

[HIGH COURT OF AUSTRALIA.]

REID APPELLANT;

AND

THE COMMISSIONER OF PATENTS RESPONDENT.

THE KING

AGAINST

THE COMMISSIONER OF PATENTS.

EX PARTE REID.

Patent—Application—Refusal by Commissioner to accept—Grounds of refusal— H. C. OF A.
Application informal—Appeal to High Court—Application under intercolonial 1915.
arrangements—Amendment—Mandamus—Patents Act 1903-1909 (No. 21 of
1903—No. 17 of 1909), secs. 32, 33, 46, 47, 121, 122—Patents Regulations MELBOURNE,
1912 (Statutory Rules 1912, No. 76), regs. 4, 31; Sched. 2, Form A6. May 28;

June 4, 7, 17.

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

The applicant having applied in New Zealand for protection of an invention applied for a patent for the same invention pursuant to secs. 121 and 122 of the *Patents Act 1903-1909*, the application being in accordance with Form A6 in Schedule 2 to the *Patents Regulations 1912*, and he lodged with the application a copy of the complete specification which had been lodged in New Zealand. The Commissioner refused to accept the application on the ground that a copy of the provisional specification which had been lodged in New Zealand did not also accompany the application. The Commissioner subsequently refused an application for leave to amend the application by converting it into an ordinary application for a patent under secs. 32 and 33.

Held, by Griffith C.J. and Gavan Duffy J. (Isaacs J. dissenting), that the refusal to accept the application was not a refusal from which an appeal lay to the High Court under secs. 46 and 47, and that an appeal did not lie

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from the refusal to allow the amendment, but that a mandamus should go to the Commissioner directing him to proceed with the hearing of the application for a patent.

By *Griffith C.J.*—The words “any other lawful ground of objection” in sec. 46 of the *Patents Act* 1903-1909 refer to objections to the specification, and do not include an objection that the application for a patent with which the specification is lodged is irregular in form.

APPEAL from the Commissioner of Patents, order *nisi* for mandamus, and motion referred to the Court.

Alexander Walker Reid on 21st August 1913 filed an application for a patent for an invention entitled “An improved milking machine pulsator,” the application being in accordance with Form A6 in Schedule 2 to the *Patents Regulations* 1912, which is applicable to applications for a patent under international or intercolonial arrangements as provided for in secs. 121 and 122 of the *Patents Act* 1903-1909. In the application the applicant stated that on 16th December 1912 he had made an application in New Zealand for protection of the same invention, and with the application was lodged a certified copy of the New Zealand complete specification for the invention.

On 10th January 1914 the Deputy Commissioner wrote to the applicant informing him that, on consideration of the New Zealand documents accompanying the application, it appeared that a provisional specification had been lodged by the applicant in New Zealand, and that he was therefore not entitled to the benefit of sec. 121, as the period of three months allowed by reg. 31 for lodging a copy of that provisional specification had expired. In the letter it was also added that the question of amending the application presented itself for consideration.

On 6th March 1914 the Deputy Commissioner again wrote to the applicant informing him that he adhered to his opinion that reg. 31 rendered it essential in cases in which the application for a patent in a foreign country or British possession was accompanied by a provisional and a complete specification, that the lodging of a copy of each specification within the time prescribed by that regulation should be observed as a condition in connection with sec. 121 of the Act.

On 12th June 1914 the Commissioner sent a written notice to

the applicant which was substantially as follows:—"I refuse the application and complete specification for the following reasons:—The application for the patent is made on Form A6 in Schedule 2 of the *Patents Regulations* 1912, and it is claimed that in consequence of an application in New Zealand for protection of the invention, the patent, if granted in the Commonwealth, should be dated as of the same date on which the protection for the invention in New Zealand was applied for, namely, 16th December 1912." After setting out the provisions of reg. 31 (1) and (2) of the *Patents Regulations* 1912, the notice continued:—"In the present case the application in New Zealand was, on the date of application for protection of the invention, accompanied by a provisional specification. Subsequently a complete specification was lodged, such lodgment being prior to the date of application for a patent in the Commonwealth. With the specification left with the application in the Commonwealth a copy of the New Zealand complete specification only was lodged. The regulation prescribes that 'a copy or copies of the specification or specifications and drawings' shall be lodged. In my opinion, in this case the words 'specification or specifications' in reg. 31 carry with them a condition that the application in the Commonwealth should have been accompanied by copies of the provisional and complete specifications filed in New Zealand. As this condition was not fulfilled at the time of lodgment of application in the Commonwealth nor within the extended time permitted by the regulation, the application for the patent within the terms of sec. 121 of the Act is irregular and cannot be proceeded with."

