

Interpreted D Werner & Inc v Leys Aluminium ducts 13 R 513	Cons R D Werner & Co Inc v Bailey Aluminium Products Pty Ltd 85 ALR 679	Foll Acushnet Co v Spalding Aust Pty Ltd 17 IPR 136	Cons R D Werner & Co Inc v Bailey Aluminium 25 FCR 565	Foll Bristol-Myers Squibb Company v L'Oreal (1992) 25 IPR 443	Expt Gum v Stevens (1923) 33 CLR 267	Appl Stamp v W J Powell Pty Ltd (1918) 24 CLR 339	Appl Pharma- cia Aktiebolag v Ueno Fine Chemicals Industry Ltd (1995) 34 IPR 445	Refd to F Hoffman-La Roche AG v New England Biolabs Inc (2000) 176 ALR 108
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[HIGH COURT OF AUSTRALIA.]

McGLASHAN AND ANOTHER APPELLANTS;

APPLICANTS,

AND

RABETT RESPONDENT.

OPPONENT,

ON APPEAL FROM THE REGISTRAR OF PATENTS.

Patent—Claim for combination of appliances—Opposition—Want of novelty —

Patents Act 1903 (No. 21 of 1903), sec. 56.

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When an application for a patent is opposed on the ground of want of novelty under sec. 56 of the *Patents Act* 1903, the onus is on the opponent to establish that the patent if granted would be clearly bad on that ground.

SYDNEY,

Aug. 5, 6.

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

In an application for a patent of an improved appliance for spreading ballast, the improvements claimed consisting in modifications of existing appliances used for the same purpose, and also in a combination of features not previously combined in one appliance ;

Held, that it was immaterial whether the modifications relied upon were substantial inventions or not, if the combination was new, and that a patent should be granted for the combination unless the opponent established that it was not substantially different from some combination already in use.

On an application for a patent of an invention it is not open to an opponent under sec. 56 of the *Trade Marks Act* 1903 to take the objection that the alleged invention does not involve any real exercise of the inventive faculty.

Linotype Co. Ltd. v. Mounsey, 9 C.L.R., 194, applied.

Decision of the Registrar of Patents : *In the matter of the application of A. H. and A. J. McGlashan for a Patent*, 24th October 1907, reversed.

APPEAL from a decision of the Registrar of Patents for the Commonwealth on an application for a patent.

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This was an application by the appellants for a patent for "An improved ballast spreader for use in the construction of the permanent way of railroads." The nature of the appliance and of the improvements claimed sufficiently appears from the judgment of *Griffith* C.J. The respondent opposed the application on various grounds under sec. 56 of the *Patents Act* 1903, viz., (a) that the appellants had obtained the invention in all its main features from the opponent; (b) that the alleged invention had not been communicated to the applicants by the actual inventor or his representatives; (c) that the alleged invention was known in the Commonwealth at the date of the appellants' specification; (d) had in all its main features been made public in the Commonwealth in Patent No. 3132 of 9th May 1905, and (e) had in all its main features been described and published in the Commonwealth prior to 12th November 1907, and was therefore in possession of the public.

The Registrar of Patents came to the conclusion that the real grounds of opposition were the previous publication in Patent No. 3132 of a feature of the appliance called the adjustable wing spreaders and the publication in a model in the possession of the Public Works Department of New South Wales of certain other features, viz., the adjustable under-frame and concave spreader. He was of opinion on the evidence that it was clear that the wing spreaders were not new, and that there was no novelty in the attachment to an adjustable frame, or in the use of a concave spreader. But he considered that it had not been shown that the present construction described by the appellants, viz., an adjustable under-frame carrying wing spreaders and a concave central spreader, had previously existed. He held that the mere variation in the position of the central spreader on the front of a truck to one on an adjustable under-frame, without the performance of any new function, which was claimed by the appellants as an improvement, did not constitute a new invention, and on that ground refused the application, with costs.

From that decision the present appeal was brought.

Leverrier, for the appellants. The design for which a patent is sought has important novel features, and there is also a com-

bination of features which is itself an improvement. The attaching of all the spreading gear to one under-frame is novel. [He referred to *Hinks & Son v. Safety Lighting Co.* (1)].

