional and the complete specifications, the nature of the inventions, and the other facts are set out in the judgments hereunder.

*Schutt*, for the appellant. The provisional specification of the respondents does not fairly describe their inventions. It should show the mode of carrying the idea into operation: *Otto v. Linford* (1). If it shows something that cannot be an invention it

(1) 46 L.T., 35, at p. 39.



H. C. OF A. is not a proper specification. The evidence shows that by the  
 1908. provisional application the respondents did not intend to describe  
 { the thing which is described in the complete specifications.

DUNLOP  
 v.  
 COOPER.

[*Starke*.—Intention is immaterial: *Gadd v. Mayor &c. of Manchester* (1).]

If the words are ambiguous and the applicant swears that what he meant was a different thing from that which is described in the complete specification, there is disconformity: *Edison and Swan Electric Light Co. v. Woodhouse* (2). An applicant cannot put into his final specification an invention of which he did not know at the time he lodged his provisional specification: *In re Newall and Elliot* (3); *Vickers, Sons & Co. Ltd. v. Siddell* (4); *Nuttall v. Hargreaves* (5); *United Telephone Co. v. Harrison, Cox-Walker & Co.* (6); *Cochrane (Ltd.) v. Smethurst, Davies* (7); *Terrell's Law of Patents*, 4th ed. p. 411.

[ISAACS J. referred to *Bailey v. Robertson* (8).]

The respondents' provisional specification describes a double scoop, or two scoops with a common back, while his complete specification describes a single scoop with two cutting edges. As both applications were lodged on the same day, the appellant is at any rate entitled to a patent as well as the respondents: *In re Dering's Patent* (9).

*Starke*, for the respondents. On a question of disconformity the documents alone should be looked at, although the opinions of experts as to whether the invention will work may be received. The language of the provisional specification must be read in its ordinary signification. If the applicant has disclosed to the public his invention, that is sufficient, even although he had not in his mind the whole effect of what he has given to the public. It is not a question of what he has consciously disclosed. The essential features of the invention need not be inserted in the provisional specification. If there is an ambiguity, evidence may be given to assist the interpretation. The provisional specification should be given a very liberal interpretation: *Pneumatic*

(1) 9 R.P.C., 516.

(2) 32 Ch. D., 520.

(3) 4 C.B. N.S., 269, at p. 293.

(4) 15 App. Cas., 496, at pp. 499, 505.

(5) (1892) 1 Ch., 23, at p. 34.

(6) 21 Ch. D., 720, at p. 743.

(7) 1 Stark, 205; P.C., 354.

(8) 3 App. Cas., 1055.

(9) 13 Ch. D., 393.



*Tyre Co. Ltd. v. East London Rubber Co.* (1); *Pneumatic Tyre Co. Ltd. v. Ixion Patent Pneumatic Tyre Co. Ltd.* (2). The principle or general idea of the invention is all that need be put in the provisional specification, and the inventor may afterwards develop the invention by finding out the best way to use it. If its language is wide enough, the Court will interpret the provisional specification so as, if possible, to protect the patent: *Gadd v. Mayor &c. of Manchester* (3). The Court should not decide against the patent on the ground of disconformity unless the provisional and complete specifications disclose unmistakably different inventions, and the decision of the Commissioner should not be reversed unless it is unreasonable: See *Patents Act* 1903, sec. 37, 39, 40, 42, 56, 65; *In re Stuart's Application* (4).

[ISAACS J. referred to *In re Bartlett's Application* (5).]

The findings of the examiner, that there is an invention disclosed in the provisional specification and as to what that invention is, are conclusive, and all that is now open is whether that invention is different from that disclosed in the complete specification: See *Wallace and Williamson on Patents*, p. 290; *Terrell's Law of Patents*, pp. 119, 185. All that the respondents have done is to develop the invention disclosed by them in their provisional specification, and they have made no such improvement as amounts to a new invention: *Terrell's Law of Patents*, p. 122.

[ISAACS J.—In order to establish disconformity there must be either a contradiction of some matter essential to the provisional specification or a new invention: *In re Andrews' Patent* (6).]

Even if there is disconformity the respondents should have leave to amend their complete specification.

[He also referred to *Bailey v. Roberton* (7); *Cassel Gold Extracting Co. Ltd. v. Cyanide Gold Recovery Syndicate* (8); *Kelvin v. Whyte, Thomson & Co.* (9); *Beavis v. Rylands Glass and Engineering Co. Ltd.* (10); *In re Wilson's Application* (11).]

H. C. OF A.

1908.

DUNLOP

v.  
COOPER.

(1) 14 R.P.C., 77; *id.*, 573, at p. 578.

(2) 14 R.P.C., 853, at p. 869.

(3) 9 R.P.C., 516, at p. 526.

(4) 9 R.P.C., 452.

(5) 9 R.P.C., 511.

(6) 24 R.P.C., 349, at p. 368.

(7) 3 App. Cas., 1055.

(8) 12 R.P.C., 232.

(9) 25 R.P.C., 177, at p. 190.

(10) 17 R.P.C., 93, at p. 98; *id.*, 704.

(11) 9 R.P.C., 512 (n).



H. C. OF A.  
1908.  
DUNLOP  
v.  
COOPER.

*Schutt* in reply. It is not sufficient that the provisional specification should be wide enough to cover the complete: *Frost's Law of Patents*, 3rd ed., vol. I., p. 190.

[ISAACS J. referred to *Penn v. Bibby* (1).]

There must be a fair description in the provisional specification of the invention: *United Telephone Co. v. Harrison, Cox-Walker & Co.* (2).

*Cur. adv. vult.*

The following judgments were read:—

Oct. 21.

GRIFFITH C.J. The questions raised for determination in these two appeals are substantially the same, and, although the arguments were—I think unnecessarily—protracted, are simple.

On 2nd April 1906 (which was a Monday) the respondents lodged an application, No. 5585, for a patent for an invention which they described as an “Improved Earth Scoop,” of which invention they declared that they were in possession. With the application they lodged a provisional specification, which, so far as material, was as follows:—

“Our invention relates to a means to be used for the purpose of removing earth or other material from river beds and such like, by a reversible scoop worked by two engines with four ropes attached and filled from both sides. The two (2) main hauling ropes are attached to the front bottom corner of the scoop in each instance and to be used also in pulling the empty scoop back.

“The two (2) tipping ropes are attached to the top of a scoop one on each side and used for tipping the scoop when required to empty same.”

On the same day, but later, the appellant lodged an application, No. 5588, for an invention described as “Improvements in method and machinery for excavating.” The provisional specification lodged with his application described the invention in somewhat full detail. It referred to a scoop patented by him in 1904 and contained the following passage:—

“The improvement consists essentially in providing a scoop with two cutting edges, and in actuating it by four ropes whereby

(1) L.R. 2 Ch., 127.

(2) 21 Ch. D., 720, at p. 745.



the scoop can be hauled backwards and forwards, filling earth, etc., and transporting and depositing alternately on either side of the place where it is filled.

