as the declared willingness of Parliament that public moneys should be applied and that specified funds should be appropriated for such a purpose is a necessary legal condition of the transaction. It does not annihilate all other legal conditions.

The statutory contentions of the respondent failing, we are of opinion that, *quacunque via*, the appeal must succeed.

Appeal allowed. Judgment appealed from rescinded. Judgment for defendant with costs. Respondent to pay costs of appeal.

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

Solicitors for the respondent, *Lynch, McDonald & Elliott.*

B. L.

[HIGH COURT OF AUSTRALIA.]

DAY . . . . . APPELLANT;
APPLICANT,

AND

PERROTT . . . . . RESPONDENT.
OPPONENT,

Patent—Application—Opposition—Disconformity between provisional and complete specifications—Construction of specifications—Patents Act 1903-1921 (*No.* 21 *of* 1903—*No.* 24 *of* 1921), *secs.* 35, 56, 65.

The appellant lodged, pursuant to the *Patents Act* 1903-1921, a provisional specification for an invention called "improvements in toys and elements for construction thereof," from which it appeared that the object of the invention was in toys, similar to the well-known Meccano, to provide rigidity without the use of bolts and nuts. This object was to be obtained by so shaping the ends of each element that, when the end of one was passed through a hole in another,

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the two could be locked together by a key, and one form of key indicated was a pronged key which would fit tightly into niches one on each side of the end, which was passed through the hole. In his complete specification one of the appellant's claims was for a means of locking elements together which was independent of the shaped ends of the elements and was not referred to in his provisional specification.

The respondent opposed the grant of a patent on the grounds mentioned in sec. 56 (*d*) of the *Patents Act* 1903-1921, namely, that the complete specification claimed an invention other than that described in the provisional specification, and that such other invention formed the subject of an application made by the respondent in the interval between the leaving of the provisional specification and the leaving of the complete specification. The Commissioner of Patents upheld the opposition.

Held, by *Knox* C.J., *Isaacs*, *Gavan Duffy* and *Rich* JJ. (*Starke* J. dissenting), that there was disconformity between the provisional and the complete specifications, and, therefore, that the respondent's opposition was properly upheld.

APPEAL from the Commissioner of Patents.

On 21st April 1922 Alfred Carlyle Day applied for a patent for an invention entitled "Improvements in toys and elements for construction thereof"; and on 24th April he lodged at the Patents Office a provisional specification in which he declared the nature of his invention to be as follows:—"This invention relates to the production of toys and to means therefor. One object of the invention is to provide combinable elements of simple forms which allow of making easily and of disassembling a great multiplicity of different structures which will be reasonably rigid, durable, amusing and interesting, and which may have working parts. The elements I provide may be used in combination with other elements already used in connection with toy structure production. The elements I use include parts which will enable machinery and buildings and manufactured objects generally to be imitated. These elements include rails, strips or bars, blocks or bodies, planes, wheels, pulleys, cranks, levers, handles, bolts, brackets, stays, clutches, distance pieces, locking keys, bearings, chains, weights, springs, and other known mechanical integers. One novelty I provide is holes or slots having, extending outward from a central aperture, recesses in one or more pairs. I avoid the use of nuts and bolts altogether or to a large extent, and thus reduce expense and also

enable time to be saved in connecting elements together. The holes or slots in the elements are centrally circular, square or of other form adapted to receive members to be connected, such as circular shafting, tubes, channels, or bars of suitable cross-section, the extension recesses being narrow to enable narrow members such as ends or parts of other elements to be fitted into these recesses, and thus to be fixed. Strips and other elements which I provide have ends or lugs each narrowed and each having one of my slots. The ends are thus shouldered and each is provided with external niches or recesses. By providing these ends or lugs various connections of elements with one another become possible. Two bars would be connected at right angles to one another by inserting the end of one bar through a slot of the other bar, at an end or between the ends of the latter. The bars can be connected in various respective planes, the holes aforesaid having their extensions in different planes. These different planes are alternate as to extensions of successive holes in some cases, holes being spaced equally apart in one or more lines or predetermined series. From the aforesaid shoulders to the niches nearest them there is distance sufficient to allow of the fitting of one or more other elements such as a cross-bar, a spacer and a key; or two or three cross-bars and a key, these bars extending in desired directions: thus one bar might be vertical and two horizontal. A strip will often be used to connect and to act as a distance piece between two other strips. When several strips are connected together each will be locked by the next in position save that the last will be locked by a key or locking element. Some distance pieces or spacers are used which consist of elements having a slot having two or more extensions, extending radially so that the position of the distance piece could be varied. One form of key I provide has prongs bounding a recess; these prongs are flanged and tapered in some cases and thus the prongs can enter and tightly fill the niches in the elements. Such a key can be reversed and adjusted in various positions, and in one simple form is approximately U shape, but with a surface of any suitable area to bear on the element keyed. A narrow or the like end in an element is in some cases omitted where the required connections will not utilize the end. The strips and other elements will have various cross-sections and

