

H. C. OF A.

1914.

GOLDS-  
BROUGH,  
MORT & CO.

v.  
CARTER.

*Appeal allowed. Judgment appealed from discharged. Verdict set aside and verdict entered for the defendants with costs of action. Respondent to pay costs of appeal.*

Solicitors, for the appellants, *Minter, Simpson & Co.*  
Solicitors, for the respondent, *Shipway & Berne.*

B. L.

## [HIGH COURT OF AUSTRALIA.]

THE AEOLIAN COMPANY . . . APPELLANTS ;

AND

STODDARD . . . RESPONDENT.

H. C. OF A. *Patent—Application—Want of novelty—Absence of invention—Prior user.*

1915.

MELBOURNE,  
March 18, 19.

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

It was a matter of common knowledge that the perforations on note-sheets for player-pianos might be prolonged beyond the line of the commencement of the next following perforation or perforations so as to avoid producing a *staccato* effect, and that by lengthening the perforations the duration of the musical notes corresponding therewith was extended. An application was made for a patent for improvements in note-sheets whereby it was proposed to prolong those perforations corresponding to such musical notes as were in harmony with the succeeding notes to such a length as to allow the strings of the particular notes struck to vibrate as long as the succeeding notes were in harmony with them.

*Held*, by the Court, that the application should be refused :

By *Griffith C.J.*, on the ground that there was no novelty ;

By *Isaacs* and *Rich JJ.*, on the ground that there was no invention.

APPEAL from the Commissioner of Patents.

Charles Fuller Stoddard applied for a patent for "Improvements in or relating to note-sheets for player-pianos and the



like," and the application was opposed by the Aeolian Co. on the grounds of want of novelty and prior publication. The Commissioner of Patents having dismissed the opposition, the Aeolian Co. now appealed to the High Court.

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—

The material facts are stated in the judgments hereunder.

*Mann*, for the appellants.

Sir *William Irvine* K.C. (with him *Braham*), for the respondent.

During argument reference was made to *Terrell on Patents*, 5th ed., pp. 158, 159; *McGlashan v. Rabett* (1); *Linotype Co. Ltd. v. Mounsey* (2).

GRIFFITH C.J. The subject matter of this alleged invention is "improvements in or relating to note-sheets for player-pianos and the like," that is, pneumatic sheets to be used on what are commonly called "pianolas." The principle of the pianola, as I understand it, is that for the mechanical pressure of the human finger upon the keys of a piano is substituted pneumatic pressure applied to the key desired to be struck. The manner in which the particular notes are selected is by passing over a proper apparatus a perforated sheet, so that the pressure is allowed to pass through the perforations at the appropriate time so as to depress the desired key. The duration of the depression to which the duration of the vibration of the string corresponds depends upon the length of the perforation—a longer perforation resulting in a longer vibration. For instance, a semibreve would be represented on the sheet by a long perforation and a semi-quaver by a correspondingly short perforation, and so on. When that invention was first brought into operation, it was thought by the inventors that each perforation should be of a length corresponding exactly with what would be the result if the key had been struck by the human finger. But it was discovered later that this method produced what is called a *staccato* effect, that is, a series of separate notes sharply separated from one another without any connection between them, which was not

(1) 9 C.L.R., 223.

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



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the effect produced by a skilful pianist. Other persons came forward, and said that that defect could be avoided by prolonging one perforation so as to overlap the next following one, and so avoiding the abruptness of transition. And, as the length of the note sounded depends on the length of the perforation, all that was necessary was to lengthen the perforation so as to overlap the next following one. This result was simply the application of what had been the principle of the invention from the first, that is, that the duration of the vibration of the string depended on the length of the perforation, so that the perforations were made as long as it was desired that the vibration should continue.

The present applicant seeks to make another use of the invention. He says that a very great improvement can be made in musical effect by continuing the notes for a very much longer time than was usual, or, indeed, than is practicable with an ordinary piano. For that purpose he says that you may lengthen the perforations still more, that, in fact, you may make them as long as you like, and so continue the vibration as long as you like, but, of course, so as not to produce discord with other notes which are afterwards struck concurrently with the vibration of the prolonged note. That is what he proposes to do.

A patent must be for some manner of new manufacture. What is there new? The apparatus was already known as an apparatus by which the vibration of the strings of a piano is continued as long as the person using it desires, and the length of the time of vibration depends on the length of the perforations.

The principle applicable to a case of this kind is that laid down by the House of Lords in *Harwood v. Great Northern Railway Co.* (1), and thus stated by Lord Davey in *Riekmann v. Thierry* (2):—"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."

In the present case the contrivance is old; it is applied in the ordinary way by lengthening the perforations in proportion to the length of time it is desired that the vibrations shall continue. There is no novelty in the mode of applying it; that remains

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

(2) 14 R.P.C., 105, at p. 121.



exactly the same as before. The discovery, if there be one, is that a certain musical result may be produced by having several notes sounding at once. That may be a new and desirable effect, but the means used are exactly the same as before, and that, as I understand the law, has never been considered to be patentable.

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It is suggested that the objection is one to subject matter. In one sense, perhaps, it is, but there must be something new. In the present case the contrivance used is precisely the same as it has always been. The only difference is that it is proposed to use it for a different purpose.

For these reasons I think that there is no novelty in the alleged invention, and that the objection ought to have been allowed.

ISAACS J. I agree that the appeal should be allowed.

The respondent claims that he conceived the idea that the continuous prolongation of all musical notes whatever, so long as discord with the succeeding notes is not occasioned, is an improvement in musical compositions because, he says, it produces a more pleasurable effect on the ear. He says further that he has indicated a way in which that can be carried out in practice, namely, by prolonging the perforations on the roll. Then he says that, having conceived a new idea and shown a way of carrying it out in practice, that is sufficient. In my opinion it is not sufficient unless invention is present. If the idea itself can properly be described as an inventive idea, then, having given that to the world and indicated a means of carrying it into practice, I think that would be patentable subject matter. The authority for that is *Hickton's Patent Syndicate v. Patents and Machine Improvements Co. Ltd.* (1).

But the idea itself seems to me clearly not to be an inventive idea, even if it be a new one.

We have then to go on to see whether the means indicated for carrying out the idea can be described as inventive. If the means he shows, namely, by prolonging the perforations, does involve invention in its adoption, the respondent is right; and I go further, and say that if at this stage it was reasonably doubtful

(1) 26 R.P.C., 339, at p. 347.



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whether it did involve invention, his application ought to be granted, and the ultimate determination of the question of invention or no invention should be left for future decision. But if it is not reasonably doubtful that there is no invention involved, then the application should be refused in the interest of the public, and this appeal ought to succeed.

Now, the test of that as applicable to this case may, I think, be expressed in this way:—If the means that Stoddard indicates would not have occurred to a person skilled in this class of instrument who was informed of the desired musical effect but was denied the exercise of invention, in other words, if such a person would have been able merely by the skilful use of knowledge already in his possession as a member of the public to produce the desired effect, there would be no invention, and therefore no patentable novelty. It is clear in law that no person has a right by getting a patent to deprive anyone of the right to exercise his skill and to make any use of known appliances in exercising it. In my opinion, that would be the effect of granting a patent in this case.

GAVAN DUFFY J. I agree.

RICH J. I have no reasonable doubt about the matter. It may be that the article was a new article in the market, but it appears to me that there is no invention in the idea or in the method of utilizing it.

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

Solicitors, for the appellants, *Blake & Riggall*.

Solicitor, for the respondent, *Madden, Drake & Candy*.

B. L.