

H. C. OF A.
1909.

CADD
v.
CADD.

Appeal allowed. Judgment appealed from discharged. Judgment for the defendant on the claim and on the counter-claim for possession.

Solicitors, for the appellant, *Symon, Rounsevell & Cleland* for *Page, Moonta*.

Solicitors, for the respondent, *Nesbit, Webb & Nesbit* for *Uffindell, Moonta*.

B. L.

Cons R D
Werner & Co
Inc v Bailey
Aluminium
Products Pty
Ltd 85 ALR
679

Interpreted
R D Werner &
Co Inc v
Bailey
Aluminium
Products 13
IPR 513

Cons
R D Werner &
Co Inc v
Bailey
Aluminium
25 FCR 565

Expl
Gum v
Stevens (1923)
33 CLR 267

Appl
McGlashan v
Rabett (1909)
9 CLR 223

[HIGH COURT OF AUSTRALIA.]

THE LINOTYPE CO. LTD. (IN LIQUIDATION) . APPELLANTS;
OPPONENTS,

AND

MOUNSEY RESPONDENT.
APPLICANT,

ON APPEAL FROM THE COMMISSIONER OF PATENTS.

H. C. OF A. *Patent—Application for patent—Opposition—Want of novelty—Prior publication—*
1909. *Substantial identity—Want of inventiveness—Patents Act 1903 (No. 21 of 1903),*
sec. 56.

MELBOURNE,
June 1, 2, 14.

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

The word “novel” in sec. 56 (e) of the *Patents Act* 1903 is to be read in the sense in which it has always been used in patent law, and (*Higgins J.* dissenting) the objection permitted by that sub-section includes an objection that the alleged invention is substantially identical as to the degree of inventiveness with a process or “manner of manufacture” already known to the public, in other words, that the difference is not sufficient to differentiate that which has gone before from that which is claimed.

An application for letters patent for an alleged invention, for cleaning the two edges of the matrices of linotype machines by means of two pairs of brushes in two particular places, was opposed on the ground of want of

novelty. The objection based on a known invention for cleaning one edge of the matrices by means of a brush which might be placed at any part of the course of the matrices.

H. C. OF A.
1909.

—
LINO TYPE Co.
LTD.
v.
MOUNSEY.
—

Held (*Higgins J.* dissenting), that the alleged invention the subject of the application was substantially identical with that already known, and was therefore not novel, and that the application should be refused.

Per Higgins J. The alleged invention achieved substantially additional results by substantially additional means, and, as the objection of want of novelty does not allow the opponent to raise the question of want of sufficient inventiveness, the application should be allowed.

Morgan & Co. v. Windover & Co., 7 R.P.C., 131; *In re Todd's Application*, 9 R.P.C., 487; *Harwood v. Great Northern Railway Co.*, 11 H.L.C., 654, applied.

APPEAL from the Commissioner of Patents.

An application was made by William Henry Mounsey on 29th April 1907 for letters patent for an "improved matrix cleaner for linotype machines." The specification was as follows (omitting formal parts):—

"This invention is for the purpose of automatically cleaning the matrices of linotype machines every time they have been used and before they are placed in the magazine, and consists of two pairs of brushes, one pair being fixed on to the intermediate elevator channel plate, and another pair being fixed on to the distributor box, in such manner that the matrices, in being distributed from each line, shall pass the brushes one of each pair of which will rub against and clean the front side and the other the back side." (The specification then described the invention in detail by reference to drawings, and continued):—

"The operation of my invention is as follows:—

"After the line has been set and the type has been cast, and the matrices are being distributed, they pass the first pair of brushes attached to the intermediate elevator channel plate, and then later on they pass the second pair of brushes attached to the distributor box, and in so passing, the brushes remove all impurities from the matrices, which are deposited in the magazine in a clean condition ready to be used again.

"I am aware that single brushes have been fixed on or behind the distributor beam of linotype machines, by which one side

H. C. OF A. 1909.
LINOTYPE CO. LTD.
v.
MOUNSEY.

only of the matrices can be cleaned, and I disclaim the sole right of making such, my invention having reference to double brushes placed on the intermediate channel plate and on the distributor box of linotype machines.

“ Having now fully described and ascertained my said invention and the manner in which it is to be performed, I declare that what I claim is:—

“ In linotype machines two or more brushes attached to the intermediate elevator channel plate and two or more brushes attached to the front and back plate of the distributor box for the purpose of automatically brushing and cleaning both sides of the matrices after they have been used for forming a line of type and before they are distributed into the magazine all substantially as described and shown.”

The application was opposed by the Linotype Co. Ltd. (in liquidation), of London, England, on the grounds:—

“(1) That the invention is not novel or has been already in possession of the public with the consent or allowance of the inventor.

“(2) 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.”

Both objections were founded upon the specification of a patent for “improvements in linotype machines” granted to William Henry Lock and Henry John Gardner in England and published in the Commonwealth before the date of the application. The material portions of this specification are set out in the judgment of *Griffith C.J.* hereunder.

The Commissioner having dismissed the opposition, the opponents now appealed to the High Court from his decision.

Mann and *Sproule*, for the appellants. It being admitted that a single brush was used for cleaning one edge of the matrix, and might be used in any place in the course taken by the matrix, the use of a pair of brushes is not novel within the meaning of sec. 56 of the *Patents Act* 1903. The objection of want of novelty could not be taken in England to an application for a

patent, although it might be in an action in which the validity of the patent was in question. Under that objection the opponent may show that there is not sufficient inventiveness to distinguish the invention for which a patent is sought from the machine which was already known: *Morgan & Co. v. Windover & Co* (1); *In re Hedge's Application* (2). Want of invention is a subdivision of want of novelty: *Edmunds on Patents*, 2nd ed., p. 81. "To be new in a patent sense it is necessary that the novelty must show invention": *Blakey & Co. v. Latham & Co.* (3). "In order to sustain a patent for an article it must be new in the sense that the making of it involved an amount of invention": *American Braided Wire Co. v. Thomson & Co.* (4); *Thomson v. American Braided Wire Co.* (5).

H. C. OF A.
1909.
LINOTYPE CO.
LTD.
v.
MOUNSEY.

Levinson, for the respondent. Most of the cases relied on for the appellants are cases of infringement. In the case, however, of an application for a patent, the application will not be refused unless the grounds of opposition are clearly made out, and where the ground of opposition is want of novelty it must be shown that the invention sought to be patented and that already in use are substantially identical: *Edmunds on Patents*, 2nd ed., p. 256; *Tolson's Patent* (6).

[ISAACS J. referred to *Moore & Hesketh v. Phillips* (7); *In re Nanhse's Application* (8).]

From Lock's specification it cannot be said that a person without the necessity of making experiments would arrive at the applicant's invention: *Savage v. D. B. Harris & Sons* (9):—"Unless it can be said that the differences are practically immaterial, that there is no ingenuity in the second invention, no experiment necessary to show whether it can be usefully carried out or not, the second cannot be said to have been anticipated by the first": *Gadd v. Mayor &c., of Manchester* (10); *Frost on Patents*, 3rd ed., p. 147; *Willmann v. Petersen* (11).

