

sary, in view of the conclusion already arrived at, to decide anything about damages, but with a view to guide future practice I would add a word on the argument as to this. If specific performance had been refused on the ground of non-essential mistake damages should have been ascertained and awarded under sec. 9 of the *Equity Act* of 1901. See the observations of the Lords Justices in *Ferguson v. Wilson* (1).

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*Appeal allowed with costs. Costs of trial
and of the appeal to be set off against
the purchase money.*

Solicitor, for the appellants, *A. J. L. Flashman*, Nyngan, by *McDonell & Moffitt*.
Solicitor, for the respondent, *W. T. Hogan*, Cobar, by *Perkins, Stevenson & Co.*

C. E. W.

[HIGH COURT OF AUSTRALIA.]

GEORGE ROGERS APPELLANT;

AND

THE COMMISSIONER OF PATENTS . . . RESPONDENT.

ON APPEAL FROM THE COMMISSIONER OF PATENTS.

*Patent — Patents Act 1903 (No. 21 of 1903), secs. 4, 46 — Manner of new
manufacture—Refusal to accept specification—Device for burning standing
timber—Production of new article.*

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SYDNEY,
May 16, 17,
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Griffith C.J.,
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(1) L.R. 2 Ch., 77, at pp. 88, 91 and 92.

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The appellant applied for a patent for a device for burning standing timber by causing a self feeding slow fire to act continuously against the side of a tree. The method employed was to set alight the face of the tree, and also the end of a log supported on two forked sticks in such a way that the lighted end of the log as it burnt away would fall forward towards the tree by force of gravity, and thus constantly provide automatically sufficient combustible material to keep the tree burning.

Held, by Griffith C.J. and O'Connor J. (Isaacs J. dissenting), that this was not any manner of new manufacture within sec. 4 of the *Patents Act* 1903, and therefore was not patentable. The alleged invention was a mere working direction for the application of the law of gravity to keep two burning objects in contact.

Per Isaacs J., that the contrivance in question was a new method of producing an old result, and was patentable, though the appellant had neither produced a vendible article nor manufactured anything.

APPEAL from the decision of the Commissioner for Patents, refusing an application by the appellant for a patent upon the grounds:—

1. That the subject matter set forth in the specification and drawings accompanying the said application for a patent is a patentable invention, and that the Commissioner should have accepted the application and overruled the examiner's report, which stated that "The alleged invention which forms the subject of the application for a patent is not, in my opinion, a manner of manufacture within the meaning of sec. 4 of the *Patents Act* 1903."

2. That the Commissioner of Patents was in error in holding "that the application must be refused on the ground that the specification is wanting in subject matter."

The specification stated that the invention consisted of a method of applying fire to the inner part of the trunks of trees without first burning through the sap to expose the same. A small area of the inflammable core was exposed by cutting away with an axe, at ground level, a patch of the outer layer of timber, about a square foot in area, and about two inches thick. The

object was to provide means whereby a self-feeding slow fire was caused to act continuously against the face of the tree, and to save the expenditure in wages and loss of time necessary where a fire was built against the core of the tree and had to be continually replenished.

The method by which the fire was applied to the exposed core was thus described by the appellant:

A log, preferably dry, eight to twelve feet long and from twelve to thirty inches in girth, is set up at an angle on a mid-way support formed of two forked sticks, and with the lower end placed to rest against the exposed part of the tree core, where the "sap" has been chopped away as before described. A chip fire is then built at the foot of the log to light the end of same. The log burns away at the point; and as it is thus consumed, and thus loses its foot support, the fork sticks allow it to move towards the tree, always keeping its lighted end pressing against the exposed core part of the trunk. This inward movement of the log is due to the manner in which it is balanced nearly midway of its length on the forked stick props, which are fixed at an angle, so that as the end of the log or the exposed part of the tree is burnt away the log will move towards the tree by gravity. It is only necessary to light a small fire sufficient to start the log, and in most cases it is not necessary to readjust the fork stick supports, one setting of fire and log being sufficient to ensure the ultimate lighting up of the tree, which progresses when once started and continues until the tree is sufficiently burned through and weakened to fall by its own weight. The fire burns out a cavity upwardly and downwardly, so that as well as felling the tree a fire set according to my method assists in removing part of the tree root.

The annexed drawing illustrates in Fig. 1 a tree trunk slashed to expose the core timber and having a log set up against it on forked support sticks as required in the working of my invention; the starting fire is also shown. In Fig. 2 is shown a section through a tree as it appears when the burning process has been almost completed.

