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ance and consequent thereon, and substituting a declaration that the plaintiff is entitled to damages for breach of the contract in the pleadings mentioned, and limiting the order for costs to the costs up to and including the costs of the trial.

Cause remitted to Supreme Court.

Solicitors, for the appellant, *James & Darbyshire*, Perth.

Solicitors, for the respondent, *Lohrmann & McDonald*, Perth.

N. McG.

[HIGH COURT OF AUSTRALIA.]

McDONALD AND ANOTHER . . . APPELLANTS;

AND

THE COMMISSIONER OF PATENTS . . RESPONDENT.

ON APPEAL FROM THE COMMISSIONER OF PATENTS.

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MELBOURNE, *Feb.* 27, 28,

Griffith C.J., Barton, Isaacs and Gavan Duffy JJ.

Patent—Application—Refusal to accept application and specification—Appeal to High Court from Commissioner of Patents—Costs—Patents Act 1903-1909 (*No.* 21 *of* 1903—*No.* 17 *of* 1909), *sec.* 46.

Where an application for a patent, accompanied by a specification, has been duly lodged with the Patents Office, and there is no objection to the specification on the ground that the invention is already patented, or is the subject of a prior application for a patent, the Commissioner should not refuse to accept the application and specification unless it is clear and obvious that a patent cannot be granted.

Therefore, where there was evidence that the device for which a patent was sought was new, useful, effective and convenient in use, and involved some substantial exercise of the inventive faculty:

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Held, that the Commissioner was wrong in refusing to accept the application and specification.

The costs of an appeal to the High Court from the decision of the Commissioner are in the discretion of the Court.

APPEAL from the Commissioner of Patents.

An application was made by Murdoch McDonald and George Walter Hall for a patent for an "improved attachment for wheels of self-propelled vehicles." The provisional specification lodged with the application described the nature of the invention as follows:—"This invention has been devised with the object of providing simple means which can be readily attached to or detached from the wheels of motor cars or other self-propelled vehicles, which will prevent 'racing' or skidding when traversing loose or slippery ground. According to this invention separate chains are passed transversely around the tire in front of or attached to the spokes, and thus afford a better gripping means for the wheels." The complete specification further described the invention by reference to certain drawings substantially as follows:—According to this invention, a number of separate chains are passed transversely around the tire and rim in front of or attached to the spokes in order to prevent the tire skidding or racing when on loose or slippery surfaces. The chains may be straight and long enough to pass around the tire and rim and then around the spoke, and the extremities are adapted to be clipped or hooked together by a spring clip or hook or the like to hold the same in position. If preferred, the chain may be provided at one extremity with a double end, that is, with two branches, in order to facilitate the fastening of the same to the spoke, while the other extremity is provided with a hook. With this arrangement the double end is passed around the spoke and the end link of one branch is passed through the end link of the other branch; the main portion of the chain is passed transversely around the rim and tire, and the hook is then connected with the end link of the first mentioned branch, when the end link of the second mentioned branch will fall back over the outer end of the hook and so form a lock or keeper, thus preventing accidental displacement of the chain. The claims in

the complete specification were:—"(1) An attachment for wheels of self-propelled vehicles consisting of a number of separate chains passed transversely around the tire and rim in front of, or attached to, the spokes. (2) An attachment for wheels of self-propelled vehicles consisting of a number of separate chains provided at one end with a hook or clip and adapted to be passed transversely around the tire and rim, and around the spokes, the two ends being then fastened together. (3) An attachment for wheels of self-propelled vehicles consisting of a number of separate chains each provided with a double end at one extremity and with a hook at the other extremity, and adapted to be passed transversely around the tire and rim, and around the spokes, the end link of one branch of the double ends being adapted to pass through the corresponding link of the other branch and encircle the spoke, and the hook being adapted to hook into the first mentioned end link and to be locked, substantially as described and illustrated."

The Commissioner referred the specification to the examiner for his report, and he reported against it on the grounds that the specification was a mere working direction for placing an ordinary chain round the tire and rim of a wheel of a motor car or like vehicle, and therefore did not describe a manner of new manufacture; and that the invention, the subject of the third claim, was not outlined in the provisional specification. The Commissioner, on those two grounds and on the third ground of want of novelty, refused to accept the application and specification. The ground of want of novelty was based on a prior specification for an invention consisting of a coat of mail or network of chain to cover the whole of a rubber tire.

From this decision the applicants now appealed to the High Court.