[ISAACS J. referred to *Riekmann v. Thierry* (12).]

(1) 7 R.P.C., 131, at p. 139.

(2) 12 R.P.C., 136.

(3) 6 R.P.C., 184, at p. 187.

(4) 6 R.P.C., 113, at pp. 123, 124.

(5) 4 R.P.C., 316.

(6) 6 D.M. & G., 422.

(7) 4 C.L.R., 1411, at p. 1425.

(8) 17 R.P.C., 203.

(9) 13 R.P.C., 364, at p. 368.

(10) 9 R.P.C., 516, at p. 526.

(11) 2 C.L.R., 1.

(12) 14 R.P.C., 105, at p. 121.

H. C. OF A. The improvement on the old machine need not be great. It
 1909. is sufficient that there is an improvement.
 {
 LINTYPE CO. [He also referred to *Betts v. Menzies* (1); *Frost on Patents*,
 LTD. 3rd ed., vol. I., pp. 404, 462; *Booth v. Kennard* (2).]
 v.
 MOUNSEY.

— *Mann*, in reply, referred to *Spencer v. Jack* (3).

[ISAACS J. referred to *Saxby v. Gloucester Waggon Co.* (4).

HIGGINS J. referred to *In re Todd's Application* (5).]

Cur. adv. vult.

The following judgments were read:—

June 14.

GRIFFITH C.J. The respondent's application is for an "Improved matrix cleaner for linotype machines." The appellants gave notice of opposition to the grant on two grounds—(1) that the invention was not novel, (2) that it had been already described in a publication published in the Commonwealth.

The general principles of linotype machines are now tolerably well known, but it is necessary for the proper understanding of the questions raised on this appeal to give a short description of them. Under the original system the letters or symbols to be printed were formed in relief at the end of small pieces of metal so shaped as to be capable of being fitted close together so as to form connected lines of type from which a print could be taken, either directly or by means of an intermediate mould taken from the type, and from which in turn a fresh cast could be taken. Under the new system the letters are no longer formed in relief upon the end of the blocks, but are formed in intaglio on one edge of a small flat metallic plate, called a matrix, which is rectangular in form, having projecting shoulders at each of its four corners, and is of such a thickness as to represent the space to be occupied by the letter in the printing when set up. The edges of this plate are at a sharply defined right angle to its surfaces. On one edge of the matrix the mould of the letter which is to be printed by means of it is sunk in a recess. On the opposite edge, which has no recess, the same letter is marked on the surface. This is

(1) 10 H.L.C., 117.

(2) 1 H. & N., 527; 2 H. & N., 84.

(3) 11 L.T.N.S., 242.

(4) 7 Q.B.D., 305, at p. 307; W.N. (1882), 102.

(5) 9 R.P.C., 487.

spoken of as the indicating letter. From the upper edge of the matrix a portion is removed, so as to form a V shaped cut with straight sides, on each of which are small serrations so devised that the matrix can be suspended by means of them upon a bar of corresponding shape and with like serrations, called the distributing bar, at a stage in the operation of the machine to which I will directly refer.

H. C. OF A.
1909.
—
LINO TYPE CO.
LTD.
v.
MOUNSEY.
—
Griffith C.J.

When the machine is to be put into operation the matrices are collected or stored in separate compartments or magazines at the top of the machine. The compositor, instead of picking up a type and placing it in a composing stick, touches a key in a key-board, the effect being that the desired letter automatically leaves its magazine and descends by a properly constructed channel to a receptacle called the "assembly box," in which the matrices take up their position in due order until a complete line of type is assembled. The intaglio edges of the matrices are away from the compositor, but the indicating letters are visible to him, so that he can detect any error. The line thus "assembled" is then moved on until it comes opposite a receptacle containing molten type metal, which, being forced against the intaglio edges of the matrices, takes an impression or cast of the whole line. This is removed and used in the ordinary way for printing. The matrices then pass onwards through a series of channels or conduits constructed for the purpose, until they reach the part of the machine where the magazines are placed, into which they are automatically returned. For the greater part of the journey they travel closely pressed together, as when in the assembly box, the edges presenting a continuous surface. They are during this portion of their passage supported by the projecting shoulders already mentioned, which fit into grooves cut in the walls of the channels through which they pass. Upon approaching the place of distribution, however, they pass under a bar called the distributing bar, so constructed as to fit into the V shaped cut in the top of the matrix, having serrations on each side adapted to those of the matrices, and so devised that the matrices at first hang from the bar, but as each matrix comes above its own magazine the support fails, and the matrix drops into the magazine, ready to be summoned again by the compositor at the key-board. At

H. C. OF A. this stage the matrices are no longer pressed together, but are
1909. separated by short intervals so as to allow them to drop succes-
sively as they come above their respective magazines. At
LINOTYPE CO. several parts in the traverse, then, the matrices present a con-
LTD. tinuous surface, and are close to the wall of the channel through
v. which they are passing, but at the final stage they are separated,
MOUNSEY. and their edges are not in contact with the channel.
Griffith C.J.

In the course of use the edges carrying the indicating letters are apt to become dirty, so that the letters are scarcely legible, and means have been devised for cleaning them by means of brushes fixed so as to project through the walls of the channels or conduits and come in contact with the letters as they pass before them.

All this is common knowledge, *i.e.*, to persons conversant with linotype machines, which, however, differ in detail from one another, the general principle being as above stated.

I come now to Mounsey's application, which, as already said, is for "an improved matrix cleaner." The complete specification begins by saying that "the invention is for the purpose of automatically cleaning the matrices of linotype machines every time they have been used and before they are placed in the magazine, and consists of two pair of brushes, one pair being fixed on to the intermediate elevator channel plate, and another pair being fixed on to the distributor box, in such manner that the matrices in being distributed from each line shall pass the brushes, one of each pair of which will rub against and clean the front side and the other the back side."

The "intermediate elevator channel" referred to is a part of the machine through which the matrices pass, supported by the projecting shoulders as above described, immediately before reaching the place of distribution or distributor box.

The specification describes the means of the attachment of the brushes, which, shortly stated, is as follows:—An oblong slit is cut in the wall of the channel, through which a brush projects for a small distance into the channel itself, so that the edges of the matrices are rubbed by it in passing, two such brushes being affixed opposite to each other at the two points mentioned.

The claim is as follows:—"In linotype machines two or more

brushes attached to the intermediate elevator channel plate and two or more brushes attached to the front and back plate of the distributor box for the purpose of automatically brushing and cleaning both sides of the matrices after they have been used for forming a line of type and before they are distributed into the magazine, all substantially as described and shown."

H. C. OF A.
1909.

LINOTYPE CO.
LTD.
v.
MOUNSEY.

Griffith C.J.