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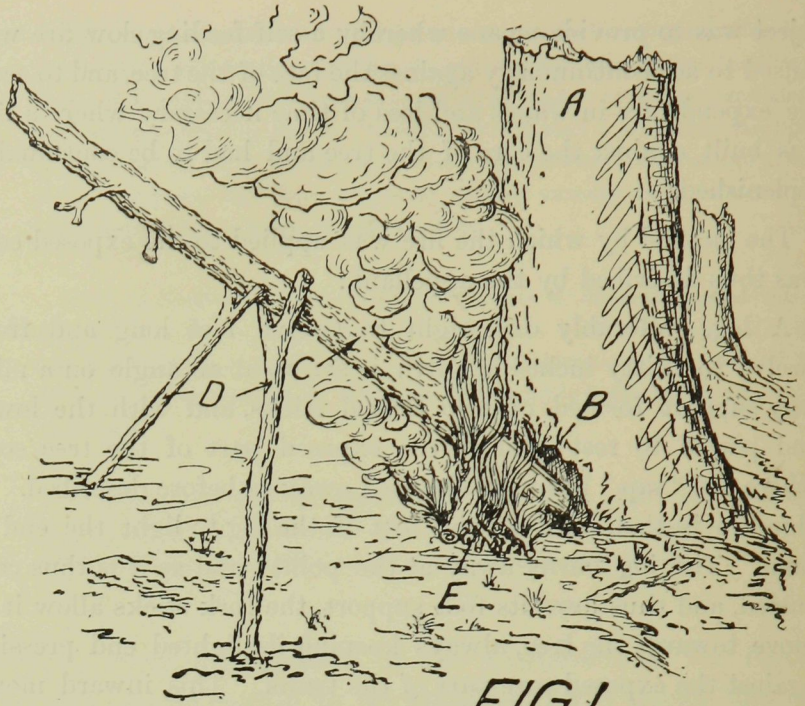


FIG. 1

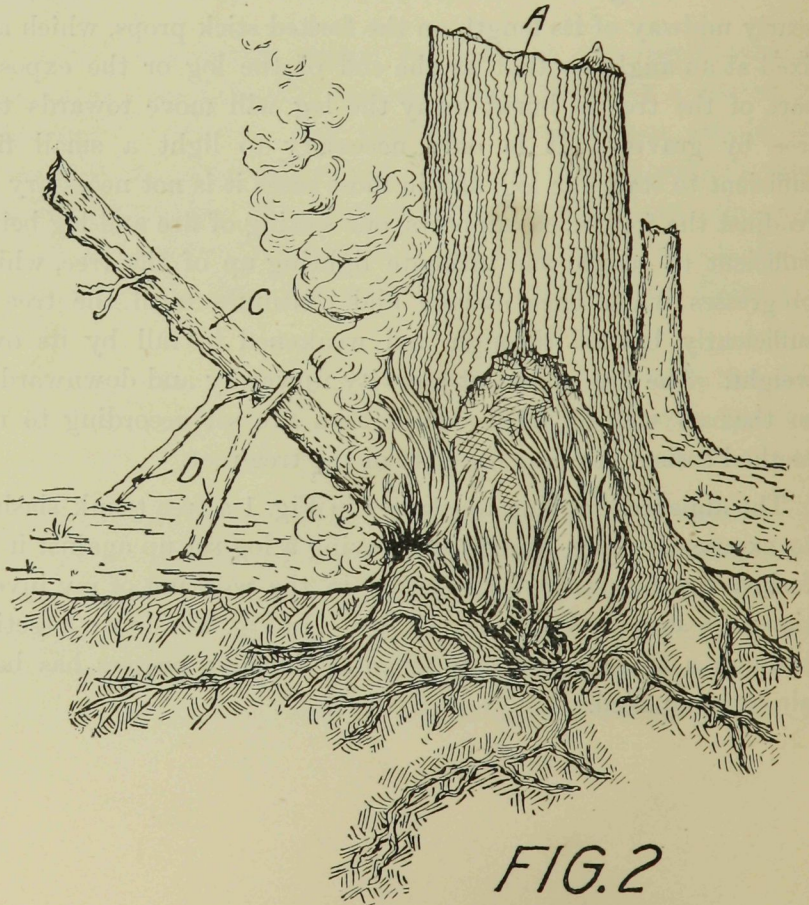


FIG. 2

A is the tree trunk, B the slashed out portion whence the surface wood has been removed, C the fire feeding log, D the forked stick support for the log C, and E the starting fire.

The forked sticks D should support the log C at a point a little rearward of its middle so that its lower end which rests in the slashed portion B of the tree trunk will be the heavier, and these forked sticks must be inclined towards the tree as shown so as to keep the log C fed towards the tree as the log is burned away at the foot; they must also be spread to form a "horse" to prevent the log from falling sideways. The tree burns into the core as indicated in Fig. 2; and ultimately the core burning outwardly destroys the "sap" or surrounding shell until it becomes too weak to support the tree, which then falls.