“The scoop has two sides closed forming the side plates of the scoop, two open sides constituting alternatively the front and top according to the direction in which the scoop is drawn when filling, and two closed sides constituting alternatively the bottom and back plates of the scoop according to the direction in which the scoop is drawn when filling. The cutting edges are on these plates, which, as before stated, constitute the bottom and back plates.”

The respondents' complete specification described an implement or scoop which is in substance identical with that described in the appellant's provisional specification. The appellant gave notice of opposition to the grant of the patent on the grounds:

1. “That the applicants have obtained the invention from the opponent herein.

2. “That the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.”

The appellant's complete specification described, but in fuller detail, the implement described in his provisional specification. The respondents gave notice of opposition on the ground that the appellant had obtained the invention from them, and also on the ground that the invention was already patented under Application No. 5585. This ground was, of course, not sustainable.

The Commissioner held that the appellant had obtained the invention from the respondents, and refused application No. 5588. He also held that the respondents had not obtained the invention from the appellant, and that the respondents' complete specification did not describe an invention other than that described in the provisional specification. He accordingly granted application No. 5585.

H. C. OF A.  
1908.

DUNLOP

v.  
COOPER.

Griffith C.J.



H. C. OF A.  
1908.

DUNLOP

v.  
COOPER.

Griffith C.J.

The relevant facts may be shortly stated, and there is no conflict of evidence on any material point.

In 1906 earth scoops operated by steam haulage power were well known in Australia, being used for excavation of tanks or channels. In 1904 the appellant had patented an invention which comprised a scoop the general shape of which was very much like that of the scoop described in his application No. 5588. A general idea of the shape may be obtained by imagining an iron tank of cubical form cut in two diagonally, so forming two vessels each of which has two square sides and two triangular sides. One of these vessels, having one of its square sides on the surface of the ground, is drawn forward, slightly tilted, so as to cut into and collect the soil, the other square side forming the back and preventing the excavated soil from escaping. In practice, this shape was departed from in details, the angle at the junction of the square sides being rounded off, and the hypotenuse of the right-angled triangle being turned into a convex curve. The hauling power was attached near the lower part of the triangular sides, so as to pull the cutting edge forward through the soil to be excavated, and the full scoop was emptied by tipping it forward by means of a rope attached to the top of the vertical back plate and called a tipping rope, the cutting edge being the fulcrum. This scoop could, of course, only be operated in one direction. In practice it was hauled backward to be emptied. Both the appellant and the respondents had been directing their attention to making further improvements in earth scoops.

On Saturday, 31st March, the appellant met the respondent Cooper, who told him that he had devised an improvement in scoops for which he intended to apply for a patent. There is some conflict of evidence as to the details of the conversation, each party alleging that the other obtained from him the idea of the scoop described in their respective complete specification.

On the same day the appellant gave instructions to a patent agent to prepare his provisional specification, which he lodged on the following Monday. The implement described in it in detail must have been then present to his mind. Comparing that description with the scoop comprised in the patent of 1904, it



will be seen that the essence of the invention was to put a cutting edge on what had been the back plate of the scoop, so making the scoop reversible, and to provide the necessary appliances for hauling it in either direction.

At the same date the respondents' experiments had gone so far as the construction of an implement which may be roughly described as of the shape which would be presented by two of the appellant's scoops placed back to back and fastened together, and having at the top of each side a semicircular loop of metal extending a few inches above the junction and called a rocker, to which the tipping ropes could be attached.

This, which may be conveniently designated a double-bowl scoop (though it was not so termed by the respondents themselves), was an implement which, to use the words of their provisional specification, could be "filled from both sides," which expression must mean "from both ends." It is apparent that in an implement of this construction only one-half could be used at a time for excavating and holding soil. It is also apparent that the angle of inclination of the floors of the two bowls to each other must have been not much less than 180°. The upright division which formed the common back to the conjoined bowls served the purpose both of stiffening the implement and of preventing the material excavated by it at one end from passing out at the other end. The respondents put in evidence a sheet of drawings showing successive advances or improvements consequent on experiments which they made during the ensuing ten days. As the experiments went on, they say that they found that the division might be dispensed with as regarded the purpose of stiffening, and that the other purpose might be served by greatly reducing the angle of inclination between the floors of the two bowls until it approximated to a right angle. About 13th April they drew a pencil sketch of an implement which is in form substantially the same as that described in the appellant's provisional specification, and gave instructions to a Mr. Campbell to construct it. This is the respondents' own story, which I accept. It follows that the appellant, who described the implement in its final form on 2nd April, could not have obtained the idea from the respondents, who did not arrive at it till the 13th. It also

H. C. OF A.

1908.

DUNLOP

v.

COOPER.

Griffith C.J.



H. C. OF A.  
1908.

DUNLOP

v.  
COOPER.

Griffith C.J.

follows, I think, that the respondents did not obtain the invention from the appellant.

The ground of the respondents' opposition to the appellant's application, and the first ground of the appellant's application, and the first ground of the appellant's opposition to the respondents' application therefore fail.

The second ground of the appellant's opposition is presented in three ways. First, it is said that the invention described in the complete specification, as to the nature of which there is no doubt, is "other than that described in the provisional specification," because the document describes an implement of quite different form and construction. This depends on the interpretation of the provisional specification itself. Secondly, it is said that a provisional specification must describe an invention which is actually in the possession of the applicant when the application is made, and that, as it appears from the respondents' own evidence that the invention described in the complete specification was not in their mind, and therefore not "in their possession" before 13th April, it is not the invention described in the specification of the 2nd, whatever may be the *primâ facie* meaning of the words. Thirdly, it is said that at best the provisional specification is ambiguous, and that, if it is capable of being read as a description both of the appellant's single-bowl scoop and of the double-bowl scoop of which the respondents then knew, there is a latent ambiguity, and that evidence is admissible to show, and being admitted shows, that the actual subject matter of the provisional specification was the double-bowl and not the single-bowl scoop.

I will deal with these points separately.

The provisional specification speaks of a reversible scoop worked by two engines with four ropes attached and filled from both sides. The hauling ropes are "attached to the front bottom corner of the scoop in each instance." This, in my opinion, denotes an implement with a single bottom plate, more or less flat, which can be hauled in opposite directions. Then it goes on to speak of "tipping ropes attached to the top of a scoop one on each side." Having regard to the purpose served by tipping ropes, it is necessary that they should be affixed to a part of the



scoop high above the floor, and at some distance in rear of the cutting edge. They must therefore be above and parallel to the hauling ropes. And, as the scoop described in the provisional specification was to excavate in both directions, it must have been capable of being tipped at either end. The tipping ropes must, therefore, have been attached to the top at some point intermediate between the ends or cutting edges. The words "on each side" are apparently synonymous with "for use in connection with each end." This language shows, to my mind, that the top and bottom of the thing described were in different parts of the implement, and were not interchangeable. An implement in which what is the top of the back when it is hauled in one direction would become the front of the bottom when it is hauled in the opposite direction is not even suggested, much less fairly described, by it. This, however, is the essential characteristic of the implement described in the complete specification. In my opinion these two inventions are essentially different, and one is not a mere development of the manner in which the idea embodied in the other was to be carried out.