The appellants oppose the grant on the grounds already mentioned; and in support of their opposition rely on a specification, which was published in Melbourne in February 1900, of an English patent for "Improvements in Linotype Machines" (called Lock's Patent) and in which the invention is described as consisting of an automatic cleaning device at which each matrix must clean the edge that carries its indicating letter, or at least so much of it as is immediately adjacent to the letter. The mode of fixing the brush involves nothing not in ordinary use. The place chosen by Lock for the process in the case of a Mergenthaler machine, which the inventor takes as an example, is the channel through which the matrices pass immediately after leaving the assembly box and before the cast is taken. But the specification says:—"The reason why the particular part *m* of the whole path through which a matrix passes from the time it leaves its magazine to the time it is returned thereto is chosen for such cleaning when the invention is applied to a Mergenthaler linotype machine is because each matrix is held during its passage through the slot *m* in a convenient position for being cleaned as and where the invention intends, and also because all of them are moved along in that position in the direction of the line of indicating letters *y* 99. The invention does not limit us as to where, in the whole path of the matrices, the cleaning shall be effected, because the invention allows the cleaning device being brought to bear upon the matrices at any part of that path which may be suitable for the purpose. The position of that part in the path may vary according as to whether the machine is a Mergenthaler or any other linotype machine."

The form of brush illustrated is a round one projecting through a round hole in the wall of the channel, but the specification says:—"The cleaning device is illustrated as large enough to clean only as much of the matrix edges as is adjacent to the

H. C. OF A. indicating letters. This is all that is necessary to keep them
 1909. legible, but the invention includes the device being large enough
 LINOTYPE Co. to keep the whole edge clean, if desired."

LTD.
 v.
 MOUNSEY. The applicant says in his specification that he is aware that
 Griffith C.J. single brushes have been fixed on or behind the distributor beam,
 by which one side only of the matrices can be cleaned, and
 disclaims "the sole right of making such."

Under the English patent law opposition to the grant of a patent on the ground of want of novelty is not allowed. In other countries, *e.g.*, the United States of America, novelty is a question to be investigated before the grant. The same rule was adopted in Queensland before the establishment of the Commonwealth, and is adopted in the Commonwealth *Patents Act* 1903. The reasons for the alteration are sufficiently obvious. Sec. 56 allows opposition to the grant of a patent on any of six grounds and no others, two of which are (*e*) want of novelty, and (*f*) prior publication. What is commonly and conveniently called want of subject-matter is not one of them. "Want of subject-matter" really means that the alleged invention is not a "manner of new manufacture," and involves two questions, whether it is a "manner of manufacture," and whether it is new. An objection that the alleged invention is for an idea only without any means specified for giving effect to it would fall under the first head. The objection that it was already in use or had been already patented would fall under the second. Proof of want of novelty is sufficient to support an objection for want of subject-matter, but it does not cover the whole ground open under that objection. Both terms have long been in use in patent law. In my opinion the word "novel" in sec. 56 (*e*) is to be read in the sense in which it has always been used in patent law. As applied to the present case it means that the alleged invention is substantially identical with a process or "manner of manufacture" already known to be public, or, to adopt the words of Sir R. Webster in *In re Todd's Application* (1), that the difference is not sufficient to differentiate that which had gone before from that which is claimed. This point was properly raised by a plea that the alleged invention was not new: *Saxby v. Gloucester Waggon Co.* (2).

(1) 9 R.P.C., 487.

(2) 7 Q.B.D., 305; 75 L.T. Jo., 167.

A rule now firmly established was thus laid down by Lord Westbury L.C. in *Harwood v. Great Northern Railway Co.* (1): "You cannot have a patent for a well-known mechanical contrivance merely when it is applied in a manner or to a purpose, which is not quite the same, but is analogous to the manner or the purpose in or to which it has been hitherto notoriously used." In *Gadd v. Mayor, &c., of Manchester* (2), cited in *Williamson v. Patterson* (3), Lindley L.J. said:—"A patent for the mere new use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties, is bad, and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention. . . . On the other hand, a patent for the new use of a known contrivance is good and can be supported if the new use involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own." *Morgan & Co. v. Windover & Co.* (4) (in the House of Lords), which was an action for infringement of a patent for affixing C-springs in front of carriages, affords a good illustration of the rule applicable to the issue of novelty. The defendant put in issue the novelty and the utility of the invention, and it appeared that such springs had already been used at the back of carriages. The following passage from Lord *Herschell's* speech (5) contains a clear exposition of the law applicable to such a case:—"Now, my Lords, if it had required mechanical ingenuity and skill to adapt the composite springs which had heretofore been used in the hind part of a carriage to the front part of a carriage, so that it was not the mere substitution in front in substantially the same way as the substitution had taken place at the back, but that it needed some skill and ingenuity to adapt to the front part of the carriage that which had been applied to the back, I should have thought that there was sufficient subject-matter and that the patent could have stood. But when once it is admitted that all that can be claimed as new is the idea of putting it in the front instead of at the back, and that when once the idea was enter-

H. C. OF A.
1909.LINOTYPE CO.
LTD.
v.
MOUNSEY.
Griffith C.J.

(1) 11 H.L.C., 654, at p. 682.

(2) 9 R.P.C., 516, at p. 524.

(3) 2 C.L.R., 1, at p. 17.

(4) 7 R.P.C., 131.

(5) 7 R.P.C., 131, at pp. 137, 8.

H. C. OF A. 1909.
LINOTYPE CO. LTD.
v.
MOUNSEY.
Griffith C.J.

tained, any workman told to do it would, without any instructions or any special mechanical skill, be able at once to do it, it seems to me that that really concludes the case against the respondents, because if their contention be well founded it would certainly be somewhat extensive in its consequences.

“It is said that it needed invention to make this substitution, and that this is obvious, because whereas for some period of time the substitution at the back of the carriage had been known, nobody thought of making the substitution at the front of the carriage, though, when made, people have found out its advantages; and a suggestion was made that this really was the attaining an end at which many people had been striving—namely, improving a C-spring carriage so as to do away with the perch. Here, again, I think the same confusion of idea comes in; it was not really the achieving that at which men had been aiming who were seeking to improve the C-spring; it was an act of a different nature altogether. It did not achieve the end at which they were aiming; it was not an adaptation of the C-spring in the sense in which that word is used in relation to many of these efforts at all events; it was the applying to a carriage something which possessed some of the advantages which the C-spring had possessed.

“Now, my Lords, if it were held that that was enough to constitute a new invention, just consider what consequences would follow. It is common knowledge that when a new mechanical contrivance, such as a new spring (and many other illustrations might be given) is first invented it is often a very considerable time before its advantages are seen and realized. Men are slow to try experiments, however successful they may turn out to be when once tried. But if the argument of the respondents were well founded, then if there was an invention of a new spring, let us say, for railway engines or carriages, and for some years no one had taken advantage of it in a particular part of an engine or carriage in which a spring was used until some one thought he would use it in that place, the first person who used it in that place could take out a patent for so using it and protect himself against all the rest of the world, and acquire a monopoly if it turned out that there were advantages in its use in that particular

place which had not occurred to anyone before. It seems to me, my Lords, that that would be extending the rights which are conferred upon patentees of new inventions beyond anything which preceding cases will justify." It will be seen that the question involved was treated as one of novelty, and not as one of utility.