On 19th August 1914 the applicant applied for leave to amend the application of 21st August 1913 by converting it into an ordinary application for a patent.

On 24th August 1914 the Commissioner by letter to the applicant said:—"I have to advise you that the application" of 21st August 1913, "owing to its refusal and the time having expired for appeal, is not now before the Department as an application for a patent, consequently the application for amendment cannot receive consideration."

The applicant appealed to the High Court from the refusal by the Commissioner on 24th August 1914 to allow the amendment

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of the application. He also on 28th October 1914 obtained an order *nisi* for a mandamus calling upon the Commissioner to proceed to hear and determine the application for a patent. He further moved in the alternative for an extension of the time for appealing from the refusal by the Commissioner on 6th March 1914 to accept the application, and the motion was referred to the Full Court.

Other material facts are stated in the judgments hereunder.

Mann, for the appellant.

Starke, for the respondent.

During argument reference was made to *In re Main's Patent* (1); *Salvitis Proprietary Ltd. v. Registrar of Trade Marks* (2); *R. v. Smith* (3); *R. v. Thomas* (4); *R. v. Dodds* (5); *Local Government Board for Ireland v. The King* (6); *R. v. City of London Assessment Committee* (7).

Cur. adv. vult.

June 17.

The following judgments were read:—

GRIFFITH C.J. The relief sought by the actor in these cases, who is a resident in New Zealand, is limited to the modest request that an application for a patent for an invention of which he claims to be the inventor may be considered upon its merits, but he has been met by the Commissioner at every stage with objections which have hitherto deprived him of such consideration.

Sec. 33 of the *Patents Act* 1903-1909 provides that an application for a patent must be made in the form prescribed, and must be accompanied by either a provisional specification or a complete specification. It must contain a declaration in the form prescribed, setting out the facts relied on to support it. The application dates from the time of lodgment in the Patent Office.

(1) 7 R.P.C., 13.

(2) 4 C.L.R., 941.

(3) L.R. 8 Q.B., 146.

(4) (1892) 1 Q.B., 426.

(5) (1905) 2 K.B., 40.

(6) (1903) A.C., 402, at p. 409.

(7) (1907) 2 K.B., 764.

When a complete specification is not lodged in the first instance, it must be lodged within ten months after the date of the application, and if it is not so lodged the application lapses (sec. 38).

A patent, when granted, is to bear the date of the application (sec. 69). This date is material as fixing the date to be taken as the starting point in determining questions of priority or prior publication.

The specifications may not be published until the complete specification has been accepted (secs. 50, 52).

Sec. 121 of the Act modifies these provisions with regard to inventors who claim the benefit of arrangements with foreign States made under sec. 103 of the Imperial *Patents, Designs and Trade Marks Act* 1883 and applied to the Commonwealth. Sec. 122 authorizes the extension of these provisions by the Governor-General by Order in Council to inventions patented in other British Possessions. They have in fact been extended to the Dominion of New Zealand. The provisions, so far as material to the present case, are as follows:—

A person who has applied in a foreign State or British Possession for protection of his invention is to be entitled to a patent under the Act in priority to other applicants, and his patent, if granted, is to bear the date of the application made abroad.

The application must be made within twelve months from the date of the application made abroad. It must be made in the same manner as ordinary applications. It must be accompanied by a complete specification, which, if not accepted “within the period of twelve months,” shall with the drawings (if any) be open to public inspection at the expiration of that period.

