[HIGH COURT OF AUSTRALIA.]

IN RE DUNLOP'S PATENT.

H. C. OF A.
1922.

MELBOURNE,
Oct. 18, 23.

Starke J.

Patent—Extension of term—Extension of period for making application—Grounds for extending term—Patents Act 1903-1921 (*No.* 21 *of* 1903—*No.* 24 *of* 1921), *sec.* 84.

Sec. 84 of the *Patents Act* 1903-1921 provides that "(1) A patentee may . . . present a petition to the High Court . . . praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent. . . . (7) Notwithstanding anything contained in this section the Court may, in its discretion, either before or after the expiration of the term of a patent extend the period within which proceedings may be taken for the extension of the term of the patent," &c.

A petition to extend the period within which proceedings might be taken for the extension of the term of a patent was not presented until three years after the patent had expired and eight months after the *Patents Act* 1921 (by sec. 4 of which sub-sec. 7 of sec. 84 was enacted) was passed, and the only ground for extending the period was that the patentee overlooked the fact that it was necessary to apply for an extension six months before the date of the expiration of the patent.

Held, that the period should not be extended.

Where the Court is not satisfied that the invention has conferred upon the public any special or peculiar advantage or is of that high degree of merit which, if everything else were satisfactory, would entitle the patentee to an extension of the term of the patent, the Court will not extend such term.

In re Saxby's Patent, (1870) L.R. 3 P.C., 292, followed.

PETITIONS under the *Patents Act* 1903-1921.

Two petitions were presented to the High Court by George Henry Dunlop, one praying that the period within which proceedings might be taken for the extension of the terms of the letters

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patent No. 3470 of 1905 might be extended, and the other praying that the letters patent should be extended for a further period of ten years or such other term as the Court might think fit.

The other material facts are stated hereunder in the judgment of *Starke* J., before whom the petitions were heard.

Stanley Lewis, for the petitioner.

Herring, for the Commissioner of Patents.

Cur. adv. vult.

Oct. 23.

STARKE J. delivered the following written judgment:—George Henry Dunlop filed two petitions in this Court, one praying that the period within which proceedings might be taken for the extension of the terms of the letters patent No. 3470 of 1905 be extended, the other praying that the letters patent be extended for a further period of ten years or such other term as the Court might think fit. An order in Chambers was made on 28th August 1922 giving leave to present a petition and take all proceedings for the extension of the letters patent, without prejudice to the objection that the proceedings were out of time; and it was also ordered that the application to extend the period within which proceedings might be taken for extension of the term of the letters patent be dealt with at the hearing of the petition for the extension of the patent. Both these petitions came for hearing before me, and are based upon the *Patents Act* 1903-1909, sec. 84, as amended by sec. 4 of the *Patents Act* 1921 (No. 24 of 1921).

The patent was granted on 22nd June 1905 for a term of fourteen years from its date, and therefore expired in June 1919. Under the *Patents Act* 1903-1909 the petition for extension of the patent should have been presented at least six months before the time limited for its expiration. But the Act of 1921 provides that the Court may, in its discretion, either before or after the expiration of the term of a patent extend the period within which proceedings may be taken for the extension of such term. The words of the section are wide enough to cover the cases of patents which had

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expired before the date of the passing of the Act (*cf. In re Brown's Patent* (1)). It seems to me, however, as it did to *Sargant* J. in *In re Brown's Patent* (2), *In re Poulsen's Patent* [No. 2] (3) and *In re Pierpont &c. Patent* (4), that it would have to be "a very special case indeed" to justify the extension of a patent which had expired two years and a half before the Act itself was passed, and more than three years before proceedings under the Act reach the Court.

The only ground suggested by the petition for the exercise of the discretion conferred upon the Court by the Act of 1921 is that the petitioner was engaged on contracts in Brisbane, and overlooked the fact that it was necessary to present a petition for an extension of the letters patent at least six months before the date of their expiry. Making every allowance for inadvertence, still the petitioner was wanting in ordinary care and diligence over a considerable period of time in protecting his invention, and, indeed, he forgot all about it. Under circumstances such as these I am not prepared to exercise in favour of the petitioner the discretion conferred by the Act of 1921.