Secondly, I am of opinion that the whole scheme of the patent law, emphasized by the obligation imposed on an applicant to declare that he is in possession of the invention, implies that an applicant must have actually made an invention before he can describe it in his provisional specification. In other words, the thing described must exist in idea before the description of it. This is indeed a truism. Ordinarily the language of the specification itself, if unambiguous, should alone be looked to. But, if it appears from admissible evidence—and the applicant's own statements are such—that he had not then conceived the idea which his words convey to other minds, I think that he is not in possession of the invention, and is not the inventor. This view, which seems to me to be self-evident, is supported by authority. In *Edison and Swan Electric Light Co. v. Woodhouse* (1) *Butt J.* said:—"I agree . . . that an inventor has no right to put into his final specification as part of his invention a discovery which he had not made at the time, of which he was ignorant when he filed his provisional specification." In

H. C. OF A.  
1908.

DUNLOP  
v.  
COOPER.

Griffith C.J.

(1) 32 Ch. D., 520, at p. 524.



H. C. OF A.  
1908.

DUNLOP

v.  
COOPER.

Griffith C.J.

*Nuttall v. Hargreaves* (1) *Bowen* L.J. said:—"Now it is to be observed that that strainer was not in his own mind at all at the time when he obtained the provisional specification. It was afterwards that it occurred to him, so that it cannot be said that the strainer was part of the invention which the provisional specification sets forth. An ingenious argument was directed to us . . . to the effect that the strainer was only a useful adjunct . . . by which the invention might be carried out, or to use the words of the Act of Parliament, 'the manner in which the invention was to be performed.' If so . . . possibly its absence from the provisional specification would not be fatal . . . The fact is (and this is the substance of the whole thing) that the patentee took out his provisional specification before the time arrived when he had absolutely matured his invention, and consequently he could not describe the nature of it."

In times when an applicant for a patent was not required to lodge a provisional specification describing the invention, the identity of the thing denoted by the general words of his title was obviously a matter to be established by evidence, if any question of identity arose. The requirement now made of a fair description cannot alter the rule in this respect.

To me it seems an amazing proposition that if A. and B. simultaneously invent two different machines, and A., who first applies for a patent, in attempting to describe his machine in his provisional specification uses language capable of being, but not intended to be, read as describing B.'s machine also, and then B. applies for a patent for his invention, A., if he subsequently invents B.'s machine, is at liberty in his complete specification to describe that machine in detail, and the Court is bound to say that the machine so described is not "other than that described in the provisional specification," with the consequence that B. cannot oppose the patent on the ground of difference, and can never obtain a patent for his own invention, which was in fact the first, since A., the unconscious inventor, was in law prior in time, and this although A. himself admits that he is not, and that B. is, the first inventor. It is quite immaterial that A. inde-



pendently invented B.'s machine after B. had applied for a patent. I do not understand the notion of an unconscious inventor.

But I think that this is in truth only another way of saying that such a specification is ambiguous, since *ex hypothesi* the language is capable of denoting the thing which the applicant had, as well as a thing which he had not, invented.

Thirdly, I think that, if a specification is ambiguous in the sense that its language is apt to describe two different things, evidence is admissible, as in any other case of latent ambiguity, to show which thing the inventor was actually speaking of. In addition to the evidence on this point to which I have already referred, it appears that on 16th or 17th April the respondents were actually experimenting with what I have called the double-bowl scoop, and showed it to the appellant, telling him that that was what they were patenting.

As already said, I do not think that the respondents' provisional specification can be read as describing the invention described in their complete specification. But, if it can, I think that it clearly appears that the words were not in fact used to describe that subject-matter.

Unless, therefore, the two things are substantially the same, the objection must prevail. For reasons already given I think that they are essentially different. A fair test is afforded by considering whether if the double-bowl scoop had been patented the single-bowl scoop would have been an infringement, or would itself have been subject-matter for a new patent. I cannot doubt that it would have been good subject-matter. In addition to other differences there is the obvious one that it would enable the same work to be done with an implement containing little more than half the weight of metal—a matter of immense importance in dealing with the excavation and haulage of earth.

In my judgment both appeals should be allowed.

O'CONNOR J. In the first of these cases Cooper and McClelland are the applicants and Dunlop the opponent; in the second the positions are reversed. In each case the opponent relies upon the ground, amongst others, that the applicant obtained the invention from the opponent. A considerable portion of the declarations

H. C. OF A.  
1908.

DUNLOP  
v.  
COOPER.

Griffith C.J.



H. C. OF A.  
1908.

DUNLOP  
v.  
COOPER.

O'Connor J.

in both cases is devoted to that ground, and it certainly occupied a great deal of time in the argument. But in neither case have I been able to discover anything sufficiently definite in the evidence to justify a finding for the opponent, upon whom the burden of proof must rest. In so far as the Commissioner based his decision upon that ground he was, in my opinion, in error. That, being out of the way, both cases really turn upon the question, what is the proper finding on the second ground of Dunlop's opposition to Cooper and McClelland's application; because if Dunlop succeeds in defeating Cooper and McClelland's application their ground of opposition to his application disappears.

In my opinion there can be no doubt that the provisional specification accompanying Dunlop's application of 2nd April describes an invention identical with that described and claimed in Cooper and McClelland's complete specification. It therefore becomes unnecessary for me to consider more than the one ground of Dunlop's opposition founded on the first portion of sec. 56 (*d*) of the *Patents Act* 1903. The words used in the material part of the sub-section are these:—"That the complete specification describes or claims an invention other than that described in the provisional specification." By sec. 35 a provisional specification must fairly describe the nature of the invention, and by sec. 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. The issue to be dealt with on the ground under consideration involves the comparison of the two specifications.

In this respect the Australian patent law follows the English Act. There is no doubt about the law on the subject. It is summarized correctly in *Frost on Patents*, 3rd ed., vol. I., p. 190, as follows:—"The provisional specification, as appears from the foregoing pages, must contain a description of the invention for which the patentee desires protection, and though his description may be a mere rough outline, it is absolutely essential that it shall be honest, fair, explicit, and wide enough to comprise all that is described and claimed in the final specification when that instrument is filed, and, speaking generally, the two specifications ought not so to differ that the nature of the invention described



in the one is materially different from that described in the other.” H. C. OF A.

1908.

DUNLOP

v.

COOPER.

O'Connor J.

In this form of proceeding it is the duty of the Commissioner in the first instance, and the Court on appeal, to compare the invention the nature of which is described by the applicant in his provisional specification with the invention as fully described and ascertained in his complete specification. For purposes of comparison the inventions must be taken to be as described in the two specifications respectively. Turning first to Cooper and McClelland's provisional specification, the invention is described as an “improved earth scoop,” not an “improved method of earth scooping.”