The effect of these provisions is to confer upon the foreign inventor the privilege of obtaining an earlier date for the commencement of his monopoly. He must establish his right to it in the same way as in any other case. The invention which is the subject of the application is the same, and the rights of the applicant are the same, plus the additional privilege. The granting of the privilege is, however, subject to two conditions, that the application must be made within twelve months from the date of making the foreign application, and that it must be accompanied by a complete specification (instead of a provisional

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or complete specification at his option), and to the disadvantage that the complete specification will be open to public inspection at the end of the period of twelve months, whether the application is or is not granted. The essential fact is that the subject matter of the application is the same in either case.

The Regulations under the *Patents Act* (Statutory Rules 1912, No. 76) contain in the Second Schedule a series of forms, as to which reg. 4 provides that the forms in the Schedule "may, as far as they are applicable, be used in any proceeding under the Act or these Regulations to which they are appropriate." There is no other regulation as to their use or effect. A special form is given for applications under secs. 121 and 122. The contention now made by the Commissioner is that failure to adopt the appropriate form entails the loss of the right to protection of the invention itself.

Reg. 31 prescribes that in the case of applications under international and intercolonial arrangements a copy or copies, duly attested, of the specification or specifications and drawings filed or deposited by the applicant in the Patent Office of the foreign State or British Possession in respect of the first foreign application must, in addition to the complete specification as required by sec. 121, be left with the application or within such further time, not exceeding three months, as the Commissioner may allow.

Giving the fullest effect to this regulation, it is only relevant to the privilege of antedating the patent, and has nothing to do with the substantive right to protection of the invention itself. Assuming, therefore, that the regulation is not open to objection on the ground that it imposes an additional condition beyond those prescribed by the Act, and that failure to comply with it is fatal to the grant of that privilege, the only result would be that the applicant has made his application on a wrong form.

The applicant in the present case had on 16th December 1912 applied in New Zealand for protection of his invention.

On 21st August 1913 he lodged an application for a Commonwealth patent in the form appropriate to an invention in respect of which the applicant claims the privileges conferred by secs. 121 and 122, and with it lodged a complete specification. Nothing more was done in the matter until 10th January 1914, when he

received from the Deputy Commissioner of Patents a letter informing him that it appeared, on consideration of the New Zealand documents accompanying the application, that a provisional specification had been lodged by the applicant in that Dominion, and that he was, therefore, not entitled to the benefit of sec. 121, as the period of three months allowed by reg. 31 for lodging a copy of it had expired. It was added that the question of amending the application presented itself for consideration. The applicant's patent agent then interviewed the Deputy Commissioner, and urged reasons for construing reg. 31 in a different sense, but on 6th March the Deputy Commissioner wrote, adhering to his former opinion. The applicant's patent agent in Melbourne then communicated with the applicant's agents in New Zealand, and received from them a letter, dated 3rd April, in which they urged reasons for thinking that the opinion of the Deputy Commissioner was erroneous, a copy of which he sent by letter of 24th April to the Commissioner, asking for further consideration, and making a formal request for a hearing "in reference to the application." An appointment was made for 28th May, when the matter was discussed with the Commissioner himself.

On 12th June 1914 the Commissioner sent to the applicant's patent agent a communication in the following terms:—

"I . . . hereby give you notice that in accordance with the provisions of sec. 46 of the *Patents Act* 1903-1909 I refuse the application and complete specification for the above-mentioned invention for the following reasons."

He then pointed out that the application was made on the form appropriate to applications under secs. 121 and 122, and claimed priority as of the date of the application for protection in New Zealand, quoted reg. 31 at length, stated that a provisional specification had been lodged in New Zealand, and concluded:—
 "As this condition was not fulfilled at the time of lodgment of the application in the Commonwealth nor within the extended time permitted by the regulation, the application for the patent within the terms of sec. 121 of the Act is irregular and cannot be proceeded with."

This on its face purports to be a refusal of the application on the ground that it could not be proceeded with because it was

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irregular as an application for an antedated patent. Up to that time the Commissioner had not entered upon the consideration of the merits of the application as an application for a patent for the invention, but had only considered the question of the applicant's right to the privilege of earlier date. The objection was a preliminary one, regarded by the Commissioner himself as an irregularity, and had nothing to do with the merits of the application itself, which were not the subject matter of the decision. It is now sought to give it the effect of a decision upon the merits of the application, and it is strongly contended for the Commissioner that the only mode by which the effect of his refusal could be obviated was by appeal to this Court under sec. 47, and that the time for appealing from it, which had expired, should not be (if it could be) extended.