H. C. OF A.
1909.
LINOTYPE Co.
LTD.
v.
MOUNSEY.
Griffith C.J.

In the present case, the appellants maintain that Lock's specification substantially describes all that is to be found in Mounsey's alleged invention. The only points of difference are (1) that by the applicant's invention the intaglio of the type upon the matrix is cleaned as well as the indicating letter; (2) that both edges are cleaned at once; (3) that they are cleaned twice instead of once only; and (4) that the places chosen for the cleaning and the shape of the brush are different. So far as the last points of difference are concerned, they are quite immaterial, since Lock had already told the public that the brushes might be brought to bear upon the matrices at any point of their path, and might be of any suitable shape. There is, therefore, nothing new in the mere selection of a different part of the path from that suggested by him, whether the newly suggested position is for other reasons a better position or not. As to the cleaning of the intaglio edge of the matrix, the case seems to me to be indistinguishable from *Morgan & Co. v. Windover & Co.* (1). The channels through which the matrices pass must necessarily have two sides or walls. The invention made known by Lock's specification was fixing a brush on one wall so as to rub the edge of the matrix as it passed. If any one desired to clean the other edge all he had to do was to put the brush on the other wall of the channel. The idea of brushing both edges does not, of course, constitute a new invention in the sense in which that term is used in patent law. With regard to the idea of brushing both edges at once, it is suggested, in the evidence, that if the brush were brought to bear on the matrices while suspended in the distributing box and were applied to one edge only, the delicate adjustment of the corresponding serrations might be endangered unless a corresponding pressure were brought to bear by another brush on the other edge. This seems to me to be no more than

(1) 7 R.P.C., 131.

H. C. OF A. 1909.
LINOTYPE CO. LTD.
v.
MOUNSEY.
Griffith C.J. saying that if the point chosen for the application of the brush is the distributing box, *i.e.*, a place presenting particular difficulties which do not occur elsewhere, an additional precaution should be used. I cannot think that this is novel in the sense already mentioned.

It is not, therefore, necessary in the present case to decide whether the absence of invention or ingenuity, as distinguished from substantial identity (if it can be distinguished), can be set up under an objection of want of novelty. I am strongly disposed to think that it can, at any rate where the absence is manifest. However that may be, the question of substantial identity is one of fact, which I think we are bound to determine for ourselves. I think the substantial identity is proved. That is sufficient to decide this case.

In my opinion, therefore, the opponents have established their objections, and the appeal should be allowed.

O'CONNOR J. I am of opinion that the patent applied for ought not to be granted. It is not denied that Lock's patent was made public in Melbourne in the early part of 1900, and that everything disclosed by his specification then became part of the common knowledge respecting linotype machines. The argument turned substantially on two questions. First, whether the applicant's invention differs in any real sense from Lock's. Secondly, if it does, whether the difference involved such an exercise of the inventive faculty as is necessary to constitute "a manner of new manufacture" within the meaning of the *Patents Act* 1903. The appellants objected to the latter question being raised, contending that sub-sec. (e) of sec. 56 of the *Patents Act* 1903 does not empower the Commissioner to determine that issue on an application for registration. The point is of much importance in the administration of the patent law, and is exceedingly arguable. If it were necessary to decide it on this appeal I would require a fuller argument than we have so far heard before coming to a conclusion. But in the view I take of the first question it becomes unnecessary to express any opinion on the objection. I shall, without repeating, adopt the description of the linotype machine and of the common knowledge existing in regard to its

mechanism and use as set forth in the judgment of my learned brother the Chief Justice, merely adding that in what I have to say I shall describe the edges of the matrices as the "indicating" edge and the "mould" edge respectively. The essential feature of Lock's invention is the automatic cleaning of the indicating edge of the matrices by means of a brush fixed on the side of the channel through which they pass on their round journey from the magazine back to the distributing box. The brush is placed at any portion of the channel which may be suitable for the purpose, and is so arranged that the indicating edge of each matrix must rub against it in passing. The applicant claims to register an invention which adapts the Lock system of automatic brushing to the cleaning at the same time of both edges of the matrix—the mould edge as well as the indicating edge. This is effected by brushes fixed in pairs opposite one another in the sides of the channel in two places—one or more pairs being attached to the intermediate elevator channel plate, and another or other pairs to the front and back plate of the distributor box. It is admitted that there is nothing new in the form of the brush or the method of attaching it to the plates, nor can it be contended that there is anything substantially new in applying Lock's method of automatically brushing one edge of the matrix to the cleaning of the other edge. The applicant in his specification, after disclaiming in substance the sole right of doing anything which could be effected by Lock's invention, states in these words what his own invention amounts to—"my invention having reference to double brushes placed on the intermediate elevator channel plate and on the distributor box of linotype machines." Taking, therefore, the applicant's own description, there are two features only, as it seems to me, in which he claims that his invention has gone beyond Lock's. First, in the use of brushes in pairs facing each other on opposite sides of the channel. Secondly, in selecting the point on the journey of the matrices at which the brushes are to be applied. As to the first, it may be conceded that the cleaning of the mould edge of the matrix is in one sense a different object from the cleaning of the indicating edge, which was the immediate object at which Lock was aiming. But Lock's invention was on the face of it capable of being applied to cleaning either edge or

H. C. OF A.
1909.

LINOTYPE CO.
LTD.
v.

MOUNSEY.

O'Connor J.

H. C. OF A. 1909.
 LINOTYPE CO. LTD.
 v.
 MOUNSEY.
 O Connor J.

both edges, and the applicant's alleged invention, apart from selecting the portion of the channel for brushing, amounted to no more than fixing a duplicate set of brushes on the opposite side of the channel. But that differs in no substantial way from Lock's invention: see Lord *Herschell's* observations in *Morgan & Co. v. Windover & Co.* (1). Whether the mould edge or the indicating edge is to be cleaned, it is the application of Lock's method to one or other or both sides of the channel that effects the cleaning. There is therefore nothing new in that portion of the applicant's claim. As to the second feature claimed as novel the same considerations apply. A paragraph in Lock's specifications contains the following passage:—"The invention does not limit us as to where in the whole path of the matrices the cleaning shall be effected, because the invention allows the cleaning device to be brought to bear upon the matrices at any part of that path which may be suitable for this purpose." Earlier in the same paragraph the "whole path of the matrices" is explained to be "the whole path through which a matrix passes from the time it leaves its magazine to the time it is returned thereto." Lock might therefore at any time have fixed his brushes at the very points which the applicant's invention has selected. In other words, Lock in his patent had already potentially selected those points for the application of his brushes. There was nothing therefore in the selection of points for attaching the brushes that had not been already discovered and made known by Lock's specification. For these reasons I am of opinion that the applicant's specification does not describe anything which is not to be found in Lock's specification, that his alleged invention adds nothing to the common stock of knowledge respecting linotypes in existence at the date of his application, and that his alleged invention is therefore not novel within the meaning of sec. 56 sub-sec. (e). It follows that the appeal must be allowed, and a declaration made that the patent ought not to be granted.