Several forms of scoop were then well known and in use. We therefore expect to find, and we do find, the improvement on the then known forms of scoop which constitutes the applicant's invention described. But to follow the description the whole specification must be read. It is a “reversible scoop” filled from both sides, that is treating each cutting edge as a side. It is to be pulled backwards and forwards by two main hauling ropes attached to the front bottom corner of the scoop “in each instance,” *i.e.* on each side. As the scoop must cut as it is pulled, it follows that each front of the scoop must have a cutting edge. Thus the scoop is reversible, each side in turn filling as it is drawn. But it must be emptied of the load which it carries to each side of the cutting before the reverse action can begin. The method of emptying will depend on the shape of the scoop, and the shape is necessarily to be inferred from the second last paragraph, which describes the attachments for emptying as follows: —“The two tipping ropes are attached to the top of a scoop one on each side and used for tipping the scoop when required to empty same.” In the previous paragraph it is stated that the hauling ropes are to be attached “to the front bottom corner of the scoop in each instance.” It follows that the scoop is so shaped that the tipping ropes are not attached to the bottom or cutting edge of the scoop but to the part which is above the bottom, and which is described as the top of the scoop. In that form of scoop the bottom of the scoop in one haul does not become the top of the scoop in the reverse haul, but the top of the scoop remains the top and the bottom remains the bottom



H. C. OF A.  
1908.

DUNLOP

v.

COOPER.

—  
O'Connor J.

in whatever direction the scoop may be pulled. In considering this description it is of no moment whether the scoop so described contained diaphragms or any other device for strengthening its construction.

Turning now to Cooper and McClelland's complete specification, the invention is designated as before an "improved earth scoop." Its shape and mode of working are described in the specifications and drawings taken together. It is made quite clear that the shape of the scoop is an essential feature of the invention. But its shape is substantially different from that described in the provisional specification. In the latter the angle of the scoop was necessarily large. The tipping ropes were attached to the highest part of the scoop when in action, which in that shape of scoop was necessarily higher than the bottom or cutting edge. But the complete specification so narrows the angle and alters the shape that the bottom of the scoop in crossing the cutting becomes the top or highest point when the scoop is reversed for re-crossing, thus making it necessary to connect the tipping rope and the hauling rope to the same part of the scoop.

It was argued on behalf of Cooper and McClelland that every essential feature of the scoop in the complete was involved in the description contained in the provisional specification, that the latter described the genus of which the complete was a species. I cannot read the provisional specification in that way. If the invention therein described had been an improved method of using earth scoops generally some weight might be given to that argument. But the invention is of an improved form of scoop—a reversible scoop, and shaped in the form described, and which the inventor then apparently deemed would give the best results. The scoop described in the provisional is not a genus, it is a species of the genus earth scoop; the complete specification also describes a species of the same genus, but it is a different species from that described in the provisional specification.

During the argument some time was occupied in discussing Mr. *Starke's* contention that, if the words of the provisional specification are capable of being so construed as to include the invention described in the complete specification, the invention described in both will be deemed identical, quite irrespective of the fact that



the inventor could not have had in his mind at the time his provisional specification was filed the invention described in his complete specification. This form of proceeding does not finally settle the applicant's right to the invention. It is merely in aid of the process of registration, and its purpose is to ensure that the applicant shall not obtain the benefit of provisional protection for any invention other than that which is finally registered as his. The invention must be dealt with as described, and the Court can know nothing of the inventor's intention except as he has expressed it in his two specifications. Ambiguities may be explained by the same kind of evidence as is admissible to explain ambiguities in other documents *inter vivos*. But, except for that purpose, evidence is not admissible to show that the applicant did not in his own mind intend to describe a different invention from that which his written words properly construed indicate. In the view I have taken of the case, however, it becomes unnecessary to deal further with that contention. As I have pointed out, the description contained in the provisional specification is not general but specific, and its words do not cover the other form of scoop specifically described in the complete specification.

I come now to Mr. *Starke's* last contention that such differences as there were between the scoop as described in the provisional and in the complete specification respectively were merely legitimate developments of the invention described in the former, and did not so depart from it as to amount to disconformity. What an inventor can and what he cannot safely do in developing his invention between the date of his provisional and that of his complete specification has been well stated by Lord *Blackburn* in the case of *Bailey v. Robertson* (1), as follows:—"Look at the nature of the invention described in the provisional specification, and say whether this which you have been doing, and which you say was a part of the patent, is fairly within the nature of the invention you have described, in that case you are protected; but if it is a new and separate invention, and a different one, then you are not protected."

How far he can safely go in developing and improving his

H. C. OF A.  
1908.

DUNLOP  
v.  
COOPER.

O'Connor J.

(1) 3 App. Cas., 1055, at p. 1075.



H. C. OF A.  
1908.

DUNLOP  
v.  
COOPER.

—  
O'Connor J.

invention, *Lopes* L.J. has concisely stated in the case of *Woodward v. Sansum & Co.* (1):—"It is essential that the nature of the invention shall be the same, but upon principle and upon authority, it is clear that improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts, with a view of producing the same results, the substitution of mechanical equivalents and modifications and developments within the scope of the invention set out in the provisional specification are allowable, and cannot be successfully relied on for the purpose of invalidating a patent for disconformity."

In determining whether the difference between the scoop as described in the provisional and that described in the complete specifications are so fundamental as to amount to disconformity the Court in this case has had the great advantage of being able to trace on diagram "W" put forward by Cooper and McClelland themselves the various stages of development by which the form of scoop described in their complete specifications was brought to its latest form. The first scoops shown in that diagram are evidently those described in the provisional specification. The shape, the place of attachment of hauling and tipping ropes respectively, the mode of reversible working, all correspond with the description in the provisional. But the shape is gradually altered; the place of attachment of tipping ropes is adapted to the altered form accordingly until they arrive at a scoop which is materially and essentially different from that described in their provisional, but identical with that described in Dunlop's. Under these circumstances I have come to the conclusion that the scoop described in Cooper and McClelland's complete specification claims an invention other than that claimed in their provisional specification, and the Commissioner ought so to have found.

It follows, in my opinion, that the findings in Cooper and McClelland's favour in both cases must be reversed and findings entered in both cases for Dunlop, with the declaration that a grant should issue to Dunlop in accordance with his application, and that Cooper and McClelland's application should be refused.

(1) 4 R.P.C., 166, at p. 178.



ISAACS J. The parties respectively claim it was from him or them that the other obtained the invention. I shall first deal with this objection.

Earth scoops have been in use for many years. But up to March 1906 neither Dunlop nor any other person except Cooper and McClelland ever conceived the idea of a scoop having two cutting edges, and so avoiding the waste of an idle return.

On Wednesday night, 28th March 1906, Cooper and McClelland decided to experiment with a reversible scoop.

On 30th March 1906 McClelland made a drawing of the first reversible scoop, shown as figure 2 on a plan exhibited.

On 31st March, a Saturday, a memorable interview took place which has led to the present litigation. It was as unfortunate for Cooper and McClelland as it was certainly a stroke of good luck as it has turned out for Dunlop. Cooper invited Dunlop to drive with him to Richmond and on the way voluntarily gave him some information. Cooper certainly erred on the side of candour. I shall let Dunlop tell his own story. "On 31st March W. E. Cooper then a licensee of my patent, told me he intended to patent an improvement in steam scoops. He appeared disposed to disclose invention. I advised him not to do so to anyone until he had applied for patent. He did not disclose to me."