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contours and will thus be like angle iron, T iron, channel iron, and of straight, zig-zag, wavy, angular and/or arcuate form, or so on. Ends may project in alignment with, or at any angle to, bodies or elements, and in the same or different planes. Some of the elements I use are thickened or weighted at desired parts, but separate weighted elements are readily connected to bars by projections having holes with extensions as aforesaid, any such hole being adapted to be fitted with shafting, tubing or the like. An element or body which contains rows of holes with extensions may have the rows parallel and the extensions alternating in direction, so that holes which are abreast but in different rows will have extensions parallel and/or in alignment and/or oblique to one another, so that many combinations of positions of connected elements may be adopted, allowing of many varied constructions. When circular shafting provided with a flat is passed through a hole a key can be inserted with its prongs in the extension of the hole, the key also pressing the shafting, preventing it from rotating. Shafting, wheels or the like are therefore made either rotatable or rigid at will. I provide abutments to be secured to elements such as shafting by means of keys to prevent longitudinal motion of parts. Thus an element attached to shafting could be between two abutments."

A complete specification was lodged by Day on 6th November 1922, and among the claims was one for "a constructional toy element for connecting purposes which has a tongue of reduced width formed by cutting it and bending the same at an angle to provide an abutment, the tongue being apertured to receive locking means."

The application was opposed by James Perrott on the ground (*inter alia*) "that the complete specification describes or claims an invention other than that described in the provisional specification and that such other invention forms the subject of an application . . . dated 22nd May 1922 made by me, the opponent, in the interval between the leaving of the provisional specification and the leaving of the complete specification." On the hearing of the application it was admitted that in that interval Perrott had applied for a patent for substantially the same invention as that described in the claim in Day's complete specification above set out. The

Commissioner upheld the opposition on the ground stated, and allowed Day one month within which to apply for leave to amend his complete specification under sec. 71 of the *Patents Act* 1903-1909, and, in the event of no application to amend being made within that time, the Commissioner decided that the patent should not be granted.

From that decision Day now appealed to the High Court.

Latham K.C. (with him *Sproule*), for the appellant. The Commissioner approached the question of whether there was disconformity between the appellant's provisional specification and his complete specification from the wrong point. He first construed the provisional specification and sought to find from it the precise means there specified for producing the desired result. Having formed a conclusion on that matter, he then considered the complete specification, and found that it claimed something additional, and held that in claiming that something additional there was disconformity. He should have first construed the complete specification and, having determined what it covered, he should then have inquired whether the provisional specification fairly foreshadowed what was claimed in the complete specification. (See *Siddell* v. *Vickers, Sons & Co.* (1); *Woodward* v. *Sansum & Co.* (2); *Dunlop* v. *Cooper* (3); *Penn* v. *Bibby* (4); *Pneumatic Tyre Co.* v. *Ixion Patent Pneumatic Tyre Co.* (5).) On its proper construction the provisional specification is wide enough to include the claim in the complete specification which was objected to.

Robert Menzies (with him *Fullagar*), for the respondent. One test of whether there is disconformity is whether, if the invention described in the provisional specification had been patented, that described in the complete specification would be an infringement (*Dunlop* v. *Cooper* (6)). Another test is whether the nature of the invention which appears in the complete specification is sufficiently indicated in the provisional specification. Applying either of those tests, the appellant fails.