ISAACS J. The only objection to the grant of the patent is that the invention is not new. The stage at which the objection is taken cannot alter its meaning, though it does, in my opinion,

(1) 7 R.P.C., 131, at pp. 137-8.

affect the amount and strength of the evidence with which the Court may be satisfied. A decision adverse to the applicant is final, and entirely shuts him out from a possible meritorious claim, and this is a serious consideration; a decision in his favour, on the other hand, is not conclusive, but leaves the question open to further agitation on possibly fuller materials. I adhere to what I said as to this in *Moore and Hesketh v. Phillips* (1).

H. C. OF A.
1909.
LINOTYPE Co.
LTD.
v.
MOUNSEY.
Isaacs J.

But the Court is still bound to see that the ground on which the claimant stands is, at all events, substantial—though it may eventually, on further proceedings, prove to be untenable—and the claim must be reasonable, having regard to all the facts adduced. The applicant asks for a monopoly against the public, and these proceedings in opposition are intended by the Act as some real protection against creating, even *prima facie*, a privilege which, on examination, the Court is satisfied ought not to be created.

Now the claim is a monopoly of the right of placing brushes parallel with each other on opposite sides of certain parts of a linotype machine. Lock's patent clearly shows how one brush may be placed at the side of the machine, and at any part of it, that is, any part where a brush may be placed at all. It requires no expert knowledge, and needs no expert evidence, to tell me that Lock's device might be put on either side, and if on either side, on both sides. If the operator observed the matrices to be in need of cleaning on the operative side, it would obviously require no invention to put Lock's brush on that side instead of on the other side, and the applicant's claim does not reach such a case or contest the right so to apply Lock's brush. But, says the applicant:—"I do object to your cleaning both sides, even with Lock's brushes, at the same time. You may put them anywhere you like provided they are not opposite each other: and you may even have them opposite each other, provided you do not put them in the two places I have selected as the places where the last particles of adhering matter may be brushed off."

He says that is novel. Now, the test of novelty is laid down by Lord *Hatherley* in *Cannington v. Nuttall* (2) in these terms:—"I take it that the test of novelty is this: Is the product

(1) 4 C.L.R., 1411, at p. 1425.

(2) L.R. 5 H.L., 205, at p. 216.

H. C. OF A. 1909.
 LINOTYPE CO. LTD.
 v.
 MOUNSEY.
 Isaacs J.

which is the result of the apparatus for which an inventor claims letters patent, effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view."

The "product" here is the cleaning of the sides of matrices. Has the applicant, by some new apparatus, as a combination succeeded in cleaning the sides of matrices more effectively than could have been done by Lock's method? It is not a sufficient answer that Lock only referred to one side of the matrix. In the case I put in argument of a man describing how one side of a horse might be brushed, it would be no new invention to apply what is really the same process to the other side of the animal also.

The law as to this is laid down in *Riekmann v. Thierry* (1) by Lord Davey (with whom Lord Macnaghten concurred). Lord Davey said:—"Now, the law upon this subject, I believe, is all to be found in the case in this House of *Harwood v. Great Northern Railway Co.* (2). The proposition there accepted and laid down was that 'a mere application of an old contrivance in the ordinary way to an analogous subject, without any novelty in the mode of applying such old contrivance to the new purpose, does not make a valid subject-matter of a patent.' The law thus laid down has never since been doubted, though whether it has always been consistently followed or rightly applied may be open to question. It is not enough that the purpose is new and that there is novelty in the application, so that the article produced is in that sense new, but there must be some novelty in the mode of application. By that I understand, that in adapting the old contrivance to the new purpose, there must be difficulties to be overcome, requiring what is called invention, or there must be some ingenuity in the mode of making the adaptation." And Lord Halsbury's observations *in arguendo* (3) are to the same effect.

The respondent answers this by saying that those observations relate entirely to subject-matter as distinct from novelty, and do

(1) 14 R.P.C., 105, at p. 121.

(2) 11 H.L.C., 654.

(3) 14 R.P.C., 105, at p. 114.

not apply to the objection here that the invention is not new because anticipated. I think an effective reply is afforded by the case of *Arnot v. Dunlop Pneumatic Tyre Co. Ltd.* (1). It was an action in the Scottish Courts for infringement of Lenson's patent. The defendants attacked the validity of the patent. The articles made under it were a commercial success. The Lord Ordinary held that it was both new and useful, and after dealing with its features said (2):—"This being so, I do not think that much need be said about utility or subject-matter." Then he proceeded to observe:—"As to anticipation, however, there is no doubt something to say." He examined the description in Lenson's patent with that in a previous patent—Parnall's—and arrived at the conclusion that there was no anticipation; because there was modification of Parnall's patent, and because Parnall's object was different and had no special relation to the particular articles and advantages indicated by Lenson.

On appeal before Lord *Dunedin* (Lord President) and Lords *Adam* and *Kinnear*, the decision was reversed. The learned Judges agreed there was an infringement. "But," said Lord *Dunedin* (3), "the point on which I am constrained to differ from the Lord Ordinary is the point which arises upon the prior specification of Parnall, because if the prior specification of Parnall really disclosed the so-called invention of Lenson, for which he got his patent, then of course the case must be at an end, because the patent is bad. I am of opinion that the invention, such as it is, was entirely disclosed by the prior specification of Parnall, and that anyone having Parnall's specification before him could construct what I may term the Lenson covering without the addition of any inventive faculty at all."

On appeal to the House of Lords, Lord *Loreburn* L.C. quoted the latter part of the Lord President's words already mentioned, and said that that put the case in one sentence. He added (4):—"I do not think that the *difference*, which is a diminutive difference, between the two constitutes *any real invention*." Now the three Courts dealt with the question of novelty—that is

H. C. OF A.
1909.
LINOTYPE CO.
LTD.
v.
MOUNSEY.
Isaacs J.

(1) 22 R.P.C., 105, *id.*, 472; 25 R.P.C., 309.

(2) 22 R.P.C., 105, at p. 108.

(3) 22 R.P.C., 472, at p. 475.

(4) 25 R.P.C., 309, at p. 312.

H. C. OF A. 1909.
 {
 LINOTYPE CO. LTD.
 v.
 MOUNSEY.
 ———
 ISAACS J.

anticipation or no anticipation—on the same footing. But the two superior Courts looked at the two specifications to ascertain whether there was any real invention in the later one which was not already contained in the earlier, and finding there was none, held that the former anticipated the latter entirely, which is only another way of saying the latter contained nothing new. *Saxby v. Gloucester Waggon Co.* (1), is to the same effect, where *Field J.* said with reference to an objection of want of novelty:—"It was admitted by both parties that the question to be decided was one of fact, whether or not the invention specified was such a substantial improvement on what had already been known and published as to render it the proper subject of the patent within the rule stated by Lord *Westbury* in *Spencer v. Jack* (2)."