Now up to that point, there is no trace of Dunlop conceiving even the remotest notion of a double-cutting action scoop. He does not pretend to any, nor that up to the time he left Cooper after their drive, which must have been full of interest to Dunlop, he ever suggested he had succeeded in further advancing the science of earth scoops.

Having regard to the onus of proof I do not reject Dunlop's statement that the method of construction was not explained to him, but I feel no doubt whatever that in some way, either directly or indirectly, he gathered from Cooper that the improvement which the latter was about to patent was in the direction of a scoop that cut both ways. The stimulating and suggestive effect of the conversation upon Dunlop's mind cannot be denied and scarcely exaggerated; what he admits the incessant study of years had failed to effect, this interview seems to have instantane-

H. C. OF A.  
1908.

DUNLOP

v.  
COOPER.

Isaacs J.



H. C. OF A.  
1908.

DUNLOP

v.

COOPER.

Isaacs J.

ously accomplished. Mr. Dunlop continues his story. "I proceeded directly to Patent Attorney Bedlington Bodycomb, disclosed my invention of four-rope two-cutting edge scoop, showed sketches, and arranged to bring provisional specification and lodge on the following Monday. I did so." Even now with all the explanation he can give his invention clearly originated from the interview. In this I thoroughly agree with the Commissioner.

The expression too that Dunlop employs as descriptive of the nature of his invention is of importance. He calls it "a four-rope two-cutting edge scoop." It was in fact nothing in essence but putting another cutting edge on his old scoop, necessarily using four ropes for hauling and tipping—a mere modification of the three rope system, and according to his own description leaving the precise position of the ropes and contour of the front part of the scoop to the judgment of experienced men. The heart and soul of the matter was the idea of the extra cutting edge. This idea, as I have said, was in my belief gathered by him from Cooper. I cannot say that Cooper has so definitely described his conversation as to establish that the method embodying the idea was communicated. Dunlop undoubtedly got what Lord *Wensleydale* in *Betts v. Menzies* (1) called "a notion that a particular article might be made."

He is, however, in my opinion just saved by the burden of proof from the objection that he obtained their invention, that is their contrivance, from Cooper and McClelland. If the invention he claims is different in nature from that in Cooper's provisional specification, of course he did not.

But indebted as he was to Cooper for his primary idea, he claims that they stole his special means of carrying it into effect. I have no hesitation in finding this against him. Cooper and McClelland's specification was lodged on Monday, No. 5585, Dunlop followed close on, No. 5588. After lodging their provisional specification Cooper and McClelland continued their experiments and altered the shape and arrangement of the actual scoop they had constructed for experimental purposes. The alterations were gradual and as dictated by actual user, not the

(1) 10 H.L.C., 117, at p. 158.



abstraction of Dunlop's work. They altered the position of the ropes, abolished the diaphragm, and diminished the angle, thereby making it lighter and easier to tip.

The modifications were included, as the applicants were bound to do, in their complete specification: See *per* Lord Macnaghten in *Pneumatic Tyre Co. Ltd. v. Leicester Pneumatic Tyre and Automatic Valve Co.* (1). Unless not merely the applicants but other witnesses are to be considered utterly untrustworthy, and unless in dating his plan No. 2 "13/4/06" McClelland has added forgery to perjury there is a period of at least three or four days before 16th or 17th April which is fatal to this part of Dunlop's case. Whatever the result, Cooper and McClelland have honestly in fact invented what they are now endeavouring to protect.

The second objection raised by Cooper and McClelland may be passed by because no patent is yet issued. Nothing was said as to this objection.

Dunlop's second objection is that set out in sec. 56 (*d*) of the Act. The arguments have raised some very important questions of law of general application. The first observation I would make as to sec. 56 is this: that it is most explicit both in its affirmative and negative provisions regarding the objections that may be taken at that stage. It sets out the possible grounds on which opposition may be based, and adds the prohibitory words "but on no other." So that the fact that the applicant is not the inventor is not *per se* a sufficient objection at that stage. Again, the mere fact that the invention is not fairly described in the provisional specification is equally insufficient at that stage. I do not put these instances as exhaustive. The opponent is limited to such of the grounds specified in the section as he puts forward, whatever they on a fair construction may include. But the Court is not at liberty—indeed is forbidden—as I read the section, to strain its operation so as to achieve what *Bowen* L.J. once termed "Oriental justice"; and as the legislature has kept separate each objection permissible, I think it should be so considered.

In my opinion, when the applicant once reaches the stage con-

H. C. OF A.

1908.

DUNLOP

v.

COOPER.

Isaacs J.



H. C. OF A. 1908.  
 {  
 DUNLOP  
 v.  
 COOPER.  
 —  
 Isaacs J.

templated by sec. 56, the provisional specification is not to be quarrelled with on the ground that it does not fairly describe the nature of the invention it deals with.

Paragraph (d) means that the opponent is not to be barred in his own application by another person's subsequent complete specification which relates to an invention different from a prior provisional specification that as regards time would bar him if the invention were not different. He therefore must show:—

- (i.) That between the two specifications he has applied for a patent for the very invention contained in the complete specification.
- (ii.) That the invention as described in the provisional specification he attacks is different from the one described in the complete.

Inasmuch as no applicant in his provisional specification need do more than fairly describe the nature of his invention, all that is necessary for him under this objection to support his complete specification is to establish that the invention there described is not different in its *nature* from that described in the provisional. To require, for the purposes of paragraph (d) of sec. 56, a greater minuteness in the provisional specification than sec. 35 provides would be to make it a trap for inventors: See *In re Andrews' Patent* (1) and *Pneumatic Tyre Co. Ltd. v. Leicester Pneumatic Tyre and Automatic Valve Co.* (2).

It follows also from the words of the paragraph that the identity of the invention actually invented by the applicant with that described in the provisional specification is altogether immaterial to this particular objection. This may be brought in question in another proceeding or under another objection, but is no part of the inquiry authorized by paragraph (d). That paragraph assumes actual invention, and concerns itself solely with identity of inventions as described. The fact that the applicant is not the inventor disentitles him to a patent for what he has described, but cannot alter the description itself.

It is a logical consequence of these considerations that the objection must be determined by a proper construction of the two

(1) 24 R.P.C., 349, at p. 368, *per*  
*Vaughan Williams L.J.*

(2) 16 R.P.C., 531, at p. 541, *per*  
*Lord Macnaghten.*



specifications of the applicant—his provisional, and his complete—and of the provisional specification of the opponent, and then by a comparison of the nature of the respective inventions so ascertained.

Before indicating what I think the proper means of arriving at the true construction of these documents, I should state what I apprehend is the test of difference, and *e converso* of identity, of invention. In *United Telephone Co. v. Harrison, Cox-Walker & Co.* (1) *Fry J.* had to determine whether a certain discovery in a mode of reproducing sound included in a complete specification had been described in the provisional specification, and speaking of possible advances between the dates of the two documents says this:—"Look at the nature of the invention described in the provisional specification, and say whether this which you have been doing, and which you say was a part of the patent, is fairly within the nature of the invention you have described; in that case you are protected; but if it is a new and separate invention, and a different one, then you are not protected." This is amplified by the learned Judge in the course of his judgment.