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Harvey, for the respondent. There is only one feature which according to the evidence is an invention, and that is not really important, and was not claimed by the applicants as the feature which constituted the novelty of their appliance. The attachment of all the spreaders to a single under-frame they did not claim as an improvement either in the specification or the claim. They should have disclosed the improvement upon which they relied; whereas there is nothing in the application to distinguish the alleged new features from the old. If the appliance is identical in all but one point with the old appliances, and the applicants have never insisted on that point as an invention, the Court may assume that it is not important.

[The Court referred to *Linotype Co. Ltd. v. Mounsey* (2) as holding that absence of inventiveness was no objection on an application for registration, the only objection being want of novelty.]

Leverrier, in reply. In the case of a combination it is not necessary for the applicant to state what is old and what is new in the individual features. [He referred to *Harrison v. Anderston Foundry Co.* (3).] If a special improvement is claimed that must be clearly shown, but a combination may be novel though the features combined are in themselves old. This combination is in important respects novel. At any rate the respondent has not shown that it is not novel, or that it is in any sense substantially identical with some combination already existing, and the onus is on him in this proceeding.

GRIFFITH C.J. This is an application for a patent for an invention described as "An improved ballast spreader for use in the construction of the permanent way of railroads." The invention as described in the specification consists, speaking generally, of an appliance to be fixed to a moveable truck to run

August 6th.

(1) 4 Ch. D., 607, at p. 615.

(2) 9 C.L.R., 194.

(3) 1 App. Cas., 574, at p. 577.

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on rails for the purpose of spreading to an even depth ballast already deposited from trucks in heaps along the course of the permanent way. The appliance consists of what are called wings or wing spreaders, one on each side of the truck, which may be described as exaggerated plough shares some feet in length which take up the earth and spread it to the required distance, the depth of the ballast to be left being controlled by regulation of the height at which the wings are suspended from the frame of the truck. In addition to that there is a contrivance underneath the truck, designed as a sort of scoop or share, moving forward with the truck, to scoop off all the earth above the desired height and distribute it at an even depth above the sleepers as required. That is the general nature of the invention. It is objected to by the opponent on various grounds, but the only ground material for the present purpose is that it is not novel; that is, that it was already in the knowledge existing in the Commonwealth before the date of the application. That is a question of fact. In the *Linotype Case* (1) decided in Melbourne recently, this Court held that on objections of this kind it will inquire into the novelty of the invention to this extent: that if it is of opinion that the invention has been substantially anticipated, or that an invention substantially the same is in use already, it will say that it is not novel. There are many other objections that run more or less into the question of novelty, for instance, that there is no substantial inventive faculty involved in such differences as there may be between the new appliance and others already existing. In the present case the question for consideration is whether the invention for which the patent is sought is substantially the same as an appliance that had been made, a model of which existed in the Public Works Department before the date of the application. I have already pointed out that in this case there are what are called wing spreaders and a central spreader. The specification states that the invention consists of an improvement on that disclosed in the specification of Commonwealth Patent No. 3132. Now that specification was for an appliance in some respects similar, but consisting only in the side spreaders that were fixed to the

(1) 9 C.L.R., 194.

frame of the truck itself. After the grant of that patent various improvements were made by persons interested in the subject. In the under-frame an improvement was made by which the under-frame could be raised or lowered, and the wing spreaders were attached to the under-frame, with the result that the vertical distances of the wing spreaders from the deck of the truck, and also the angle at which the frames were in respect of the trunk, could be varied. Moreover another invention had been added. A sort of shovel had been attached to the front of the truck which could be raised vertically, and which scooped off the earth in front. What was called a central spreader was attached to the front of the truck which could be raised vertically with the under-frame, but the under-frame to which that was attached was not the same as that to which the wing spreaders were attached. There is therefore this difference, that the earlier contrivance had a central spreader in front of the truck, whereas in that described in the present application the spreader is underneath the truck. The two things are therefore not identical in form, though they are very much alike, and are intended to perform exactly the same functions. The differences may be in practice infinitesimal, or they may be considerable. But there is certainly this difference, that the two wing spreaders and the central spreader in the one are attached to two separate under-frames, and in the other are attached to the same under-frame, the consequence being that in the one raising the under-frame raises the whole spreading appliance, while in the other there are two frames to be raised. There is another minor modification, that the central spreader being attached to the same under-frame to which the wing spreaders are attached can be raised and lowered on a batter, whereas in the modification of the original patent which was already in use this central spreader could only be raised vertically. Under these circumstances are we to say that one invention is practically the same as the other? In consideration of these cases it is important to consider, first of all, the nature and subject-matter of the invention. It was pointed out in *Clark v. Adie* (1), and in other earlier cases, that in the case of a combination it is no