The respondent's contention is opposed to these cases. The respondent says the purpose is new, the application is new, and the article produced—namely, the cleaning of the matrices—is in that sense new. Lord *Davey* says that is not sufficient. What is the suggested novelty in the mode of application? Nothing but putting the brushes opposite one another; I put the places selected aside, because Lock's claim covered all suitable places. But putting the brushes opposite is not new in the sense necessary for this purpose; it is not new as applied to invention.

The root of the matter, which is altogether one of fact, is this: The apparatus consisting of double brushes placed along the sides of the machine, opposite each other, is an invention undoubtedly, but as an invention is certainly not entirely new. Admittedly some part of that invention is old; brushes are old, the screw is old, affixing a brush to one side is old, the method of attaching and regulating a brush is old, cleaning one side of the matrix is old, and the question, therefore, is how much is old, and how much is new?—that is, new in the sense used in the *Patents Act*, because "new" has various meanings. A hat may be called new because it has never been worn, or in another sense because it is of a somewhat uncommon shape, but you could not, for either of those reasons, call it new in a patentable sense.

Mr. Justice *Field*, speaking for the Supreme Court of the United States, puts the matter very clearly in *The Milligan &*

(1) 7 Q.B.D., 305, at p. 307.

(2) 11 L.T. (N.S.), 242.

Higgins Glue Co. v. Upton (1), and as an illustration is well worth quoting, notwithstanding the existence of the authorities already referred to. He said :—"A distinction must be observed between a new article of commerce, and a new article which, as such, is patentable. Any change in form from a previous condition may render the article new in commerce ; as powdered sugar is a different article in commerce from loaf sugar, and ground coffee is a different article in commerce from coffee in the berry. But to render the article new in the sense of the patent law it must be more or less efficacious, or possess new properties by a combination with other ingredients ; not from a mere change of form produced by a mechanical division. It is only where one of these results follows that the product of the compound can be treated as the result of invention or discovery, and be regarded as a new and useful article."

H. C. OF A.
1909.
LINOTYPE Co.
LTD.
v.
MOUNSEY.
Isaacs J.

Therefore I accept the whole of the combined apparatus described by the applicant as an invention. If he were the first in Australia to devise it, undoubtedly it would be new ; but in view of Lock's patent and the common knowledge previously existing, I come to the conclusion clearly and without hesitation that in fact the invention is old. There is no substantial difference between the invention comprised in previously existing knowledge and that comprised in the applicant's invention. The essence of it all is old ; its substance was already included within the bounds of public knowledge, and nothing was added to the old device except a mechanical arrangement which not only persons highly versed in the trade would be expected to employ where the necessity called for it, but would be suggested by commonsense to any person acquainted with Lock's mechanism and using the ordinary experience of life. The case falls short of the requirements of a patentable combination (see *Moore and Hesketh v. Phillips* (2)).

As to the general statements in the declaration that invention and experiment were required for the applicant's device, there are two observations to be made. First the applicant's own statement is open to the reflections of Lord Davey in *Riekmann's Case* (3) ;

(1) 97 U.S., 3, at p. 6.

(2) 4 C.L.R., 1411, at p. 1426.

(3) 14 R.P.C., 105, at p. 122.

H. C. OF A. and the corroborative witnesses are careful to add qualifying
1909. words, namely, "to apply a pair of brushes as the applicant has
done." But the claim, as learned counsel for the respondent
LINOTYPE CO. stated, would debar even Lock's device from being used on
LTD. both sides at the places designated. It was boldly put that Lock
v. himself would infringe the applicant's patent if he put two of his
MOUNSEY. brushes opposite each other within the limits selected by the
Isaacs J. applicant.

I attach very little importance in the circumstances to the so-called expert testimony. It has not condescended on particulars, or explained what is meant by the declarants when they use the words "experiment" or "inventive skill," and with the materials before us, it appears altogether a matter of common knowledge and commonsense added to Lock's device.

In my opinion, therefore, the objection has been sustained and the appeal should be allowed.

HIGGINS J. Mounsey's specification, and the nature of his alleged invention, have been already amply described. What he says, in effect, is that somebody else had already used the device of a single brush to clean the indicator edge of the matrix as it passes; but that his claim is for the device of two sets of two brushes, each set at two definite points, to clean not only the indicator edge, but also the edge which contains the mould for the letters. This statement, from which I exclude all matters in controversy, is sufficient to show that the applicant achieves substantially additional results by substantially additional means, as compared with Lock and Gardner—on whose British specification deposited in the Australian Patents Office, but not subject of a patent grant here, the opponent company relies. It was not denied in argument that the double brushing process, on both edges of the matrix, involves a clear addition in fact to the single brush device. But it was contended strongly that the quadrupling of the brushes in the manner described does not involve sufficient inventiveness on the part of the applicant to justify the grant of letters patent for the sole right to make, use, exercise and vend this additional device.

Now, the objection as stated, and as allowed by the Act, is

that the applicant's "invention is not novel." The first question, to my mind, is—is it open to the opponents under this objection to urge that the applicant has not shown sufficient inventiveness in his additional device. It is admitted that want of inventiveness could be taken as a defence to an action under another plea—shortly called "want of subject-matter." The form of the objection allowed by sec. 56 (e), is "that the *invention* is not novel"; but according to sec. 4 ("invention") the word "invention" includes an *alleged* invention; so that the objection should be read:—"That the *alleged* invention is not novel." It means:—"Even if what you allege to be an invention is an invention—even if it shows sufficient inventiveness—it is not new: some one else discovered it before, and made it available." It follows that, so far as the form of this objection is concerned, the Court has not to go into the truth of the allegation that the added matter is an invention—a true invention involving sufficient inventiveness—and has merely to consider, is the added matter (if any) new—has it been used or known before?

Under our law, a grant of letters patent is no guarantee to the holder of the grant that he has patent rights, that he has a property which he can assert against the world. If, after he obtains the grant, he bring an action for infringement, the defendant may plead that "the invention is not new," that "the invention is not useful, that the invention is not one for which letters patent could by law be granted," or that "the plaintiff is not the true and first inventor" (see *Bullen and Leake*, 4th ed., p. 448). These defences are quite distinct, logically and in practice, although it often occurs that the same facts are used to support more than one of these defences, and from the nature of the patent cases some confusion of expression has therefore often crept into arguments, and even into judgments. But, inasmuch as our Act, sec. 56, allows objection on any of six definite grounds "*but on no other*," it becomes necessary for us to keep steadily to the accurate meaning of "not novel." The meaning of "not novel" may be taken to be the same as in an action for infringement. The meaning certainly is not wider.