Secs. 46 and 47 of the Act are as follows:—

“46. 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 he shall in the absence of any other lawful ground of objection accept the application and specification without any condition, but if he is not so satisfied he may either—(a) accept the application and specification on condition that a reference to such prior specifications as he thinks fit be made thereon by way of notice to the public; or (b) refuse to accept the application and specification.

“47. (1) An appeal shall lie to the High Court or the Supreme Court from any decision of the Commissioner under the preceding section. (2) The Court shall hear the applicant and the Commissioner and shall decide whether and subject to what conditions, if any, the application and specification shall be accepted.”

It is to be observed that the power of the Commissioner to refuse the application and specification is by sec. 46 made dependent upon the condition expressed in the introductory words of the section: “If the Commissioner is satisfied that no objection exists to the specification . . . but if he is not so satisfied.” These words necessarily imply that he has dealt with the specification and considered objections to it. The words “any other

lawful ground of objection" mean, in my opinion, objections to the specification, and do not include irregularity in the form of the application which it accompanies, which may or may not warrant a refusal to entertain the application at all.

If the Commissioner was right in his construction of the meaning and effect of reg. 31, upon which I express no opinion, the only consequence was that the applicant had, by adopting one form instead of another, and not complying with the regulation applicable when that form is adopted, lost the benefit of priority. This is quite irrelevant to the question whether there was any objection to the specification. If the word "objection" can be extended to include objections to the application as well as to the specification, it can only extend to an objection so far as it is material, and the only materiality that can be suggested is as to the date of the patent. In my judgment, therefore, the refusal of the Commissioner, although called by him a refusal under sec. 46, was not such a refusal, but was a refusal to entertain the application at all on the ground that the applicant had asked for more than he was entitled to obtain. An appeal lies to the High Court only in cases of decisions within the meaning of sec. 46; that is, decisions on merits. I am, therefore, of opinion that the decision was not appealable.

The applicant did not appeal from it within the prescribed time, but his patent agent on 19th August, after further communication with his New Zealand principals, asked leave to amend the application by converting it into an ordinary application, as suggested by the Deputy Commissioner in his letter of 10th January. This application was refused, and an appeal is brought from it. For the reasons I have already given, I do not think that an appeal lies from this refusal.

The only question, therefore, is whether the applicant is entitled to an order in the nature of a mandamus requiring the Commissioner to proceed upon the application. Under the circumstances which I have stated, it appears to me that the Commissioner has never adjudicated upon the application regarded as an application for protection of the invention, but has simply declined for irrelevant reasons to enter upon consideration of it. The appropriate remedy for such a declension of duty is

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mandamus. The only reason that can be urged against granting such relief in the present case is the applicant's delay in asking for it. Such delay might be a bar to a request to have the application dealt with as an application for the privilege of priority which was refused in June, but the subsequent delay is fully accounted for. For these reasons I am of opinion that the applicant was entitled to have the merits of his application considered and adjudicated upon by the Commissioner, and that he has not lost this right by any delay on his part.

I think it right to add that I should have supposed that the attitude of a public officer who, by his mistake, has done to a member of the public an injury which is irretrievable unless the mistake can be corrected, would be one of regret and sympathy, instead of an attitude of active hostility such as has been taken up by the Commissioner in this case.

In my judgment the order *nisi* for a mandamus should be made absolute.

ISAACS J. I have not been able to arrive at the same conclusion.

On 21st August 1913 the appellant made what is known as an intercolonial application. In England it is called a convention application. It was in form A6, and was headed "Application for a Patent under International or Intercolonial Arrangements," and was only permitted to be made for a patent of that class. The body of the document asked "that a patent may be granted to me in priority to other applicants for an invention entitled 'An improved milking machine pulsator,'" and that "such patent shall have the date the 16th December 1912." In it he declared that he had made foreign application for protection of his invention in New Zealand, on 16th December 1912. No other application has ever been made, and no right has ever been shown even *primâ facie* on which to found any other claim. At a later date the appellant asked leave to amend this application of 21st August 1913, and this forms a separate branch of the case.