The two petitions were, as I have already stated, heard together, and consequently the merits of the case were fully presented to me. It is therefore desirable, in the interests of the petitioner, that I should state, as shortly as possible, my view of the facts and of the result which I should reach upon those facts. In 1896 the petitioner obtained letters patent for an invention relating to the construction of walls or linings for tunnels or shafts, especially shield-driven tunnels. Shields were mainly used in tunnels driven in soft or yielding ground. By the year 1896 shields were a well-known engineering device, though there had been progressive improvements made since that date. The walls or linings used for tunnels which were shield-driven had hitherto been constructed either of cast iron or of concrete blocks. The former was costly, and, according to the petitioner, not altogether free from defects; the latter were both unsatisfactory and costly. The petitioner's invention of 1896 suggested wooden linings and described a construction consisting of a strong wooden lining of the outer form of the tunnel built of

(1) (1920) 37 R.P.C., 52, 142.
(2) (1920) 37 R.P.C., at p. 145.
(3) (1921) 38 R.P.C., 105.
(4) (1921) 38 R.P.C., 355.

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sections or segments forming rings and provided when requisite with continuous lines of horizontal struts. In 1905 the petitioner obtained the letters patent the subject of these proceedings. The same idea was the foundation of this later patent, but a much improved construction was described and claimed. In 1913 the petitioner also obtained letters patent for improvements on the 1905 construction, but the main improvement, as I understood the petitioner, consisted in an extension of the rib over to the edge of the shield, thus retarding the intrusion of water, mud or sand, between the shield and the lining. Apparently, however, the 1913 invention would not be practised if the 1905 invention were unprotected.

The petitioner claims that he gave to the public a useful alternative in the choice of material for the walls or lining of a shield-driven tunnel, and a novel method of construction of such walls or linings involving less cost and giving greater rigidity than the methods formerly practised. However this may be, the fact remains that the petitioner's invention has been little used and no "special or peculiar advantage" has accrued to the public by reason of it (*In re Bailey's Patent* (1); *In re Saxby's Patent* (2)). The wooden wall or lining construction has been used since 1896 in about two miles of tunnelling work; but in only about half a mile of this was the improved construction of 1905 used, namely, in certain sewerage works at Brisbane. I do not lose sight of the fact that the invention cannot from its nature come into general use quickly or on a large scale. Still, its future use seems wholly problematical. Engineers do not seem to have taken much interest in it, and I have no reason to suppose that they will depart in the future, any more than they have done in the past, from their accustomed methods of construction. The 1905 invention has been practically unused for seventeen years, and is likely, I am afraid, to remain unused for many years to come. I do not, of course, inquire into the novelty or utility of the 1905 invention so far as it affects the validity of the grant, but, in relation to the public, the petitioner has wholly failed to satisfy me that his invention has conferred upon them any special

(5) (1884) 1 R.P.C., 1, at p. 3. (6) (1870) L.R. 3 P.C., 292.

or peculiar advantage, or is of "that high degree of merit which, if everything else were satisfactory, would entitle the patentee to a prolongation" of his patent (*In re Saxby's Patent* (1)).

Under all these circumstances the petitions must be dismissed. The petitioner will pay the costs of the Commissioner of Patents.

Petitions dismissed with costs.

Solicitors for the petitioner, *Maddock, Jamieson & Lonie.*

Solicitor for the Commissioner of Patents, *Gordon H. Castle,* Crown Solicitor for the Commonwealth.

B. L.

(1) (1870) L.R. 3 P.C., at p. 294.

[HIGH COURT OF AUSTRALIA.]

DAVIS . . . . APPELLANT;
DEFENDANT,

AND

HUEBER . . . . RESPONDENT.
PLAINTIFF,

ON APPEAL FROM THE SUPREME COURT OF NEW SOUTH WALES.

H. C. OF A. 1923.

SYDNEY, *April* 12, 13, 16, 26.

Knox C.J., Higgins and Starke JJ.

Supreme Court (N.S.W.)—Equitable jurisdiction—Plaintiff entitled to indemnity—Claim for accounts and injunction—Claim for delivery up of property—Breach of contract—Action at law—Parties—Equity Act 1901 (*N.S.W.*) (*No.* 24 *of* 1901), *sec.* 16—*Common Law Procedure Act* 1899 (*N.S.W.*) (*No.* 21 *of* 1899), *sec.* 176.

The plaintiff, who carried on business in Australia as agent for the A company, which was a foreign company, in the course of carrying it on incurred on behalf of the A company certain debts for which he was personally responsible ; and in respect of those debts he was entitled to an indemnity out of the