The true relation for this purpose of the two specifications is clearly defined in *Penn v. Bibby* (2) where Lord *Chelmsford*, L.C., dealt with the matter comprehensively. The validity of a patent was challenged on the ground of a variance between the provisional and the complete specification. One of the defendant's arguments as put by the Lord Chancellor was that the precise description in the complete specification was "not what is described in the provisional specification"—I quote these words to emphasize the similarity of the point at issue. Dealing with this argument his Lordship said (3): "The object of this protection evidently is, to enable the patentee to perfect his invention by experiments which, although open and known, will not be a user and publication to the prejudice of letters-patent to be afterwards granted, so that he may be in a condition to describe in his complete specification, as the result of his experience, the best manner of performing the invention. It clearly appears, therefore, that the complete specification is, in a sense, supplemental to the pro-

H. C. OF A.  
1908.

DUNLOP  
v.

COOPER.

Isaacs J.

(1) 21 Ch. D., 720, at p. 744.

(2) L.R. 2 Ch., 127.

(3) L.R. 2 Ch., 127, at p. 132.



H. C. OF A.  
1908.

DUNLOP

v.  
COOPER.

Isaacs J.

visional specification, not going beyond or varying from it as to the *nature* of the invention, but conveying *additional information*, which may have been acquired during the currency of the provisional specification, as to the manner in which the invention is to be performed."

"From this description of the different offices of the two specifications, it follows that upon an issue whether the specification, enrolled in pursuance of the letters-patent, describes and ascertains the nature of the invention, *if the claim in the complete specification is comprehended within the terms of the provisional specification* that issue will be satisfied. The relation which the provisional specification bears to the complete specification is much the same as that which, before the *Patent Law Amendment Act*, the title bore to the specification; and the observations of *Tindal*, C.J. in *Cook v. Pearce* (1) are as applicable to the provisional specification now as they were to the title formerly."

Then his Lordship says:—"The only objection, then, which is open, is upon the complete specification, whether it is sufficient in itself, and whether it agrees with the provisional specification. Now, by agreement is not meant a perfect correspondence, but merely that there shall be nothing in the complete specification at variance with the provisional. . . . It is clear, therefore, that unless the complete specification in this case claims something *different* from the provisional specification, the objection to the patent under consideration cannot prevail."

This case appears to me to apply exactly to the matter before us with the addition in paragraph (*d*) of the intermediate application of the opponent for the invention contained in the complete specification.

It is a rare thing for a patent to be forfeited for what is known as disconformity. Of course it depends upon the facts, but the case must be clear.

The point is of general importance to inventors, as well as of manifestly great value to the parties. I think the cases cited by Mr. *Starke* on this point support his contention that the established principles applied to the facts of this case entitle his clients to a favourable decision. In *Gadd v. Mayor, &c. of Man-*

(1) 8 Q.B., 1064.



chester (1), approved in *In re Andrews' Patent* (2), Lindley L.J. said:—"The Court ought not to decide against the validity of a patent on the ground in question, unless the two inventions are unmistakably different. If a case is on the border line, the patent ought to be held good rather than bad."

H. C. of A.

1908.

DUNLOP

v.

COOPER.

Isaacs J.

In *Cassel Gold Extracting Co. Ltd. v. Cyanide Gold Recovery Syndicate* (3), the Court of Appeal held that there was no conformity, that is variance, between a provisional specification which stated that a solution of cyanide of potassium could be used to extract gold from the ore, and the complete specification stating the only effective solution, namely, a specified quantity described. If the provisional specification is only wide enough the applicant may fill it up and take advantage of any subsequent knowledge to cover matter of detail which the words of the provisional description would include: *Pneumatic Tyre Co. Ltd. v. Leicester Pneumatic Tyre and Automatic Valve Co.* (4); *Bailey v. Robertson* (5).

Unless therefore the invention in the complete specification is a perfectly new and distinct invention, and not merely a development of that in the provisional, there is no variance. The issue then being whether the invention as described in the complete is comprehended within the ambit of the provisional, the next step is to ascertain how this should be determined.

It has been strenuously contended that, for the purpose of construing the provisional specification, the applicant's actual state of mind is material—that in order to assist the Court in ascertaining the intent of the words contained in the document, evidence of the extent to which the applicant's inventive process had advanced may be admitted, as to what drawings he had made, and what models he had constructed. As this is not a case of estoppel, admissions are no more potent than adverse testimony. If the one class of evidence is permissible so must be the other.

Further, as the contest is between competing applicants, it is not a question of whether as between the Crown and the original applicant he ought to be regarded as the actual inventor in return for the patent. Dunlop should be tied down to what he asserts,

(1) 9 R.P.C., 516, at p. 527.

(2) 24 R.P.C., 349, at p. 369.

(3) 12 R.P.C., 232, at pp. 256-7.

(4) 16 R.P.C., 531.

(5) 3 App. Cas., 1055.



H. C. OF A.  
1908.

DUNLOP  
v.  
COOPER.  
Isaacs J.

viz., that the provisional specification describes an invention of a different nature from that described in the complete.

I know of no authority for such a method as is suggested of arriving at the meaning of a provisional specification, and if admissible it is of course equally applicable to interpret published anticipations for the purpose of either upholding patents or destroying them. Could it, for instance, be said that the mind of the author of a published anticipation, however ambiguous it might be, was a fit subject of inquiry to determine the identity of the thing disclosed with that described in a subsequent specification?

In my opinion no such inquiry is open upon the present ground of opposition. Some expressions of *Bowen* L.J. in *Nuttall v. Hargreaves* (1) were relied upon in support of the position taken up, but I do not understand that learned Lord Justice as in any way suggesting such an exceptional rule of law. The words were in any event quite unnecessary to the result, and other portions of his judgment show how he regarded the legal position. He said, "Unless the nature of the invention is described in the provisional specification the patentee cannot recover."

The learned Judge could not have meant that everything which does not occur to the mind of the inventor up to the time of filing the provisional specification, is not part of his invention as described. Such a doctrine would shut out all improvements and developments, and yet his words are as applicable to one as the other. *Bowen* L.J. in using the words relied on was, I think, giving an all-sufficient moral reason for not expanding the primary meaning of the words contained in the description. Here the attempt is to depart from the ordinary meaning of the words used and to cut them down. *Lindley* L.J. puts it shortly thus:—"I gather from the complete specification and from the evidence that the strainer is an essential part of the invention . . . there is not a word about it in his provisional specification" (2).

Authorities of the highest character place the matter, in my opinion, beyond doubt. In *Clark v. Adie* (*No.* 2) (3) Lord

(1) (1892) 1 Ch., 23, at p. 32.

(2) (1892) 1 Ch., 23, at p. 30.

(3) 2 App. Cas., 423, at p. 436.