No doubt the reason that Parliament has not allowed defences of "not useful," or "not one for which letters patent could by

H. C. OF A.
1909.
LINOTYPE Co.
LTD.
v.
MOUNSEY.
Higgins J.

H. C. OF A.
1909.
LINOTYPE Co.
LTD.
v.
MOUNSEY.
Higgins J.

law be granted,” or “not the true and first inventor,” to be raised at this stage, is to prevent the machinery of the Patents Office and of the Courts from being blocked by inquiries of the most delicate and difficult character, made on such unsafe materials as mere statutory declarations, instead of full *vivá voce* evidence with cross-examination—inquiries which, when the patent is granted, give no finality as to rights. The object of objections at this stage is to prevent grants from being made which are obviously and hopelessly bad, and which put the public to expense and annoyance. In England, under the Act of 1883, there are only two kinds of objections allowed to be taken; in Australia there are six. In England even the objection of want of novelty is treated as being too delicate to be taken in this crude fashion; but in Australia it has been allowed. Moreover, our duty now is not to decide whether the patent will hold good or not, but “*whether the grant ought or ought not to be made*” (sec. 59). It is one thing to refuse a grant, for what it may be worth; and quite another thing to declare the grant invalid after it has gone through the ordeal of an action for infringement. When a patent is refused, the applicant never gets afterwards the opportunity of fully testing his right; and therefore the practice of the Courts has always been to lean in favour of the grant, and not to interfere with the Registrar granting a patent (as here), unless he is clearly and indubitably wrong (see *Tolson’s Patent* (1)).

Does, then, the objection “that the *alleged* invention is not novel” involve the objection that “the invention is not one for which letters patent could by law be granted?” This latter objection is usually called, for brevity, an objection for want of subject-matter. In England, as I have said, an objection for general want of novelty is not allowed; but an objection is allowed to the same effect as our sec. 56 (c), that the invention has been patented on an application of prior date. There was an application made to Sir Richard Webster A.-G., for a patent for stoppering bottles, *In re Todd’s Application* (2), and he decided against the applicant on this ground of a prior patent. He admitted that it is only “in the clearest possible case that a

(1) 6 D.M. & G., 422.

(2) 9 R.P.C., 487.

patent ought to be stopped;" but he found the mode of attaching the cork to the capsule was in each case identical. And he used these words—words which come with great weight from one of the most eminent authorities on patents as counsel, as Law Officer, as Master of the Rolls (1):—" *I have not to deal with subject-matter properly so called; that is to say, supposing Todd's invention to have been the first invention brought before me, it would not matter whether it showed no subject-matter, if it was a claim to that which had not been done before; I quite agree I have not to consider whether it is subject-matter or not. But when there is a previous anticipatory patent it is necessary to consider then indirectly the differences, and without saying whether those differences form subject-matter or not, to decide whether the differences are sufficient to differentiate that which has gone before from that which is now claimed.*" So here, the question is, is there a substantial margin in fact between Lock and Gardner's device and the applicant's; and if there is, there is novelty, whether the novelty shows sufficient inventiveness or not. The same ground was taken by Sir John Rigby S.G. in *In re Boulton's Application* (2); and Sir Robert Finlay S.G. in *In re Wylie and Morton's Application* (3). But in the case last mentioned, we have a good instance of the double use of the word "invention"—either a device properly patentable, or a device alleged to be patentable. In a previous patent, Gatty had specified for a dyeing process soluble salts of chromium and soluble salts of iron. The applicants claimed bisulphite of chromium (which is a soluble salt of chromium) and bisulphite of iron (which is a soluble salt of iron). The applicants had added *nothing*, whether showing inventiveness or not; and it was held, therefore, that the patent should be refused. Sir Robert *Finlay* S.G. said (4):—"I am not satisfied that the applicants have shown any invention with reference to the process which they propose to use." The meaning in this case is obvious; for there was nothing additional at all. There was no "invention," for there was nothing more than in the prior patent. The same explanation applies to *In re Hedges' Application* (5). One point was

H. C. OF A.
1909.
LINOTYPE Co.
LTD.
v.
MOUNSEY.
Higgins J.

(1) 9 R.P.C., 487, at p. 488.

(2) 10 R.P.C., 275.

(3) 13 R.P.C., 97.

(4) 13 R.P.C., 97, at p. 99.

(5) 12 R.P.C., 136, at p. 137.

H. C. OF A. found in an opponent's patent; another was in daily use: "When
 1909. those parts are struck out nothing remains which, to my mind,
 LINOTYPE Co. can properly form the subject-matter for a patent."

LTD.
 v.
 MOUNSEY. The case of *Saxby v. Gloucester Waggon Co.* (1), is at first
 Higgins J. sight inconsistent. The plaintiff brought an action for infringement
 of his patent of 1874 for interlocking apparatus in railway
 points and signals. But, under a plea of want of novelty, it was
 proved before a referee that *every element* of the patent was to
 be found in previous patents of 1870 and 1871, and there was no
 new result. The two alleged inventions were substantially
 identical in fact. This would be conclusive against the plaintiff,
 even without a plea of "not sufficient subject-matter for a
 patent." But counsel for the plaintiff urged that his invention,
 as it combined the previous patents, was such a substantial im-
 provement on what had been already known as to render it the
 proper subject of a patent. The Court of Queen's Bench, speak-
 ing through *Field J.*, held against the plaintiff, and discussed the
 want of inventiveness as if it came under the defence of want of
 novelty. But the learned Judge was careful to point out that
 both parties *admitted* "that the question to be decided was one of
 fact, whether or not the invention specified was such a substantial
 improvement on what had already been known and published as
to render it the proper subject of a patent" (2). This admission,
 such as it is, goes no further than the plaintiff's counsel's view of
 expediency in a particular case, where want of inventiveness
 appeared under another plea, and would be as dangerous if taken
 thereunder as under the plea of want of novelty. Pleadings are
 merely means to an end; and in this case the parties and the
 Court were content to discuss the point as to inventiveness under
 the plea as to novelty. Moreover, nothing is more natural than
 to confuse in ordinary talk novelty in inventiveness with novelty
 in actual manufacture ("new manufactures," within the Statute
 of James I.); and yet the latter is the meaning of "novel" in
 the plea of not novel. This appears more clearly in the earlier
 cases when issues were more precise than they are now. In
Walton v. Potter (3), it was held that, under the plea of want of

(1) 7 Q.B.D., 305.

(2) 7 Q.B.D., 305, at p. 307.