On 10th January 1914 the Deputy Commissioner of Patents, before the office dealt with the application, took the trouble to draw the appellant's attention to a legal difficulty in his way, by

reason of non-compliance with reg. 31 in not lodging a certain provisional specification, a difficulty only discoverable after examination of the New Zealand certificate. The office suggested an amendment of the application, but manifestly an amendment forthwith, before the application was dealt with.

The appellant's patent attorney says he understood the suggestion to be that the application should be converted into an ordinary application for a patent, and he conveyed that to his real principals, Henry Hughes Limited. That firm, being desirous of retaining the application in its existing form, took no notice of the suggestion, but still pressed the application in its then shape, and urged the reception then of the New Zealand provisional specification. In other words, he insisted on a patent under sec. 122 and nothing else. After an interview with the Deputy Commissioner, that officer on 6th March 1914 adhered to his view that it was too late to comply with reg. 31. The views of the appellant were still pressed; a formal hearing was by letter of 24th April 1914 applied for to have the application proceeded with, to have the application accepted. On 28th May 1914 the hearing took place. Up to this time, as already mentioned, no application had been made to amend or to ask for anything but the one thing, a convention patent—in fuller terms, a patent permitted by sec. 122. The suggestion of the Department to alter the application was still absolutely ignored.

Nothing else being asked for, obviously nothing else could have been granted. Further, nothing else could then have been properly asked for on the materials before the Commissioner, because there was no evidence that the appellant satisfied the conditions of sub-sec. 3 of sec. 32 or sub-sec. 2 of sec. 33. On 12th June 1914 the Commissioner notified the appellant in these words: "In accordance with the provisions of sec. 46 of the *Patents Act* 1903-1909 I refuse the application and complete specification" &c. He gave reasons, but the potent fact is that the Commissioner left no doubt that his refusal was intended to be a refusal within the meaning of sec. 46 of the Act—in other words, a total refusal of both application and specification, and therefore an appealable refusal. The refusal of the specification seems to me decisive that the whole matter was ended. His

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reasons summarized are: (1) the application is only for a convention patent, and (2) reg. 31 has not been followed; (3) this makes the application "irregular," and therefore it cannot be proceeded with. "Irregular" there means not in conformity with law.

On 14th July 1914 this refusal was publicly notified in the *Australian Official Journal of Patents*, and the matter treated as finally ended.

No appeal or other attempt to review that decision was made. On 19th August 1914 the appellant then applied to do what was suggested before the application was heard and disposed of, namely, to amend the application by converting it into a different thing, namely, an application for an ordinary patent. A fee of £2 was forwarded therewith, and a declaration stating certain circumstances alleged as grounds for the alteration. It amounted to an application to change the A6 into a form for an ordinary patent, but to antedate the actual application for such patent, which would be clearly wrong if a new application is required. See sec. 33 (3).

On 24th August the Commissioner said that as the application had been refused there was nothing to amend.

I have stated these facts at length because of the immense importance of the case, both nationally and internationally, with reference to the right, and the limitation upon the right, of getting patents and priorities.

Further, notwithstanding any attitude of the respondent, through his learned counsel, in this case, which avoided questioning the accuracy of the Commissioner's former treatment of some similar applications, I conceive the rights of the public, and the reciprocal rights and obligations of applicants under the convention sections of the Act, are more important than office regulations, and are essential to be ascertained. As an instance: I am not prepared to assume, on the mere unwillingness of the Commissioner to contest it, an interpretation of the law which may lead the appellant to think he has rights which he does not in my opinion possess, or may deter the public from contesting a monopoly which the law does not allow. It is not at all like

the case of a private litigant who makes admissions which only bind himself.

The appellant has appealed against the decision of 24th August 1914, and has obtained an order *nisi* for mandamus with respect to both the decisions of 12th June and 24th August. He has no appeal against the former decision, and the time for appealing has long elapsed.