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Leverrier, for the appellant. The Commissioner refused the application for a patent upon the ground that it was not a manner of manufacture within sec. 4 of the *Patents Act* 1903. The examiner is not required by the Act to report, as he has done, whether the patent is a manner of manufacture, but the Commissioner is apparently entitled to take this objection under sec. 46. It is contended by the appellant that the cost of clearing land by the method stated in the specification is one third of the ordinary cost. For the purposes of this case novelty and utility must be assumed in favour of the appellant. It is submitted that anything is a manner of manufacture within the Act if it relates to material things and produces a useful industrial result: *Boulton v. Bull* (1). The invention no doubt involves an old principle, but the application of that principle is a novelty. The invention is a contrivance by which two lighted bodies can be kept in contact. The ingenuity consists in the method of feeding a fire in the cavity of a tree. The application cannot be refused unless the Court is satisfied that it is beyond all question not patentable. If by inventive ingenuity a useful result is attained it is patentable: *R. v. Wheeler* (2); *Frost on Patents*, 2nd ed., p. 25; *Edmunds on Patents*, 2nd ed., p. 127; *Forsyth's v. Riviere* (3); *Innes v. Short* (4); *Re Cooper's Application* (5); *Re Johnson's Application* (6).

(1) 2 Bl. H., 463, at p. 493.

(2) 2 B. & A., 345.

(3) 1 Web. Pat. Cas., 97.

(4) 15 R.P.C., 449.

(5) 19 R.P.C., 53.

(6) 19 R.P.C., 56.

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Flannery, for the respondent. This is nothing more than a working direction, and is not patentable. It is merely a new way of building up a fire, so that the wood falls into the fire by gravitation. When, as in this case, the mechanical process is not new, a patent will not be granted unless the result is new. Assuming that the appellant has exercised ingenuity, this has not resulted in the production of a vendible article or a manner of manufacture. [He referred to *Patterson v. Gas Light and Coke Co.* (1); *Dredge v. Parnell* (2); *Gadd v. Mayor of Manchester* (3); *Harwood v. Great Northern Railway Co.* (4).]

Leverrier, in reply.

Cur. adv. vult.

May 19.

The following judgments were read:—

GRIFFITH C.J. The alleged invention in question in this case may be described as a device or contrivance for burning down standing timber, and consists in a mode of keeping the wood used as fuel in constant contact with the tree to be felled.

The mode described is to set up two forked sticks, resting loosely on the ground, near the tree and inclined towards it, and to use them as two legs of a tripod, the third being formed by a long piece of dry timber, which serves as fuel, and which is supported near the middle of its length by the forks, with one end (which is on fire) resting against the foot of the tree, the point of support being such that the part near the tree is heavier than the other part, so that as it burns away the burning end will fall forward towards the tree and still remain in contact with it. The question is whether such a device or contrivance is “any manner of new manufacture” within the meaning of the *Statute of Monopolies*.

As a matter of plain sense unaided by judicial interpretation, I do not suppose that any person conversant with the English language could be found to say that it is. But it is suggested that these words have in some cases received an extended signification, and that the language used by learned Judges is capable

(1) 2 Ch. D., 812.

(2) 16 R.P.C., 625.

(3) 9 R.P.C., 516, at p. 523.

(4) 11 H.L.C., 654.

of being read as covering such a case. There is no more dangerous fallacy than that involved in assuming that words used, and aptly used, with reference to particular facts lay down a general principle. It might be sufficient in the present case to say that no authority has been cited in which these words have ever been extended to such a case as the present, and that the rule of plain sense must prevail. But in deference to Mr. *Leverrier's* argument I will briefly advert to some of the supposed judicial extensions of the meaning.

The word "manufacture" may be read as denoting both the thing produced and the process of producing it: *Boulton v. Bull* (1). It is settled law that a new idea alone is not subject matter for a patent. Again: "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 to the purpose in or to which it has been hitherto notoriously used": *Harwood v. Great Northern Railway Co.* (2).

In *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.* Lindley L.J. said (3):—"A patentee must do something more; he must make some addition, not only to knowledge, but to previously known inventions, and must so use his knowledge and ingenuity as to produce either a new and useful thing or result, or a new and useful method of producing an old thing or result.

"On the one hand, the discovery that a known thing—such, for example, as a *Planté* battery—can be employed for a useful purpose for which it has never been used before is not alone a patentable invention; but, on the other hand, the discovery how to use such a thing for such a purpose will be a patentable invention if there is novelty in the mode of using it, as distinguished from novelty of purpose, or if any new modification of the thing, or any new appliance is necessary for using it for its new purpose, and if such mode of user, or modification, or appliance involves any appreciable merit."

There may, then, in some circumstances be a patentable inven-

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(1) 2 Bl.H., 463.

(2) 11 H.L.C., 654, at p. 682.

(3) (1892) 3 Ch., 424, at p. 429.