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objection that all the elements are old, as there may be something new in the particular combination, and that rule was applied by this Court in *Moore and Hesketh v. Phillips* (1). The claim in the present case is, first, in an improved ballast spreader for use in the construction of the permanent way of railroads, an adjustable supplementary under-frame carrying the hinged wing spreaders and a central trailing spreader substantially as described and as illustrated in the drawings; and secondly, in an improved ballast spreader for use in the construction of the permanent way of railroads, the combination of an adjustable under-frame and means for adjusting the same, in combination with a pair of hinged wing spreaders and a central trailing spreader substantially as described and as illustrated in the drawings. The second claim is undoubtedly for a combination; the first may be doubtful, but it is not necessary to express an opinion on that point now. If the invention consists in a combination, all that it is necessary, and indeed all that we are entitled, to inquire into, is whether the combination is novel. It appears that the Registrar for the reasons he has stated has found that no such combination has been made before. For these reasons I think that this Court, acting upon the principle that it should not refuse to allow the grant of a patent unless it is quite clear that it cannot stand upon the ground of want of novelty, should allow it. It by no means follows that the patent will be valid when granted. Upon all the materials before us it is impossible to say that it has been proved affirmatively that substantially the same combination has ever been in use in the Commonwealth before, and upon that ground I think that the patent should be granted, without expressing any opinion as to the validity of the patent when granted.

O'CONNOR J. I am entirely of the same opinion. The specification of the applicants, if compared with the Patent No. 3132, which I understand is the only existing patent dealing with this method of spreading ballast, is, I think, clearly enough a new combination. But it is not sufficient for the applicants to succeed in showing that. It must also appear that, as compared

(1) 4 C.L.R., 1411.

with the state of existing knowledge in the Commonwealth upon the subject, their patent has sufficient novelty to enable their specification to be good. It appears that there are other machines of a much improved pattern to that of Patent No. 3132, which have been in operation on the New South Wales railways, doing the same work as the applicants' invention is intended to perform. A certain amount of evidence has been given as to whether the applicants' invention differs substantially from them. But the evidence is not sufficient to satisfy me one way or the other upon that point. The onus on such an issue is clearly upon the objector. As he has failed to satisfy the Court upon that question of fact, he must fail altogether. In determining the principle upon which a doubtful condition of facts is to be dealt with, we must have regard to what the proceeding really is. The objection, and the proceedings in connection with it under sec. 56 of the *Patents Act* 1903, are merely to enable the patent office to come to a determination for the purposes of registration so that only patents *prima facie* valid shall be upon the register. It is no doubt a good thing to have some process by which patents obviously invalid shall not be allowed to encumber the register. Under these circumstances it is very important that the Registrar should have full powers of inquiry as to certain matters, for the purpose of ensuring that patents which are obviously bad shall not acquire by registration even a *prima facie* recognition by the Commonwealth. The machinery provided by the section does not go beyond that. It certainly appears to me that under those circumstances it is not the duty of the Court to give a decision which will shut out the applicant altogether, but in cases where the objector has not discharged the onus cast on him, to allow the patent to be registered, leaving the question of the existence of sufficient invention to be fought out by the parties, if they think fit, in a suit for infringement, where the whole question may be thoroughly gone into. Under these circumstances I agree that the appeal should be allowed, and the patent should be granted.

ISAACS J. I agree with the judgments delivered by my learned brothers, and I do so upon this ground, that upon this summary

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proceeding the onus lying upon the objector is greater than it would be if the validity of the patent were at issue in an ordinary action for infringement. I have already in two previous cases, *Moore and Hesketh v. Phillips* (1), and *Linotype Co. Ltd. v. Mounsey* (2), expressed my views as to the duty of the Court in such cases. I merely refer to those cases without repeating what I there said.

Appeal allowed. Declaration that the patent should be granted. Respondent to pay the costs of the appeal, and of the proceedings before the Commissioner, to be taxed in the High Court.

Leverrier, for the appellants, asked for the allowance of costs of printing the appeal book, there being no special provision for such costs in these appeals.

GRIFFITH C.J. We lay it down as a rule that the costs of printing will be allowed unless otherwise ordered.

Solicitor, for the appellants, *V. Le G. Brereton*.
Solicitors, for the respondent, *Sly & Russell*.

C. A. W.

(1) 4 C.L.R., 1411.

(2) 9 C.L.R., 194.