Mann, for the appellants. The Commissioner has held on the authority of *Rogers* v. *Commissioner of Patents* (1), that the appellants have in their specification given merely a working direction. But this device is a combination of known mechanical appliances which effects an old purpose with greater efficiency.

(1) 10 C.L.R., 701.

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It also involves an exercise of the inventive skill, and is therefore good subject matter for a patent: *Willmann* v. *Petersen* (1); *Peacock* v. *D. M. Osborne & Co.* (2); *International Harvester Co. of America* v. *Peacock* (3). The novelty is the tying of single transverse chains in the manner described in the specification. This is distinct from the coat of mail or network of chain, and also from the "ladder chain," which consists of two chains passing around the circumference of the wheel with short cross chains joining them and passing across the face of the tire. The Commissioner should not stop the patent at this stage. [He also referred to *Frost on Patents*, 3rd ed., vol. I., p. 33; *Edison Bell Phonograph Corporation Ltd.* v. *Smith* (4).

[ISAACS J. referred to *Boulton* v. *Bull* (5).]

Schutt, for the respondent. The appellants' claim is merely a direction for putting chains traversely round the wheels of motor cars. They have shown no special method of doing that, but have merely described an idea: *Frost on Patents*, 3rd ed., vol. I., p. 77; *Patterson* v. *Gas Light & Coke Co.* (6); *Schwer* v. *Fulham* (7).

[ISAACS J. referred to *Vickers, Sons & Co. Ltd* v. *Siddell* (8); *Halsbury's Laws of England*, vol. XXII., p. 136].

There is no such ingenuity disclosed as deserves a patent. There cannot be any ingenuity in giving directions how to do a thing.

Mann, in reply.

GRIFFITH C.J. This is an application by way of appeal from the refusal of the Commissioner of Patents to accept an application for a patent. If he accepted it, the acceptance would be advertised and any person might object to the grant on various grounds stated in the Statute. Those objections, when made, would be investigated, and on hearing them the Commissioner would have to give his decision. The Statute provides, by

(1) 2 C.L.R., 1.
(2) 4 C.L.R., 921, at p. 932.
(3) 6 C.L.R., 287.
(4) 11 R.P.C., 389, at p. 398.
(5) 2 Bl. H., 463, at p. 492.
(6) 3 App. Cas., 239.
(7) 11 C.L.R., 249.
(8) 7 R.P.C., 292.

sec. 46, that if the Commissioner is satisfied that no objection exists to the specification on the ground that the invention is already patented in the Commonwealth or in any State, or is already the subject of any prior application for a patent in the Commonwealth or in any State, then, in the absence of any other lawful ground of objection, he must accept it; but, if he is not so satisfied, he may either accept it on a certain condition or refuse to accept it. The existence of any other lawful ground of objection is a reason justifying the Commissioner in refusing to accept the application. One ground that might be taken is that the invention is not novel. Now, it is evident that, if the Commissioner stops the patent at that stage, it is a final bar. The opportunity for giving evidence in answer to any opposition that might be set up on the ground of novelty has not arisen. I think that it is only in a clear case, where it is obvious that a patent cannot be granted, that the Commissioner should reject an application altogether.

The real objection made in the present case is on the ground of want of novelty. That objection cannot be taken in England, but it is not the practice in England, when the matter comes before the Commissioner, to insist on conclusive proof, in answer to other objections, that the patent if granted will be valid. If a *primâ facie* case is made out, that is sufficient.

The alleged invention in this case is a method described clumsily in the specification as "an improved attachment for the wheels of self-propelled vehicles." It really is a device for stopping the slipping or skidding of wheels having inflated tires. The method of the alleged invention is in putting round the tires and felloes of such wheels chains, either attached or not attached to the spokes. There is evidence to show that the device, when applied, is very effectual. If it were quite clear and obvious that the invention was not new, and was not subject matter for a patent at all, I think that the Court would be justified, as was done in *Rogers* v. *Commissioner of Patents* (1), in refusing to order the Commissioner to accept the application. But, if it comes within the rule laid down in many cases, then, in the words of my brother *Barton* and myself in *Willmann* v. *Petersen*

(1) 10 C.L.R., 701.

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(1):—"A combination of two or more known mechanical appliances the result of which is to effect a new purpose, or to effect an old purpose with greater efficiency or economy, may be the subject matter of a patent, if it involves some substantial exercise of the inventive faculty."