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tion if the discovery involves novelty in the use of a known thing as distinguished from novelty of purpose, or if any new modification of the thing or any new appliance is necessary for using it for the new purpose. The present case does not come within this doctrine. A tripod is a thing notoriously used for all sorts of purposes. The alleged invention is not a modification of it. There is no new appliance. At most there is the use of a tripod in unstable equilibrium to keep two objects in contact.

In *Consolidated Car Heating Co. v. Came* (1), Lord Davey, delivering the opinion of the Judicial Committee, pointed out that in considering the substance of an alleged invention, it is important to distinguish whether the merit of the invention consists in the idea or principle which is involved in it, or in the means by which that idea is carried into effect.

The law applicable to the case of the invention of a new principle is thus stated by the same learned Lord in the case of *Chamberlain and Hookham Ltd. v. Mayor of Bradford* (2):—"The law on this subject is free from doubt, and I do not know that it has been better stated than it was by Mr. Baron Alderson in the well known case of *Jupe v. Pratt* (3). The learned Judge says:—"You cannot take out a patent for a principle. You may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect."

Whether the mode to be used is or is not "a manner of new manufacture" depends upon circumstances. The words "process" and "method" are sometimes used to denote the new mode or means. For instance, in the case of a new admixture of substances to produce a chemical result (such as the cyanide process for extracting gold), in which the merit of the invention is the use of a known substance to effect a result which was not before known to be attainable by such means, the invention is sometimes called a new process or new method. In other cases a combination of known appliances to produce a new result has

(1) (1903) A.C., 509.

(2) 20 R.P.C., 673, at p. 684.

(3) 1 Web. Pat Cas., 144.

been treated as an invention, as in the hot air case: *Crane v. Price* (1). In such a case the combination is the invention. I am unable to bring the present case within any of these extensions of the term, and I do not know of any other instances in which the words "new method" have been used except in the sense of new appliance.

The idea of keeping two inflammable substances in contact in order to promote combustion is, I suppose, as old as the discovery of the means of producing fire; the idea of a tripod is not new; the fact that a consumable limb of a tripod will fall as the end of it is consumed is not new, the use of forked sticks is not new. At best, the invention is a direction how to apply the law of gravitation in order to keep in contact two bodies, one of which is being consumed. I am unable to distinguish the case from that of an alleged invention of a new method of laying a kitchen fire in a grate. In such a case the discovery may be meritorious and useful, but the supposed invention is merely a direction how best to use materials in everyday use to achieve an everyday object. Such an invention is not a new manner of manufacture in any sense in which that term has hitherto been used.

This being so, it is quite immaterial whether the particular method of disposing of the fuel is or is not novel, or is or is not useful.

With all respect, I think that the case of *Hickton's Syndicate* (2), on which my brother *Isaacs* relies, and which was not cited in argument, is obviously distinguishable. That was a case of using an old appliance for an allegedly new purpose, and the Court thought that the old and new purposes for which the appliance in question was used were not analogous.

The appeal must therefore be dismissed.

O'CONNOR J. This is an appeal from a decision of the Commissioner of Patents, under sec. 46 of the *Patents Act* 1903, refusing the acceptance of a patent. The ground of refusal was that the invention was not a manner of new manufacture within the meaning of the Act. It may be conceded that the Court will not in this preliminary stage throw out an application on

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(1) 4 M. & G., 580.

(2) 26 R.P.C., 339.

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that ground unless it is established beyond any question that the invention cannot be the subject of patent. But if the ground is established with sufficient clearness, the decision of the Commissioner refusing to further entertain the application will be upheld. The invention is described as an improved method of felling trees by burning the lower part of the trunk. The method of felling trees by burning the lower part of the trunk is old and in common use. In order to apply it successfully it is necessary to keep the fire burning against the tree until the latter is so thoroughly alight as to burn of itself. The attainment of that result involves, it is said, considerable labour in attending the fire and keeping it against the tree. The applicant claims that he has invented a method by which, with a small expenditure of labour, the fire is kept burning against the tree until the result aimed at is attained. The material part of the invention is described in the following words of the specification :—" A log, preferably dry, eight to twelve feet long and from twelve to thirty inches in girth, is set up at an angle on a midway support formed of two forked sticks, and with the lower placed to rest against the exposed part of the tree core, where the 'sap' has been chopped away as before described. A chip fire is then built at the foot of the log to light the end of same. The log burns away at the point; and as it is thus consumed, and thus loses its foot support, the forked sticks allow it to move towards the tree, always keeping its lighted end pressing against the exposed core part of the trunk. This inward movement of the log is due to the manner in which it is balanced nearly midway of its length on the forked stick props which are fixed at an angle so that as the end of the log or the exposed part of the tree is burnt away the log will move towards the tree by gravity."