(1) (1887) 5 R.P.C. 81, at p. 97; (1888) 39 Ch. D. 92; (1890) 15 App. Cas. 496.
(2) (1887) 4 R.P.C. 166.
(3) (1908) 7 C.L.R. 146, at pp. 166, 167.
(4) (1866) L.R. 2 Ch. 127.
(5) (1897) 14 R.P.C. 853, at p. 869.
(6) (1908) 7 C.L.R., at p. 157.

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Latham K.C., in reply, referred to *Gadd* v. *Manchester Corporation* (1).

Cur adv. vult.

May 26.

The following written judgments were delivered :—

KNOX C.J. AND GAVAN DUFFY J. The appellant applied for the grant of a patent for an invention for "improvements in toys and elements for construction thereof." The application was opposed by respondent and refused by the Commissioner on the ground of disconformity between the provisional and the complete specifications. This is an appeal from that decision.

The Commissioner, in giving his decision, said :—"Now, on analysis, what is the nature of the invention described by the words to be found in the applicant's specification. The object of the invention is to provide improved means for obtaining a known result—that is, a rigid structure of the nature of a toy ; and the nature of the invention is to be found in the means which are provided for producing the result. The means consist of elements of particular design which, according to their relativity, are so disposed to represent particular structures and to be fixed in position by keys patterned in a manner to co-operate with a particular characteristic in the ends of the elements. The ends of the elements are specifically designed for adaptation in the making of rigid structures. The mere positioning of the elements according to their adaptability to each other does not produce the result—a rigid structure. It is essential, and it is of the essence of the invention, in producing the result to combine with the means for adapting one element to one or more other elements the locking means which reside in the co-operation of a key with the niches which are fixed features of the design which characterizes the ends of the elements. It is this combination, having integers of particular shape and functioning in a manner according to their shape, in which the nature of the invention resides. In introducing additional locking means into his complete specification which are at variance with

(1) (1892) 9 R.P.C. 516.

the locking means distinguished by the intercommunication of a key with the niches in the end of an element as described in his provisional specification, the applicant is asking for protection for more than he is entitled to. To the extent of the locking means which are described or claimed in the applicant's complete specification and which are additional to the locking means described in his provisional specification, disconformity exists between the complete and provisional specifications. And, it being admitted that these additional locking means form the subject of an application for a patent by the opponent during the interval between the leaving of a provisional specification and the leaving of a complete specification by the applicant, it follows that the second ground of opposition succeeds."

In our opinion the decision of the Commissioner was right for the reasons given by him, and the appeal should be dismissed.

ISAACS AND RICH JJ. In our opinion this appeal should be dismissed.

The appellant's provisional specification disclosed not a master invention but an improvement invention. Meccano, or the elements of constructional toys, was well known. The improvement, the nature of which was described in the provisional specification, was in its essence the elimination of bolts and nuts as separate elements connecting the structural elements. Structural elements were so fashioned that the end could enter into other structural elements so as to act also as a bolt, rigidity being given by means of a key. The key really acted as the nut would act in the case of a bolt. It may be that other forms of keys might without disconformity be substituted for the key mentioned in the provisional specification. But to add, as has been done in the complete specification, a separate connecting element acting only as such, is in substance reversion to the system of bolts which the provisional specification set out to discard. This, we think, is disconformity, and is another invention, and, by admission, another invention applied for in the statutory period by the respondent.

The Commissioner's decision should be upheld.

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Starke J.

STARKE J. Day applied for a patent for improvements in toys and elements for the construction thereof. Perrott opposed this application on the ground that the completed specification described and claimed an invention other than that described in the provisional specification and that such other invention formed the subject of an application made by Perrott in the interval between the leaving by Day of his provisional specification and his complete specification (*Patents Act*, sec. 56). It is not in contest that the latter part of this allegation is established if Day's complete specification is not in conformity with his provisional specification. This question of conformity is therefore all that the Court is called upon to determine on this appeal. Lack of such conformity is an objection open on an application for a patent, but the Act (sec. 65) precludes the objection once letters patent are granted.

Now, the provisional specification must fairly describe the nature of the invention (*Patents Act*, sec. 35). It may do so roughly, and without entering into all the minute details of the manner in which the invention is to be carried out (*In re Newall and Elliot* (1); *Pneumatic Tyre Co.* v. *East London Rubber Co.* (2)). On the other hand, the inventor may give such minute details of his invention as to tie his hands afterwards, and "exclude an area which might otherwise be within more general phraseology" (*Pneumatic Tyre Co.* v. *Ixion Patent Pneumatic Tyre Co.* (3)).