*Blackburn* said:—"In construing the specification, we must construe it like all written documents, taking the words and seeing what is the meaning of those words when applied to the subject-matter; and in the case of a specification which is addressed not to the world at large but to a particular class, for instance, skilled mechanics, possessing a certain amount of knowledge, it is material for the tribunal to put itself in the position of such a class, namely, skilled mechanics, and to see what the words of the specification mean when applied to such a subject as skilled mechanics would know, and, as the tribunal has now, by the admission of evidence or otherwise, put itself in a position to understand, and then to say what the words of the specification mean when applied to such a subject-matter."

In *Castner-Kellner Alkali Co. Ltd. v. Commercial Development Corporation Ltd.* (1) Lord *Halsbury* L.C. said:—"The question must be determined by the fair construction of the provisional specification itself"; and the same learned Lord said (2):—"I think one must look at the provisional specification and then consider whether it is really describing what is now claimed or what is in its essential features a different thing." Lord *Macnaghten* in the same case said (2):—"In his complete specification . . . he is describing a different invention from that described in the provisional specification and an invention not merely different from, but in its leading feature at variance with, the invention described in the provisional specification." In *Gadd v. Mayor &c. of Manchester* (3) *Stirling* L.J. was explicit in stating the inadmissibility of expert evidence as to the true reading of the specification, but the admissibility of the expert evidence as to mechanical equivalents.

The whole subject was considered in two cases of great authority—*Hills v. Evans* (4) by Lord *Westbury*, L.C., in January 1862; and *Betts v. Menzies* (5) decided a month later—the latter case containing a most definite statement by some of the learned Judges whose opinion was requested.

From these and the other cases cited I deduce the following as the law on the subject.

(1) 17 R.P.C., 593, at p. 604.

(2) 17 R.P.C., 593, at p. 605.

(3) 9 R.P.C., 516, at p. 532.

(4) 31 L.J. Ch., 457.

(5) 10 H.L.C., 117.

H. C. OF A.

1908.

DUNLOP

v.  
COOPER.

Isaacs J.



H. C. OF A.

1908.

DUNLOP

v.

COOPER.

Isaacs J.

The construction of the specification, like any other document, is for the Court, and is to be determined by a consideration of what meaning is conveyed to a reader of the instrument by its words alone; that consideration being given by the light of all surrounding circumstances available, to enable the reader to understand the words such as the previous general state of knowledge applicable to the subject matter dealt with by the document, and with the aid of any evidence necessary to inform the Court of the meaning of any terms of art such as scientific expressions, special or technical processes or commercial phrases with which a reader would be presumed to be acquainted before he understood what is written.

The writer's private mental condition at the time of composing the document is for this purpose irrelevant.

The Court having settled the interpretation of the document, and so defined the invention there described, it may be necessary as here to compare that invention with another similarly ascertained from another specification. The two inventions, once obtained and placed side by side, may be of such a character that the common knowledge of mankind is sufficient to enable the Court to say whether they are different things or not. On the other hand, special knowledge may be necessary, and in that case, as they are now by the process of interpretation matters external to the documents, they are fit subjects for expert or scientific evidence, and the tribunal, whether Court, jury, or Commissioner, whose function it is to determine the issues of fact may and must take the extrinsic evidence into consideration in determining the question of identity.

Proceeding according to these principles I have examined the specifications in order to discover:—

- (1) What invention Cooper's complete specification describes:
- (2) What invention Dunlop's provisional specification describes:
- (3) What invention Cooper's provisional specification describes.

The view taken by the majority of the Court upon the construction of these documents renders my opinion quite immaterial, and although the parties are entitled to my reasons for the conclusions at which I arrive, these shall be stated very briefly because the result on this branch cannot affect any future case.



I must confess I approach the consideration of such a question with a strong desire to conserve to the originators of any meritorious conception the benefit of their ingenuity. They have conferred a benefit on the public, and unless the case is unmistakably clear against them I would endeavour to let them have the benefit of their invention.

The whole objection seems now, and for the first time, to be really rested upon the supposed antagonism between the two words "bottom" in the phrase "front bottom corner," and "top" used with regard to the tipping ropes. That was not the case presented to the Commissioner. If it had been, evidence might have been tendered as to the understanding among experts of these expressions, in view of actual operations and the effect of various angles. Apparently it is an afterthought. Reference to Dunlop's declaration of 15th January 1907 will show his real objection to Cooper's invention was that it was a double-bowl scoop and not a single-bowl scoop. On the construction of the specification, so far as he attempted to support it by evidence, his experts made no reference to the present point. In effect they thought the document was not sufficiently explicit to show "any particular type of reversible scoop": (*Delbridge*, par. 2). And they thought, so far as they condescended to particulars, that it was a double-bowl scoop.

What the applicant and his experts apparently failed to discover, I am equally unable to find. Now, what is Dunlop's invention according to his own provisional specification? He describes it thus:—"Providing a scoop with two cutting edges, and in actuating it by four ropes," or in other words taken from his declaration "a four-rope two-cutting-edge scoop." Analysing his provisional specification these facts appear:—

(1) The essence of the invention is the providing two cutting edges and actuating the scoop with four ropes.

(2) The machine is constructed and operated as in patent No. 1604 modified only to suit the above essential invention.

(3) The hauling ropes are to be connected with the cutting edge "*in the usual way*"—his own words.

(4) The tipping ropes are "attached to the scoop in such position" as enables them to tilt as in No. 1604 and to tip.

H. C. OF A.

1908.

DUNLOP

v.

COOPER.

Isaacs J.



H. C. OF A.  
1908.

DUNLOP

v.  
COOPER.

Isaacs J.

Therefore there is no novelty in make of the machine; use of ropes, method of attachment, or method of working, except that there is an additional edge and a consequent active operation in both directions. Apparently it was Cooper's idea applied to the old scoop, and nothing more.

Now, where is the variance of Cooper's provisional specification? None as to the single-bowl scoop—that is now admitted.

As I read it, it comes to this. Cutting edge A, as I may term it, is the bottom when it is operating as the cutting edge, and cutting edge B opposite by reason of tilting is not, or at least may not be, the bottom. The shape of the scoop, that is, the angle of the body and the direction of the line joining the two cutting edges, may be such as to make B the highest point of the whole scoop while A is cutting.

One can have a scoop rectangular as to its closed sides with a convex line between the cutting edges so curved that neither cutting edge would ever be on top. On the other hand, there may be a scoop at an angle, say of 130 degrees, with a concave line between the cutting edges in which both cutting edges would be always top when at rest, and one always top in operation. If the line were straight it would from edge to edge be the top when at rest, and one end would always be top in operation. As all angles and lines of junction are included in the applicants' provisional specification I see no valid reason for deciding in favour of the opponent.

If Dunlop were to pull his new machine back empty with a rope in the position of the tipping rope it would do exactly what it is assumed differentiates his invention from Cooper's, because the scoop would inevitably have that cutting edge below the other. But would that really constitute it an invention of a different nature?