A comparison of the new way and the old way will, I think, well illustrate what the invention really is. In the old way dry wood was piled around the trunk, and so arranged as to keep burning against it. In the new way the tree is set alight by the same material, but it is differently arranged. Instead of being piled around the trunk indiscriminately, the end of a long light log is placed in a hole cut in the trunk for the purpose of holding it. The forked sticks keep it in a place at the required angle.

Instead of lighting a fire all round the tree it is lit only where the log is fitted into the tree so as to set the end of the log alight, and the burning end is kept pressed against the tree until the latter is sufficiently alight to burn of itself. The idea of the new way is to keep the burning end of the log pressed against the tree by an automatic method, and it is carried out by combining the dry wood into a tripod with one long leg pressing against the tree, and so supported by two forked sticks that, by the operation of gravity, it keeps pressing against the tree as it goes on burning. I can see nothing in the idea or the mode of its application other than a new method of arranging the materials for burning, in other words, a new method of laying the fire. The final object attained, the felling of the tree by the fire, is old, the method of attaining it by setting fire to the tree close to the ground is also old. It may be assumed that the idea of setting the tree alight and keeping it burning by pressing a burning log into it is new, but the method of carrying it out by setting up the material for burning in a tripod form so arranged as to press against the tree by the force of gravity is a well known mechanical contrivance applied to many other purposes. The only new thing is the idea of disposing the material in such a way as to keep it burning against the tree without further handling when it has once been set alight. In putting the idea into operation no machine is made—nothing is invented, nothing is produced. The contrivance for carrying it out is as well known as the principles of gravitation by which it operates. Under these circumstances I am at a loss to understand what there is in the invention which can by any stretch of imagination be brought within the words of the Statute “any new manner of manufacture.” Mr. *Leverrier* relied on the principle that a patent may under some circumstances be granted for a new process or method of attaining an old result, and cited several cases in illustration. But behind that principle there is always the primal requirement of the Statute—“a new manner of manufacture.” In *Frost on Patents*, 3rd ed., at p. 25, this view is put as follows:—“It has been said that only an art by the exercise of which vendible articles, or articles of trade or commerce, are capable of being produced can form the subject matter of valid letters patent,

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for two reasons." After stating the reasons he proceeds:—"Since the object of the patent must be a manufacture, it must result in the production of a material entity." In *R. v. Wheeler* (1), Chief Justice *Abbott*, afterwards Lord *Tenterden*, explains the meaning of the word "manufacture" as used in the Statute. "It is well known that the granting of monopolies was restrained by the Stat. 21 Jac. 1 c. 3, to the sole working or making of any manner of new manufactures, and to the true and first inventor of such manufactures. Now the word 'manufactures' has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine or instrument, or some part of an engine or instrument, to be employed, either in the making of some previously known article, or in some other useful purpose, as a stocking-frame, or a steam engine for raising water from mines. Or it may perhaps extend to a new process to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, by producing it in a cheaper or more expeditious manner, or of a better or more useful kind. But no merely philosophical or abstract principle can answer to the word 'manufactures.' Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy this word." The proposition that a patent may be granted for a new method of producing an old result in a more efficient and more economical manner must therefore be qualified by the condition that the new method must either produce some vendible article or must be carried out by some mechanical contrivance or some substance the use or adaptation of which for the purpose of working the new method is part of the invention. If the applicant's invention can be brought within the Statute I can see no reason why a patent could not issue for a new method of laying a burning-off fire in such a way that the logs in burning would fall together instead of apart, thus keeping them burning without further attention until they were consumed. The absurdity

(1) 2 B. & A., 345, at p. 349.

of describing an improved method of building a log fire as a patentable invention is apparent from the mere statement of it. Yet there is in principle no difference between such a case and the invention now applied for. I am therefore of opinion that the decision of the Commissioner must be upheld and the appeal dismissed.

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ISAACS J. This case raises a short but extremely important question of patent law. It is a matter of sincere regret to me that I am not able to come to the same determination as my learned brothers. And as the principle upon which this case is decided appears to me to affect not merely the present and future applications, but also the possible validity of many existing patents, I shall explain as clearly as I can the reasons which lead me to the conclusions I have formed.

The appellant's application was rejected by the Commissioner on one ground only, namely, that no patent can be granted where the applicant has neither produced a vendible article nor manufactured anything. In other words, that unless the invention consists or results in producing some new article it is outside the purview of the Patents Acts.

That is the simple question which comes to us. It is short and clear and should occasion no hesitation one way or the other. I am clearly of opinion that the Commissioner was wrong.

The Statute defines invention, except where otherwise clearly intended, as meaning any new manufacture within the meaning of the *Statute of Monopolies*, and as including "an alleged invention."