There are, in my opinion, clear reasons why the mandamus to hear and determine the earlier application cannot be sustained. The first is that there was no failure to hear and determine. It was heard and determined and was refused by the Commissioner; and, however erroneous his construction of the law of the case might be, he had done his duty, and a mandamus is not an appropriate remedy.

It is said, however, that he did not finally and completely refuse the application, but merely dealt with the priority part, leaving the main and essential portion unaffected and still awaiting determination. As to this, the view is in the first place, as it appears to me, quite opposed to the facts. The applicant deliberately refrained from regarding the application as for anything but a convention patent; and the Commissioner, finding his courteous suggestion ignored, dealt with the whole matter completely, as he thought. He was not asked to do more, and did not refuse. The observations of Lord *Lindley* in *Local Government Board for Ireland v. The King* (1) are in point, and, as I venture to think, conclusive.

But further, the view assumed is, as I read the law, an impossible one, and this notwithstanding the reluctance of the Commissioner to urge the point. Sec. 122 makes the Order in Council of 15th March 1905 of statutory force. That Order says, *inter alia*, "the application for the grant of a patent under the said section must be made in the same manner as an ordinary application under the said Act." To my mind it is difficult to imagine a more obvious legislative recognition of the separateness of the two applications—the ordinary and the intercolonial. The real identity between the two cases consists in this: that in each case a patent in the same form given in the Schedule to the

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(1) (1903) A.C., 402, at pp. 409, 410.

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Act is ultimately issued to the successful applicant. The applications, which are the roads to the same end—a patent—are distinct and separate, and the date to be inserted in the patent varies with each, and the rights under which it is claimed vary; and that is the true position.

The contention that the two applications are identical in the essential point, and that each can be read for the other, is, with great deference to the contrary opinion, inconsistent with the legislation.

An application under sec. 122 and an application under the general part of the Act for the same invention are different applications. The period of commencement and the consequent terminal period of the patents sought for are different. Further, the persons who are entitled to the ordinary patent are not the same. They are particularized in sec. 32. But the person who is entitled to an international or intercolonial patent under sec. 121 or sec. 122 is any person who has applied for protection abroad, whether he answers the description in sec. 32 or not, and only that person. See *In re Carez* (1).

Lord *Alverstone*, when Attorney-General, held in *In re Shallenberger* (2) that a patent under the International Convention—that is, sec. 103 of the English Act as it then stood—could only be granted to the person who had made the foreign application. He pointed out in the most distinct terms the different conditions under which patents could be taken out, and each required whatever form was prescribed for it, one of them being the foreign patentee. He held that the applicant had to make his application in the appropriate form, and said: “Mr. *Thompson* must elect whether or not he will proceed under the Convention, and under sec. 103, or whether he will proceed on the ground that he is the first and true inventor.” And see *In re Carez* (1).

In *British Tanning Co. v. Groth* (3) the subject came again under examination by *Romer J.* The patent was a convention patent, but, as was pointed out by Sir *Richard Webster A.-G.* (4), when the application was made there were no rules as to the manner of the application, and the application

(1) 6 R.P.C., 552.

(2) 6 R.P.C., 550.

(3) 8 R.P.C., 113.

(4) 8 R.P.C., 113, at p. 119.

was made in the ordinary way. *Romer J.* laid it down most distinctly that a person applying for an English patent, if he had previously obtained a foreign patent, has according to the Act a double right—of *applying* for the restricted patent or restricted rights under sec. 103, or to obtain the ordinary patent for the full period. At that time, as there was no difference in the form of application, the only way it could, after grant, be told which form of patent was applied for, was to look at the date of the patent granted. But the two distinct rights and the distinct applications for those rights were plainly recognized.

