

that in relation to one matter specific provision is made for representation by counsel does not necessarily cut down the common law right as to another matter contained in another section which is silent upon that point. Then there is another reason why sec. 48 is inapplicable impliedly to cut down the right of an appellant under sec. 50 to be represented by counsel: if sub-sec. 1 of sec. 48 had that effect, then sub-sec. 2 would have a similar effect, and when sub-sec. 2 is looked at, such a result would be absurd.

Therefore I agree that the order *nisi* should be made absolute for a mandamus in the first alternative.

*Order absolute in the first alternative.*

Solicitors for the applicant, *Doyle & Kerr*.

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[HIGH COURT OF AUSTRALIA.]

CALDWELL . . . . . APPELLANT;

AND

THE COMMISSIONER OF PATENTS . . . RESPONDENT.

*Patent—Application—Anticipation—Acceptance of application and specification—  
Patents Act 1903-1909 (No. 21 of 1903—No. 17 of 1909), sec. 46.*

The Commissioner of Patents should not refuse to accept an application and specification in respect of an alleged invention that is said to solve a problem which hitherto has been thought to be insoluble, merely because the alleged invention is very similar to a contrivance intended to effect the same object which was patented in the Commonwealth many years ago.

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H. C. OF A. APPEAL from the Commissioner of Patents.

1916.

CALDWELL

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Norman Lawrie Caldwell applied for a patent for "an improved device for overcoming the break of gauge difficulty in railways," and lodged a complete specification, the material parts of which were as follows:—

"My invention relates to an improved device for overcoming the break of gauge difficulty in railways, and whilst it may be applicable to varying circumstances of construction it is intended more particularly to apply to the principal requirements of the Trans-Australian railway, wherein the gauges mostly to be considered are the 5 ft. 3 in. and the 4 ft. 8½ in. These differences in gauge represent a total of 6½ in., which when divided between two sets of rails reduces the margin of variation to 3¼ in. on each side.

"To overcome this difficulty I provide a wheel of approximately double the width of an ordinary railway vehicle wheel, and having two treads formed thereon. I am aware that wheels having a somewhat similar appearance to my invention have hitherto been formed by combining together an ordinary built-up iron wheel comprising an iron rim which surrounds a set of iron spokes, which said spokes are attached to and radiate from a nave or hub, all such iron parts being mechanically united together, and these parts being subsequently contained within a steel tyre and attached thereto by mechanical fastening devices, as for instance by studs or bolts.

"A built-up structure such as I have described, and embracing a number of separable subordinate parts is illustrated in connection with Phillip George Brunton's Victorian Specification, No. 3705.

"So far as I am aware the built-up wheel above described, which was the subject of a patent application upwards of thirty years ago, has not found favour with engineers for various reasons, amongst others being that the width of the double tread steel tyre was much in excess of the width of the spokes and other portions of an ordinary standard iron wheel.

"To avoid the disadvantages incidental to a built-up structure the complete wheel which I have devised is characterized by being cast in one solid piece of iron or of steel, and as an integral casting it comprises in its structure a periphery having a flange



and double tread formation, as hereinafter more fully described, such parts being inseparable from the spokes and the hub or nave portion of the wheel, so that my wheel serves the purpose of two wheels placed side by side but in one single casting.

"In order that my invention may be better understood I will now proceed to describe the same by aid of the accompanying illustrative drawing wherein:—

"Fig. 1 represents a side elevation of my wheel, the upper portion being illustrated in section and the lower portion being shown as an external view.

"In the illustration *a* and *a1* are the treads of the wheel designed respectively to rest upon the broad gauge and narrow gauge rails. The periphery of the tread for the narrow gauge is greater than that of the broad gauge, and the difference in diameter is such as to result in forming an integral flange at *b* of suitable height to serve the same purpose as regards the tread *a* as does the ordinary flange *b1* in relation to its adjacent tread *a1*.

"The casting extends from the periphery or rim through the spokes or web *c* to the hub or nave *d* and the spokes or web may be curved as indicated by the dotted lines in the illustration to minimize the danger of fracture during the cooling of the casting.

"By constructing my improved wheel in the manner indicated I obviate the necessity of turning, fitting, and fastening the tyre and component parts of the wheel together as has hitherto been necessary in the wheel and double tread tyre structure referred to in the earlier part of this specification, and I thereby avoid the very great risk of a separable tyre becoming loose or fractured.

"It will be understood that pairs of wheels such as I have described are suitably spaced apart, and are mounted upon an axle so that they may traverse either broad or narrow gauge tracks *e* and *e1*.

"Having now fully described and ascertained my said invention and the manner in which it is to be performed, I declare that what I claim is:—1. An improved device for overcoming the break of gauge difficulty in railways, comprising in one casting a tyreless wheel combining the principal elements of two