The last three words refer to what, if novel, would be an invention. The Statute prescribes certain formalities and office procedure, including a report by the examiner, as to prior patents or applications, and as to novelty (sec. 41). By sec. 46 the Commissioner, if satisfied that there is no prior Australian patent or application shall, in the absence of any other lawful ground of objection, accept the application, but if not so satisfied may refuse to accept it.

In the present case the examiner reported that in his opinion the alleged invention is not a manner of manufacture within the

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meaning of sec. 4 of the Act. This is not one of the matters upon which the legislature has required the examiner to offer his opinion, but beyond this no report appears to have been made. So that on all other points, including novelty, we are bound to assume for the present purpose all necessary facts, including novelty, in favour of the applicant, and if the Commissioner has decided erroneously as I think he has, the matter should be remitted to him to obtain the statutory reports, and consider the application in the regular course prescribed by law.

The Commissioner has not so far even considered the application with regard to the matters indicated by the Act; he has regarded it as an intrusion into the precincts of the Statute, has held, for the simple reason he gave, that it was *dehors* all consideration, and forthwith expelled it.

Novelty, prior patent or application, and all lawful reasons for rejecting an application for a possible invention have been left unconsidered.

In my opinion, the Commissioner has wrongfully declined jurisdiction, and the application should be sent back to him to deal with in the ordinary way.

The appellant's application is for an improvement of known methods of felling trees by burning. He explains, what is common knowledge, that this operation as previously known and practised in Australia involves the feeding of the fire by hand. He devised a means whereby a self-feeding slow fire is caused to act continuously against the face of a green tree after preparation by cutting away a part of the outer portion of the trunk. If prior to the publication of Rogers' system any landholder had been asked to suggest any method whereby the fire could be made continuously self-feeding until the tree was felled, he would, so far as is known to the Court or suggested by counsel, have been utterly unable to do so.

The means devised by the applicant are simple, and are said to be effectual. It consists of an idea coupled with a practical method of operating it. The idea is to start the fire by igniting at the same time the prepared face of the tree and the end of a log of sufficient length, and causing the log as the lighted end burns away to constantly move towards the tree so as to provide

always sufficient combustible material to maintain the fire, and so as to continue without intermission the process of burning and approach day and night, and without the expense and inconvenience of human labour and attention. No one so far as is known had ever conceived the idea before, at all events as a workable notion : but that was Rogers' idea.

If such an idea could be put into practical operation simultaneously over a large area of timber, it is evident that it would be of great practical value, upon one condition, namely, that the apparatus should not be costly.

The problem involved first the temporary fixation of the log until the burning has sufficiently proceeded ; next, its motion forward when required to continue ignition ; and lastly, the maintenance of the proper direction until the desired effect had been produced.

Rogers' system combines simplicity, economy, and ingenuity. He places one of the logs in the tree cavity which, being made, at once exposes the face, and forms a support for the log ; the other end of the log is placed at a higher elevation ; and at nearly midway of its length there are placed two forked prop supports which effect several purposes :—(1) They uphold the log at the desired angle ; (2) they prevent it swaying out of line ; (3) they yield with its weight as it advances drawn downward and forward by the forces of gravity modified by the two end supports ; and they thus effectively, as it is claimed, fulfil the desired object of constantly feeding the fire with necessary fuel until the tree falls or the log is consumed.

Why is this contrivance not of the nature of an invention ? Why is it to be treated as if it were an absurd attempt to claim an every day practice, say of lighting the kitchen fire, or striking a match ? I pass by the reason given by the Commissioner as not supported by any doctrine of the law, and proceed to state why I think the system described does answer the description of an invention. It involves an idea, and a *modus operandi*. It is objected that building and feeding fires for clearing land are ancient operations. Conceded. Further, it is objected that in building some fires the materials are frequently so placed as to fall in towards the fire as they burn. Conceded also. But the

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vital difference is that in the familiar methods the gap between the burning components of the fire widens, and the falling pieces have no regularity of direction or movement, and have no constancy of action, and no possible practical use can be made for the purpose in question of any of the hitherto used methods. Millions of acres of land have been cleared, tens of thousands of human hands have been employed in doing it, and until now, simple as the method is now it is disclosed, no one has struck upon the expedient.

It is objected that to grant Rogers a patent for this would prevent a land owner from adopting the expedient. If this is an objection a great proportion of the patents in existence should never have been granted. The zinc dust patent prevented the mere use of the dust for boilers, though the same man owned both zinc dust and boilers; similarly with regard to the patents for the use of acid for mineral concentration, or oil for mineral concentration, or carbide of calcium for lighting purposes. In none of these was there a machine or a new substance invented.

Natural facts were ingeniously found to be assistant to man in some art, and it was shown practically how they could be made of assistance.