(3) 1 Web. Pat. Rep., 597, at p. 601.

novelty, the defendant could not be allowed to show that the invention was one for which in point of law a patent should not be granted. And the converse holds good—under a plea that the alleged invention is not a matter for which letters patent could be granted, it is laid down that such a plea does not put in issue novelty: *Booth v. Kennard* (1). These cases are treated as still being law in the last edition of *Frost on Patents* (1906, 3rd ed., vol. I., pp. 403, 404), and in *Edmonds on Patents* (1897, 2nd ed., p. 389). The point was left in doubt by *Ridley J.* in *Electrolytic Plating Apparatus Co. v. Holland* (2); but the authorities were not cited, and the point was unnecessary for the decision. In *Spencer v. Jack* (3), the Lords Justices, in sending issues to a jury in a patent suit, deliberately separated the issues:—(1) Whether the plaintiff's invention constituted a new manufacture, and (2) whether it constituted a new *invention*: see the same case after issues found (4). Except *Saxby v. Gloucester Waggon Co.* (5), no case has been cited to us in which want of inventiveness has been treated as coming under the plea of want of novelty; and that case, as I have shown, turned on an express admission made by counsel, under special circumstances, for the purposes of that case only. All the cases in which the Court has decided against the patentee on the ground of want of inventiveness have been actions of infringement, in which the plea of want of subject-matter has been pleaded as well as the plea of want of novelty. Such was the case in *Morgan & Co. v. Windover & Co.* (6).

Such again was the position in the recent case of *Arnot v. Dunlop Pneumatic Tyre Co.* (7). In an action for infringement of a patent for driving aprons, the Lord Ordinary found that the plaintiff's invention "had sufficient merit, *if new*, to make it patentable" (8). It was new, if not anticipated by Parnall's patent; and the Lord Ordinary held that there was no anticipation, and granted an interdict. On appeal to the Inner House, however, it was held that there was anticipation—that Parnall's

H. C. OF A.
1909.

LINOTYPE CO.
LTD.

v.
MOUNSEY.

Higgins J.

(1) 1 H. & N., 527.

(2) 18 R.P.C., 521, at pp. 526-7.

(3) 3 D.J. & S., 346.

(4) 11 L.T.N.S., 242.

(5) 7 Q.B.D., 305.

(6) 7 R.P.C., 131.

(7) 22 R.P.C., 105; id. 472; 25 R.P.C., 309.

(8) 22 R.P.C., 105, at p. 108.

H. C. OF A. patent in fact contained all that was described in the plaintiff's
 1909. patent—and something more—an “underneath platform”—
 LINOTYPE CO. material underneath the soles of the feet. This decision was
 LTD. affirmed by the House of Lords. The case turned wholly on the
 v. facts. There was no argument as to the distinction between
 MOUNSEY. want of novelty and want of subject-matter, for the case turned
 Higgins J. wholly on anticipation, not on ordinary want of novelty. There
 was no overruling of the previous cases to which I have referred,
 or even reference to them. If the question of inventiveness could
 not be discussed under the plea of anticipation, it could have been
 discussed under the other plea of want of subject-matter, so that
 there was no use in arguing as to the precise scope of each plea.
 The only thing which gives the case any importance for present
 purposes is a form of expression used by the Inner House in a
 sentence which was approved by the House of Lords—that the
 plaintiff's invention “was entirely disclosed by the prior specifica-
 tion of Parnall, and that anyone having Parnall's specification
 before him could construct what I may term the Lenson cover-
 ing without the addition of any inventive faculty at all” (1).

This last phrase is not felicitous in any aspect. I presume that
 the meaning is “without the addition of anything the result of
 inventive faculty” or “without the use of any further inventive-
 ness.” Why, it is asked, does the learned Judge refer to inventive
 faculty if the objection of “prior patent” does not include want
 of inventive faculty? The question assumes that, if the objection
 of prior patent involves the question of inventiveness, the plea
 of mere want of novelty involves it also—which is by no means
 clear. But whether this assumption is correct or not, it is clear
 that the attention of the Court was not directed to the difference
 between the two issues of prior patent and want of subject-
 matter, both having been pleaded; and that in using the phrase
 in question the Court did not mean to lay down any principle, or
 to decide anything except this—that the plaintiff's invention had
 nothing new in it—that the plaintiff had invented nothing new—
 using the word “invented” in its secondary and broader sense.

Moreover the expressions of the Law Lords in *Riekmann v. Thierry* (2) put the matter beyond all doubt, to my mind. The

(1) 22 R.P.C., 472, at p. 475.

(2) 14 R.P.C., 105.

patent was for an eyelet for boots. The House of Lords, Lord *Shand* dissenting, held, in an action for infringement, that there was not sufficient inventiveness to constitute the subject-matter of a patent. Lord *Halsbury* L.C. assumed that the article was "novel" (1); yet "a thing may be new, but unless it has some invention it is not patentable." Even Lord *Shand* distinguished between the objection for want of novelty and the objection for want of ingenuity (2). Lord *Davey* also distinguished between *new* and *patentable*—the thing may be new and yet not proper subject-matter for a patent; and Lord *Davey's* words are adopted "in every particular" by Lord *Macnaghten* (3). Lord *Davey* says (4): "If the learned counsel meant only that a new and useful article, *in the production of which there is invention*, is the proper subject of a patent, I suppose nobody will disagree with him. But if he means that an article which is new in the market is therefore proper subject-matter for a patent, irrespective of the question whether the production of it was the result of invention, I do not agree, and I am of opinion that it is not the law." See also *per Bowen* L.J. in *American Braided Wire Co. v. Thomson & Co.* (5); and *per Lord Herschell* in the House of Lords in *Thomson v. American Braided Wire Co.* (6). I take, therefore, the true meaning of the plea of want of novelty in a action for infringement from those cases never overruled. I cannot bring myself to think that the same objection—want of inventiveness—may now be taken under either of two separate pleas—not novel, and no sufficient subject-matter. I think that the old rule has not been changed—the rule as laid down in so many cases of high authority. The point becomes of considerable practical importance in this Court, in view of the marked increase in applications and of the prolonged discussions, in connection with the registration of patents and other such preliminary skirmishes, on mere statutory declarations. In my opinion Parliament never intended that questions as to the fact or the amount of inventiveness should be determined in this unsatisfactory fashion. Of course, if, as is now suggested, there is in the

H. C. OF A.
1909.
LINOTYPE CO.
LTD.
v.
MOUNSEY.
Higgins J.

(1) 14 R.P.C., 105, at p. 114.

(2) 14 R.P.C., 105, at p. 118.

(3) 14 R.P.C., 105, at p. 117.

(4) 14 R.P.C., 105, at p. 121.

(5) 5 R.P.C., 113.

(6) 6 R.P.C., 518, at p. 526.

H. C. OF A. 1909.
LINOTYPE CO. LTD.
v.
MOUNSEY.
Higgins J.

applicant's patent no addition in fact to the single brush device— if the applicant's alleged invention is substantially identical with that of Lock and Gardner—there is an end of the matter. If there is no difference in fact, there can be no novelty. But such a position is, to my mind, simply unthinkable, when I regard the single brush for the indicator edges, placed anywhere in the course of the matrix, in the earlier specification, and the double sets of brushes, four in all, placed at two definite points to brush the edge that has the mould for the letters as well as the indicator edge. For the reasons stated, I think that the appeal should be dismissed.

Appeal allowed. Declaration that the patent ought not to be granted. Costs of the appeal and of the proceedings before the Registrar to be taxed in the High Court and paid by the respondent.

Solicitors, for the appellants, *Waters & Crespin.*

Solicitors, for the respondent, *Braham & Pirani.*

B. L.