H. C. OF A. 1908.

LYONS v. SMART.

GRIFFITH C.J. delivered the judgment of the Court. Sec. 148 of the *Justices Act* 1890 does not govern Order XLVI. r. 14, which is a general rule prescribing a scale upon which the officer is to tax the costs, and has nothing to say as to the maximum amount that can be allowed. The only order on this motion will be that the appellant's costs of the motion be added to the costs of the appeal. I am of opinion, and my brothers agree with me, that this is a case in which no affidavits were needed, and therefore no costs of affidavits will be allowed on either side.

Order accordingly.

Solicitor, for the respondent, *Powers*, Commonwealth Crown Solicitor.

Solicitor, for the appellant, *A. E. Jones.*

B. L.

[PRIVY COUNCIL.]

INTERNATIONAL HARVESTER CO. OF AMERICA . . . . . } APPELLANTS;

AND

PEACOCK . . . . . RESPONDENT.

ON APPEAL FROM THE HIGH COURT OF AUSTRALIA.

PRIVY COUNCIL.* 1908.

June 25.

Patent—Infringement—Validity of patent—Combination—Specification—Prior publication—Patents Act 1890 (*Vict.*), (*No.* 1123), *sec.* 56.

Where a patent is sought for a combination of several parts, it is not necessary in the specification to distinguish between those parts which are old and those which are new.

*Present.—Lord Macnaghten, Lord Atkinson, Lord Collins, Sir J. H. de Villiers and Sir Arthur Wilson.

PRIVY COUNCIL.
1908.
INTERNATIONAL HARVESTER CO. OF AMERICA
v.
PEACOCK.

Sec. 56 of the *Patents Act* 1890 operates to protect a patent the specification of which contains several claims, one of which is identical in one of several claims in a specification for a prior patent granted out of Victoria, and is not limited to cases where there is absolute identity between the invention sought to be patented in Victoria and that in respect of which a patent has been granted out of Victoria.

A patent was granted in Victoria for rotary disc ploughs, and the specification contained several claims, each of them being for a combination. In an action by the patentee for an infringement:

Held, on the evidence, that each of the claims was new, was good subject-matter for a patent, and was useful, and that the patent was valid.

Decision of the High Court: *Peacock* v. *D. M. Osborne & Co.*, 4 C.L.R., 921, affirmed.

APPEAL to His Majesty in Council from the decision of the High Court: *Peacock* v. *D. M. Osborne & Co.* (1).

The judgment of their Lordships was delivered by

LORD COLLINS. This is an appeal by special leave from a judgment of the High Court of Australia (1), reversing the judgment of *à Beckett* J. of the Supreme Court of Victoria, who, in an action for infringement of a certain patent, had held the plaintiff's (the respondent's) patent bad for want of subject-matter, and ordering judgment in the said action to be entered for the plaintiff.

The patent in question related to certain improvements in rotary disc ploughs. The only points discussed in the Courts below arose on claims 1, 2, 5 and 7.

The only claim in respect of which infringement was alleged was claim 7, and the appellants did not dispute it, but they relied on want of utility, and also upon anticipation by the lodging at the Victorian Patent Office of the United States Official Gazette of 7th July 1896, some days before the respondent's patent, disclosing the invention claimed in claim 7 of the respondent's patent.

The question whether this document could be relied on as an anticipation depended upon sec. 56 of the Victorian *Patents Act* 1890.

(1) 4 C.L.R., 921.

à Beckett J., with regard to this claim, held that it was new and useful and good subject-matter, and that sec. 56 of the Statute was an answer to the suggested anticipation, but, inasmuch as he was of opinion that claims 1, 2 and 5 were bad for want of subject-matter, he dismissed the plaintiff's action (1).

On appeal by the plaintiff to the High Court the case was heard on six days, and a very elaborate judgment dealing minutely with each point raised was delivered by *Griffith* C.J., with whom *Barton*, *O'Connor* and *Higgins* JJ. concurred, adding some additional reasons. Cases turning on subject-matter often involve questions of considerable nicety, and this one is certainly near the line, but the elaborate and detailed judgments of the learned Chief Justice and his colleagues have removed all doubts from the minds of their Lordships, and they cannot but concur in their conclusions. They are quite satisfied that the several combinations claimed by the plaintiff were a real advance upon anything that had been before attempted. It would be a mere waste of public time to state over again in other language reasons which have been so fully set forth in the judgments already given; and on claim 7, the only one which raised a point of law, viz., the construction of sec. 56, both Courts were agreed. Their Lordships, therefore, will humbly advise His Majesty that the appeal be dismissed. The appellants will pay the costs.

(1) (1906) V.L.R., 375; 27 A.L.T., 207.