If in the present case it could have been shown that Rogers' method was known and practised in any other domain of industry, and was merely the application of a well known thing to an analogous use, without any novelty in applying it, it would have been lacking in invention: *Harwood v. Great Northern Railway Co.* (1); *Riekmann v. Thierry* (2); *British Ore Concentration Syndicate Ltd. v. Minerals Separation Ltd.* (3). But as always indicated even in such a case the application to the new purpose may not be a mere application of the old method, it may be that in the mode of application there is a sufficient degree of inventive ingenuity to save it from the rule: *per Lord Watson in Morgan v. Windover* (4), and see *per Lord Davey in Riekmann v. Thierry* (5). The mere fact of simplicity, and that the expedient looks obvious now to those who have become acquainted with it

(1) 11 H.L.C., 654.

(2) 14 R.P.C., 105, at p. 114.

(3) 27 R.P.C., 33.

(4) 7 R.P.C., 131, at p. 136.

(5) 14 R.P.C., 105.

for the first time, does not destroy its inventive character. Lord *Herschell* in *Vickers, Sons & Co. Ltd. v. Siddell* (1) observed: "Experience has shown that not a few inventions, some of which have revolutionized the industries of this country, have been of so simple a character that when once they were made known it was difficult to understand how the idea had been so long in presenting itself, or not to believe that they must have been obvious to everyone." The test of invention is clearly stated by the House of Lords in *Dredge v. Parnell* (2) to be whether it would have occurred to an ordinary skilled workman desirous of effecting the purpose; of course experience demonstrates it would not. *Patterson v. Gas Light and Coke Co.* (3) was relied on by Mr. *Flannery* as a guide to this case, because of some observations at page 835 that a certain statement to the effect that carbonic acid, unless wholly removed at a particular stage in a gas making process, poisons the purifiers, and restores to the gas the sulphur impurities previously removed, was nothing more than a working caution and direction. But, as *James L.J.* points out, there was no suggestion in that of any new apparatus, or any process, and no device or scheme of any kind. It was, as he shows, merely a working caution and direction in the use of a machine, and a process, and materials already in full use for the very purpose in view. And when the case went to the House of Lords (4) it is quite clear what the position was. Lord *Blackburn* says (5):—"If by reason of knowing the theory he (the appellant) is enabled to make some improvements he may take out a patent for those improvements, but he cannot take out a patent to prevent others from using *what they had used before*, though only empirically." And Lord *Gordon* says (6):—"It has been proved that the modes of purification there claimed were known modes before the date of the patent, and, that being so, that the patent is therefore invalid *in toto*."

Here the applicant is claiming a device that no one had used before. It matters not in the least that the separate factors of the applicant's device are old. He utilizes the natural force of gravity, but he regulates it. Uncontrolled it would pull the log

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(1) 7 R.P.C., 292, at pp. 304 and 305.

(2) 16 R.P.C., 625.

(3) 2 Ch. D., 812.

(4) 3 App. Cas., 239.

(5) 3 App. Cas., 239, at p. 246.

(6) 3 App. Cas., 239, at p. 252.

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to earth, and render it useless for his purpose: he harnesses it, controls its energy, restrains its operation from exertion in undesired directions and at inappropriate times, and permits it to assist and not to hinder the immediate purpose and through that the ultimate purpose he has in view. The appliances with which he effects all this are primitive, but the chain of events which constitute their action is novel. The force of gravity which they control is utilised also in turn to compel the forward action of the supporting forks, and it is the combination of the idea or principle, of machine or apparatus, and of system or *modus operandi*, which constitutes the total process the subject of the application.

Lindley L.J. in *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co. Ltd.* (1) said a new method of producing an old result was patentable, and that clearly covers this case, unless on further investigation novelty should possibly be found to be wanting. In *Badische Anilin Und Soda Fabrik v. Levinstein* (2), *Pearson* J. said: "A man cannot take out a patent for an idea, but he may take out a patent, if I might say so, for an idea, coupled with a practical process of effecting that idea." There are other cases enunciating the same principle, but I shall first refer to a very late instance where it was again definitely stated and acted upon.

Hickton's Patent Syndicate v. Patents and Machine Improvements Co. Ltd. (3) was an appeal from a decision that a patent was bad for want of subject matter, principally on the ground that an old operation well known in the trade as "shogging" was used to accomplish the result. *Cozens-Hardy* M.R. asked was it a new idea, a meritorious idea, a useful invention; and he came to the conclusion on the evidence it was a new idea. Then he said (4): "Certain it is that, although need for some invention to obviate this waste had been before the eyes of all persons engaged in the trade, it had never been discovered before. It was new in that sense, and it was none the less new because the operation of 'shogging' was as old as the hills. It was a new application of 'shogging,' an application never applied to a

(1) 9 R.P.C., 413, at p. 416.

(2) 24 Ch. D., 156, at p. 162.

(3) 26 R.P.C., 339.