Now, it is said that the use of chains applied to the tires of such wheels is a well known device. I accept the suggestion that it is. Probably we have all seen such wheels with chains wound round the tires and passing between the spokes. It is probable, also, that one of the well known devices is what has been called the "ladder chain," that is, two chains around the circumference of the wheel, one on each side of it, with cross chains running transversely across the tire. I will assume that that is a well known device. But does it follow that short separate chains attached or not attached to the spokes are not an improvement? One advantage that occurs at once is that each chain is a small thing, easily handled. The inventor claims that it can be put on or taken off without getting out of the vehicle. They are light. It is, in my opinion, quite possible, at any rate, that the old purpose of preventing the wheels from skidding or slipping may be effected by this means with greater efficiency, economy or convenience. Any of these would be sufficient to entitle the applicant to a patent, provided that there be some substantial exercise of the inventive faculty.

It is objected that this device is so simple that anyone might have thought of it. As was said by Lord *Herschell* in *Vickers, Sons & Co.* v. *Siddell* (2), one may be led astray by the very simplicity of an invention into the belief that no invention was needed to produce it.

But I think that it would not be right at this stage of the proceedings to say finally that the inventor shall not have a patent for this device, which, according to the evidence, is useful, effective and convenient in use, or that he should not have an opportunity of putting forward evidence in support of his claim.

I think, therefore, that the Commissioner should have accepted the application. If, as I have pointed out, the patent, if granted, is invalid, the patentee will obtain nothing by it.

(1) 2 C.L.R., 1, at p. 21.

(2) 15 App. Cas., 496, at p. 502.

BARTON J. I think, too, that the Commissioner should have accepted the application. As the case stands at present, and without prejudging any future stage, I rather think it is within the principle of *Willmann* v. *Petersen* (1) and *Peacock* v. *D. M. Osborne & Co.* (2).

ISAACS J. I agree that this appeal should be allowed. An applicant for the grant of a patent has to run the gauntlet on several occasions. When he puts in his application the Commissioner is first of all interposed, as the protector of the public, practically to say whether the application is of such a nature that no member of the public ought to be harassed by having to object to it—whether it is so plainly wanting in merit, or subject matter, or so manifestly an infringement of some other patent, or so obviously an attempt to monopolize something already a matter of common knowledge, that the public ought not to be troubled to oppose it. Therefore, he may stop it at the very threshold—that is, subject to an appeal, as it is called, to this Court.

Isaacs J.

But to stop it at that stage is fatal to the applicant. If, however, it is not stopped at that stage, there are still means of preventing the applicant from having an improper advantage. The specification is open to the public, inspection is allowed, and an opportunity is given for opposition. At that stage, when it is brought on the applicant may be called upon by some person other than the Commissioner to defend his position. Even then, if the applicant be successful, the grant of the patent is not conclusive; for if it is granted the patentee holds it at his peril, and thereafter, if the patent turns out to have been granted improperly, it may be attacked, and, if the patentee attacks another person, his grant may be challenged and he may be beaten. So that it is a very strong step, indeed, to stop the applicant at this initial stage; and, so far as I can see at present, on the evidence now before us the Commissioner ought certainly to have accepted the application. This is not so clear a case, to say the least of it, that the applicant ought to be refused at this stage.

I agree in the judgment of the Court.

(1) 2 C.L.R., 1. (2) 4 C.L.R., 921.

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GAVAN DUFFY J. I have very grave doubt as to whether there is any new invention in this case, but, for the reasons stated by the Chief Justice, I agree that the appeal should be allowed.

Schutt. The Commissioner should have his costs of this appeal. In the case of trade marks in England, prior to the *Trade Marks Act* 1905 it was the practice to give the Registrar his costs of an appeal against a decision by him which was reversed: *Sebastian on Trade Marks*, 5th ed., p. 393.

Mann. In *In re McKay's Application* (1) the Commissioner was not given his costs. The costs are in the discretion of the Court.

GRIFFITH C.J. We think the costs are in the discretion of the Court. If, indeed, the Court can give costs against the Commissioner, still the granting of them is entirely within the discretion of the Court. We think that if an applicant is in any way to blame, or is asking for an indulgence, he may properly be ordered to pay costs. But that is not this case. The order will stand as pronounced.

Appeal allowed. Direct that the application and specification be accepted.

Solicitor, for the appellants, *F. B. Waters.*

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

B. L.

(1) (1909) V.L.R., 423; 31 A.L.T., 63.