If Dunlop is entitled to succeed because no point of the scoop is higher than the cutting edge of the back plate, it would either reduce his patent rights to a nullity to allow others to construct a scoop with a front so curved as to have some point higher than the back cutting edge, or else, if that would be considered an infringement, it demonstrates that Cooper's provisional specification does not inherently differ from his own complete, and shows



that Dunlop succeeds here because different names are used for the same thing. H. C. OF A.  
1908.

I desire to add specially on the question of fact respecting the later form of Cooper and McClelland's scoop that, the onus establishing inherent diversity resting on Dunlop, he has not discharged it.

DUNLOP  
v.  
COOPER.  
Isaacs J.

The whole weight of expert evidence so far as relevant is against him, the Commissioner has found the fact against him and I am not prepared to differ from him; on the contrary I agree with him. So far as I, having no expert knowledge, can form an opinion apart from specific evidence and based only upon the fuller description of the applicant's invention, I entertain the belief that what is finally claimed by Cooper constitutes no new invention different from that in his provisional specification, but a useful development properly and necessarily included in his complete specification. On this branch of the case the constant practice of the Commissioner, the aid of skilled officers, and his necessarily greater acquaintance with technical details would lead me to require a very strong case to come to an adverse view upon the question.

HIGGINS J. In my opinion there is not sufficient evidence to justify a finding that Cooper and McClelland obtained their invention from Dunlop, or a finding that Dunlop obtained his invention from Cooper and McClelland. As for Cooper and McClelland, the evidence shows that these applicants adhered to their double-bowl double-edge scoop even after lodging their provisional specification, and that the single-bowl scoop which appears in their complete specification was the result of a long course of study and experiment. As for Dunlop, the facts certainly looked suspicious against him, for he learnt from Cooper on 31st March that Cooper intended to patent an improvement in scoops, and Cooper appeared disposed to disclose his invention. Cooper also says (declaration No. 6 of 3rd July 1907) that he "confidentially described the shape of the scoop and the method we intended to adopt to make the reversible scoop do the work in a more economical way than the system we were then adopting." But (1) this disclosure is denied by Dunlop; (2) it is



H. C. OF A. significant that Cooper does not say *what he said* to Dunlop;  
1908. and (3) it is clear that if he disclosed anything at that time,  
DUNLOP 31st March, it would not have the essential features of Dunlop's  
v. invention—it would have been a double-bowl double-edge scoop,  
COOPER. with “diaphragm,” with tipping ropes attached to the “top”—a  
Higgins J. point half-way between the edges; and the scoop would there-  
fore not tip in such a way that the back would become the  
bottom and the bottom become the back. I see no sufficient  
ground for disbelieving Dunlop when he states (declaration of  
Dunlop, No. 7, 15th January 1907, paragraphs 7 and 8) that he  
studied the question of reversible scoops in consequence of a  
remark by Mr. J. G. Starr, C.E., and of seeing scoops working  
backwards and forwards at Yanco, New South Wales; and as  
the evidence was all mere written evidence, and we have as good  
materials for judging as to the veracity of the parties as the  
Commissioners had, I feel less hesitation in exercising my own  
judgment on this question of fact. To believe Dunlop on this  
point is quite consistent with surmising that his mind was  
stimulated on the subject, and his preparation for the provisional  
specification hastened, by his conversation with Cooper on the  
31st March.

But Dunlop's second objection is more serious. He objects,  
under sec. 56 (d) of the *Patents Act* 1903, “that the complete  
specification (of Cooper and McClelland) describes or claims an  
invention other than that described in the provisional specifica-  
tion, and that such other invention forms the subject of an  
application made by (Dunlop) in the interval between the leaving  
of the provisional specification and the leaving of the complete  
specification.” This is the only stage at which such an objection  
can be taken (*Patents Act* 1903, sec. 65). I agree with Mr.  
*Starks's* contention that for the purpose of this objection it is our  
duty to compare what is written in the provisional specification  
with what is written in the complete specification; and to find  
whether the invention described or claimed in the complete is  
comprehended under the description in the provisional. We have  
to find, by ordinary rules of interpretation, what is the invention  
that is “described” in each of the two documents. There is  
much evidence, put in on the issues as to obtaining or “cribbing”



the invention, tending to show that on 2nd April Cooper and McClelland had in their minds a double-bowl scoop, with a diaphragm, with tipping ropes attached to the "top"—a point half-way between the edges. But if the description in their provisional would include this and Dunlop's device also, I am of opinion that there is no disconformity within the meaning of sec. 56 (*d*). An applicant may not change or enlarge, by his complete, the class of machines denoted by his provisional specification; but he can safely limit the class (*Penn v. Bibby* (1)). Language is not necessarily ambiguous because it is comprehensive, because it is applicable to several machines which achieve the same purpose by substantially the same means, but with differences in detail. It was never meant, I think, that the Commissioner and the Court should, under this objection, inquire not only into the meaning of the words used, but also into the particular application of the words which was before the mind of the applicant.

But, in my opinion, the complete specification of Cooper and McClelland is not only not comprehended under their provisional, but it is inconsistent with it. I shall assume in their favour that in their short provisional these applicants by the words "reversible scoop" imply two cutting edges. But there is a vital difference between the place to which the tipping ropes are affixed according to the provisional, and the place to which they are affixed in the complete; and this difference involves an alteration in the whole structure of the scoop. In the provisional, the tipping ropes are "attached to the top of a scoop one on each side"; and this does not mean to the cutting edge that happens to be on the top for the time, for the hauling ropes are "attached to the front bottom corner of the scoop in each instance." The bottom remains the bottom throughout the process of hauling; and the top remains the top. But in their complete specification, the tipping ropes are attached to the ends of the cutting edges, and the scoop is tilted over in such a manner that the back becomes the bottom and the bottom becomes the back. This device renders the single-bowl formation necessary; it is an essential part of the complete specification; and it is just what

H. C. OF A.  
1908.

DUNLOP  
v.  
COOPER.

Higgins J.

(1) L.R. 2 Ch., 127, at p. 134.



H. C. OF A.  
1908.

DUNLOP  
v.  
COOPER.

Higgins J.

appears in Dunlop's provisional, and in Dunlop's complete, and does not appear in the provisional of Cooper and McClelland. This invention was not the subject of the provisional specification of Cooper and McClelland.

Under sec. 59 of the *Patents Act* 1903, it is our duty, therefore, to determine that the grant to Cooper and McClelland ought not to be made; and that the grant to Dunlop ought to be made. I do not think that on this appeal we are justified in considering any possible objections to Dunlop's patent which had not been taken under sec. 56. If the objections taken to the grant of his patent fail, we ought to say that the grant ought to be made. Whether the patent can be sustained in an action against Cooper and McClelland, or against any other person for infringement, is quite another matter.

*Appeal allowed. Declare that the grant of a patent ought to be made to the appellant and not to the respondents. Respondents to pay costs of appeal and costs before Commissioner, except so far as the latter were increased by the appellant's allegation that the respondents obtained their invention from the appellant. The respondents' costs of that issue to be set off. Costs to be taxed in this Court. Time for sealing patent extended to 30th November.*

Solicitors, for the appellant, *Maddock & Jamieson.*

Solicitors, for the respondents, *Gillott, Bates & Moir.*

B. L.