(4) 26 R.P.C., 339, at p. 347.

machine of this class, nor for any analagous purpose. It is true that 'shogging' being old, 'shogging' was applied in other lace machines, but it either was so applied as not to produce the equalization, which was aimed at here, or if by accident it did produce the equalization it was not a use so analogous to that which is found here as to render the thing so *obvious* as to compel us to state that there is no subject-matter in the patent." The Master of the Rolls then in an important passage corrects an observation of the learned primary Judge. He says: "The learned Judge in his judgment states a proposition, which, with the greatest possible respect, seems to me to be a great deal too wide. 'An idea may be new and original and very meritorious, but unless there is some invention necessary for putting the idea into practice it is not patentable.' That, I venture to say, is not in accordance with the principles which have hitherto been applied in patent cases, and I do not think it ought to be recognized as the law. When once the idea of applying some well-known thing for a special and new purpose is stated, it may be very obvious how to give effect to that idea, and yet none the less is that a good subject-matter for a patent."

Fletcher Moulton L.J. says (1): "In my opinion, invention may lie in the idea, and it may lie in the way which it is carried out, and it may lie in the combination of the two; but if there is *invention in the idea plus the way of carrying it out*, then it is good subject-matter for letters patent."

Buckley L.J. says (1):—"Every invention to support a patent must no doubt be a new manufacture—that is to say, it must either suggest a new way of making something—a means of constructing an old thing in a new manner—or it may mean the way of producing a new article altogether; but I think you are losing grasp of the substance and seizing the shadow when you say that the invention is the manufacture as distinguished from the idea. It is much more true to say that the patent is for the idea as distinguished from the thing manufactured. No doubt you cannot patent an idea, which you have simply conceived, and have suggested no way of carrying out, but the *invention consists in thinking of or conceiving something and suggesting a*

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(1) 26 R.P.C., 339, at p. 348.

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way of doing it. In my humble judgment the learned Judge has gone wrong in that he forgot that that was so. I think you can have a patent for an idea, which is new and original and very meritorious, if you suggest a way of carrying it out. If you do not so suggest you cannot no doubt have a patent; but the learned Judge goes on to say: ‘Unless there is some invention necessary for putting the idea into practice it is not patentable.’ If you have got a new idea, a new conception of manufacturing something, or a new way of manufacturing something and you suggest a way of carrying it out, that is patentable.”

If that is good law, and it is only expressing in other words what earlier cases have laid down, it seems to me, with much respect to the contrary opinion, that this appeal should succeed.

I shall make some very brief references which show that those observations are well founded in previous decisions.

Sir George Jessel M.R. in Otto v. Linford (1) says:—“If you have a new principle, or a *new idea*, as regards any art or manufacture, and then show *a mode* of carrying that into practice, you may patent that; though you could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new.”

In *Frost on Patents* (3rd ed., pp. 45, 51 and 53), occur passages which correctly sum up the position so far as material. I read them (1): “A claim to every mode of carrying a principle or idea into effect amounts to a claim for the principle or idea itself, and therefore renders the patent void, unless the patentee has described in the specification a method or methods of utilizing the principle or idea, *i.e., unless he has embodied the principle or idea*, in which case such a claim is good, provided always that the patentee was the discoverer of the principle or idea.

(2) “In order that a patent may secure to the patentee the application of a principle by means different to those described in the specification, it is only necessary that the principle itself be *new*, and the patentee sufficiently describes a means of applying it. *It is not necessary that the means, as well as the principle, should be new, for the novelty of the invention consists in applying the new principle by the means specified.* If, however,

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

not only the principle but the means is also new, then the means may form the subject of a distinct claim or a separate patent."

(3) "If a principle is *not new*, whether or not it has been successfully applied before does not matter, a patent for a method of applying it only secures to the patentee protection in respect of the *particular method* specified, and there may be other perfectly valid patents in respect of different methods of carrying the same principle into effect." Finally I quote the words of Lord *Halsbury* L.C. in *Ashworth v. English Card Clothing Co. Ltd.* (1) where the learned Lord says referring to the judgment of Lord *Hatherley* in *Harrison v. Anderston Foundry Co.* (2):—"I think the judgment of Lord *Hatherley* most lucidly expounded the principle on which in patent law you may have a principle so far made the subject of a claim in a patent by reason of the *thing itself*—the whole principle—being an *invention* and then being reduced into practice." It is therefore all important to distinguish between ideas that are new and ideas that are old. The formula of *Fletcher Moulton* L.J. in *Hickton's Case* (3) sums the matter up correctly.

This appeal should therefore I think be allowed.

Appeal dismissed.

Solicitor, for appellant, *P. J. O'Donnell*.

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

(1) 20 R.P.C., 790, at p. 797.

(2) 1 App. Cas., 574.

(3) 26 R.P.C., 339.

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