Then came the *Acetylene Co.'s Case* (1), where, at p. 222, Lord *Wrenbury*—then *Buckley J.*—(whose decision was affirmed on appeal (2)) seems to place the matter beyond reasonable doubt. The application was in common form on 1st September 1894, which was just over six months after his foreign application, the statutory seven months expiring on 28th September. Subsequently, on 20th June 1895, just before lodging his complete specification, he wrote in, desiring to take advantage of sec. 103. It was held he had elected to make the common application, and as the time had passed—namely, seven months—he could not then make the other application. *Buckley J.* said that the effect of sec. 103 is that if the man has applied in the foreign State, he has two alternatives, and may take which he likes. Later on he read the proviso, which corresponds with the first proviso in sec. 121, and was in these terms:—"Provided that the application is made, in the case of a patent, within seven months from his applying for protection in the foreign State with which the arrangement is in force." His Lordship proceeded:—"Now which is the application there spoken of? In my opinion it is his application under this section—his application upon which he says: 'Of the two alternatives offered me I will take the patent dating back to the date of my foreign application.'"

It is clear, from all these cases, that the election which the person applying for a patent is called upon to make is not the choice at the end of the proceeding, whether the patent shall be issued in the one form or the other, because if that were the case,

(1) 19 R.P.C., 213.

(2) 20 R.P.C., 161.

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the application once made would stand good the whole time for either, and the grounds of the decision in the *Acetylene Co.'s Case* (1) would have been wrong. But he cannot have a Jekyll and Hyde application; he must choose, and his choice is to be as to what application he is to make, and this is necessary, as *Buckley J.* points out in the course of his judgment, in fairness to other applicants. It may be that, apart from prohibitory limitations, he may, after one application is ended by withdrawal or otherwise, make the other; but, if so, it is an entirely new application.

I am, therefore, clearly of opinion the mandamus as to the June decision should be refused on every ground. Mr. *Starke* also pressed that, failing all else, it should be refused on the ground of discretion. The delay from 24th June to 14th September, he urged, was so great that the members of the public might have relied upon the refusal to act to their prejudice. I give no opinion on this as unnecessary, though it has considerable weight.

With respect to the August decision, if the June determination was a complete refusal, of course the decision was right. If it was not, that must be so because the application, divested of its intercolonial character, remained an ordinary application. If so, the amendment asked for was unnecessary, and, indeed, superfluous—and although a wrong reason would in that case have been given, the decision was right. No request was made to hear the application itself, in its simple form, and consequently neither appeal nor mandamus can be properly allowed.

In my opinion the whole of the present applications were very properly opposed, and should be dismissed with costs.

GAVAN DUFFY J. Counsel in this case agree in thinking that the non-compliance with reg. 31 can have no further effect than to deprive the applicant of the benefit of sec. 121. The point of difference between them is whether the applicant, not having appealed against the decision of the Commissioner intimated in his letter of 12th June, is now without a remedy. I agree with the Chief Justice in thinking that appeal is not the proper remedy

in respect either of that determination or of the later determination in August. If that be so, our jurisdiction to issue mandamus is not questioned, and I think our discretion will be wisely exercised by doing so.

H. C. OF A.
1915.
REID
v.
COMMISSIONER OF PATENTS.

Order absolute for mandamus.

Solicitors, for the appellant, *Eales & Miller.*

Solicitor, for the Crown and the respondent, *Gordon H. Castle,*
Crown Solicitor for the Commonwealth.

B. L.

Dist
Gabriel v Ah
Mook (1924)
34 CLR 591

Foll
Schiffmann v
Whitton
(1916) 22
CLR 142

[HIGH COURT OF AUSTRALIA.]

SYMONS APPELLANT;

AND

SCHIFFMANN RESPONDENT.

ON APPEAL FROM A COURT OF GENERAL SESSIONS OF VICTORIA.

Customs Law—Interference with goods in control of Customs—Evidence—Burden of proof—Averment in information—Customs Act 1901-1914 (No. 6 of 1901—No. 19 of 1914), secs. 33, 255.

H. C. OF A.
1915.

Practice—High Court—Appeal from Court of General Sessions of Victoria—Case stated—Justices Act 1890 (Vict.) (No. 1105), sec. 139—Rules of the High Court 1911, Part II., Sec. IV., r. 1.

MELBOURNE,
Sept. 22.

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

On an information under sec. 33 of the *Customs Act 1901-1914* for interfering without authority with certain goods subject to the control of the Customs, the Crown gave evidence to the effect that the goods had been imported into Australia, that duty was not paid on them, that they were not delivered to the importer, and that a month after importation they were found in the possession of the accused. No evidence was called for the accused.