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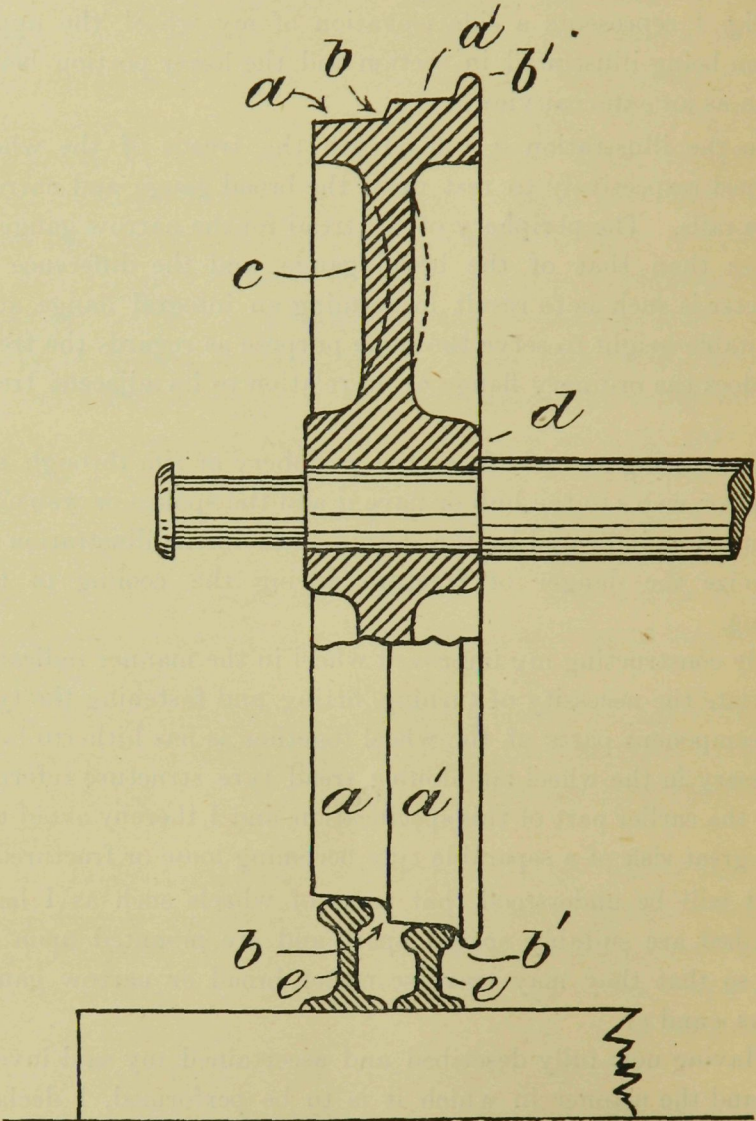
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wheels placed side by side, that is to say, a wheel having two treads of unequal diameter, an integrally formed shoulder which serves as a flange to the smaller tread, a flange for the larger tread, and a web or spokes and a hub or nave, all formed of iron or steel in one casting."

The following is a copy of the drawing above referred to as Fig. 1 :—



The Commissioner of Patents refused to accept the application and specification, and stated his reasons as follows:—"I judge



the applicant's invention to be simply what has been described in the Victorian Specification No. 3705 as a double tread wheel, being differentiated therefrom in consisting of a tyreless wheel in one casting. In my opinion the fact that the wheel is cast in one piece does not distinguish it from the invention described and illustrated in the anticipatory specification and drawings (Victoria No. 3705) to a degree coinciding with invention. The casting of tyreless wheels having single treads and flanges is old, and it is not contended by the applicant that the casting of a tyreless wheel having two treads and two flanges involves other than known methods. The invention may be stated to reside in the manufacture of a wheel, having two treads and two flanges, in one casting. The casting of wheels being an old art and the application of tyres, formed with a double tread and having an outside flange to the larger tread and an integrally formed shoulder as a flange for the smaller tread, to wheels being known, I am unable to regard that which is claimed by the applicant as patentable subject matter."

From that decision the applicant now appealed to the High Court.

*Schutt*, for the appellant.

*Starke*, for the Commissioner of Patents, respondent.

[During argument reference was made to *Willmann v. Petersen* (1); *N. Guthridge Ltd. v. Wilfley Ore Concentrator Syndicate Ltd.* (2); *McDonald v. Commissioner of Patents* (3); *Hayward v. Hamilton* (4).]

GRIFFITH C.J. I think that there is enough in this case to show that the applicant should be allowed to proceed with his application. He claims to have invented a contrivance which will solve a problem which up to the present has been thought to be insoluble. It is said that thirty years ago someone invented a very similar contrivance, which however did not embody the

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(1) 2 C.L.R., 1.  
(2) 3 C.L.R., 583.

(3) 15 C.L.R., 713.  
(4) Griff. Pat. Cas., 115.



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element of combining two wheels in one. The problem of a workable contrivance had remained unsolved. When a man says he has discovered a means of doing something which people have for many years been unsuccessfully trying to do I think that it is a very strong thing to say to him "you have invented nothing and you shall not have a patent." I do not think that in a case of that sort the matter ought to be stayed at this stage. To direct the application to be received merely gives the applicant an opportunity of establishing that he has invented something in respect of which he should receive a patent.

I therefore think that the Commissioner should have accepted the application and specification.

BARTON J. On the whole I agree, although I have some doubts.

RICH J. Having regard to Brunton's specification and to common knowledge, I doubt whether it would require inventive ingenuity to combine the various elements for the purpose in view: *Mercedes Daimler Motor Co. Ltd. v. F.I.A.T. Motor Car Co. Ltd.* (1). As, however, my learned brethren think that at this stage the matter should not be stopped, I will raise no further objection.

*Appeal allowed. Commissioner directed to accept the application and specification.*

Solicitor for the appellant, *Louis Waxman*.

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

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(1) 32 R.P.C., 393, at p. 413.