What, then, is the nature of Day's invention as described in his provisional specification? The title describes it as improvements in toys and elements for construction thereof. And one of its objects was to provide a variety of simple elements which enabled the making and the construction of a great multiplicity of structures, reasonably rigid and durable, of an interesting nature, and which might have working parts. Rails, strips, planes, wheels, pulleys, cranks, levers, keys, springs, and other mechanical devices are mentioned as instances of these elements.

Now, to combine or connect such elements together, it was necessary to make holes or slots in the pieces, in order to facilitate their interlocking. And this, substantially, could be accomplished

(1) (1858) 4 C.B. (N.S.) 269.
(2) (1896-97) 14 R.P.C. 77, 573.
(3) (1897) 14 R.P.C., at p. 869.

by the use of nuts and bolts. There would be nothing novel in all this, for the well-known "Meccano" toy sets are constructed on the same principle. But the applicant specifically stated that he desired to avoid the use of nuts and bolts, wholly or largely, thereby saving expense and also time in connecting together the elements. He therefore suggested that elements be adopted having, in addition to holes or slots, narrowed or shouldered extensions or ends, with niches in them adapted to receive members to be connected therewith, and that these elements be locked by means of a key or wedge fitting into the niches. A form of key suggested had prongs which could "enter and tightly fill the niches in the elements."

The novelty of the invention is not in question in this application. The real substance of the so-called invention, as set forth by the applicant, consisted in locking elements together by means of a key or wedge instead of by means of nuts and bolts. The passages to which I have referred describe how the elements can be locked by means of keys and wedges, but they do not, to my mind, limit or confine the applicant's discovery to this method or make it the substance and essence of the invention. Now, in his complete specification the applicant adheres to the substantive basis of his invention, namely, locking elements by means of keys and wedges instead of by means of nuts and bolts. He retains the strips with shouldered ends and niches but he also further describes and claims a method of locking whereby he dispenses with shouldered ends and niches in his strips, and substitutes strips with holes or slots, but without niches in them, which he can lock with a tapered, instead of a pronged, key or wedge fitting into the niches. But it is well settled that an inventor is permitted, until the time of filing his complete specification, "to perfect any details, to modify, supplement, and develop his invention," so long as he keeps within the ambit of the invention disclosed in his provisional specification (*Woodward* v. *Sansum & Co.* (1)). And to my mind the applicant has done no more in the present case: indeed the modification strikes me as nothing more than the substitution of obvious and equivalent means for accomplishing the same object, namely, locking together the elements.

(1) (1887) 4 R.P.C., at pp. 176-178.

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In my opinion, therefore, the appeal ought to be allowed.

Appeal dismissed with costs.

Solicitors for the appellant, *A. Robinson & Co.*

Solicitor for the respondent, *M. F. Bourke.*

B. L.

[HIGH COURT OF AUSTRALIA.]

CARR . . . . . APPELLANT;

AND

THE PRESIDENT, COUNCILLORS AND RATEPAYERS OF THE SHIRE OF WODONGA . . . . . RESPONDENT.

ON APPEAL FROM THE SUPREME COURT OF VICTORIA.

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MELBOURNE, *May* 7, 8, 29.

KNOX C.J., ISAACS, RICH and STARKE JJ.

Arbitration—Question of law arising in course of reference—Jurisdiction of Supreme Court to direct arbitrators to state special case—Question of law specifically submitted to arbitrators—Discretion—Arbitration Act 1915 (*Vict.*) (*No.* 2614), *sec.* 19.

Section 19 of the *Arbitration Act* 1915 (Vict.) provides that "any referee arbitrator or umpire may at any stage of the proceedings under a reference and shall if so directed by the Court or a Judge state in the form of a special case for the opinion of the Court any question of law arising in the course of the reference."

Held, that under the section the Court or a Judge has jurisdiction to direct arbitrators to state in the form of a special case for the opinion of the Court a question of law specifically submitted to them.

Held, also, that, in the circumstances of the particular case, it was a proper exercise of discretion to make such an order.