[HIGH COURT OF AUSTRALIA.]

HENRY BERRY AND COMPANY PROPRIETARY LIMITED . . . . . APPELLANT;
OPPONENT,

AND

POTTER AND ANOTHER . . . . . RESPONDENTS.
APPLICANTS,

H. C. OF A. 1924.

MELBOURNE, *Oct.* 1, 2; *Nov.* 6.

Isaacs A.C.J., Gavan Duffy and Starke JJ.

Patent—Application—Opposition—Novelty—Subject matter—Invention or ingenuity—Patents Act 1903-1921 (*No.* 21 *of* 1903—*No.* 24 *of* 1921), *secs.* 56, 59.

The respondents applied for a patent for improvements relating to the seasoning of sausage-meat and butchers' small-goods. The improvements consisted in incorporating into the material composing sausage-meat or small-goods the emulsified essential oils of the herbs and spices with which it was desired to flavour them, instead of mixing in the dried herbs or spices themselves, which had always been the method adopted. The appellant opposed the application on the ground of want of novelty.

Held, by *Isaacs* A.C.J. and *Gavan Duffy* J. (*Starke* J. dissenting), that, on the evidence, the process was not a mere use of known devices without any inventive exertion of the mind; and, therefore, that a patent ought to be granted.

APPEAL from the Commissioner of Patents.

An application was made by Allen Percy Potter and Harry Woolf Shmith for a patent for "Improvements relating to the seasoning of sausage-meat and like butchers' small-goods."

In the complete specification the invention was (so far as is material) described as follows:—

"This invention relates to the seasoning of sausages, sausage-meat, and other butchers' small-goods or minced meat products of a like

nature, which have hitherto been seasoned or flavoured with dried herbs, spices and peppers. An objection to such existing methods of seasoning goods of the nature indicated is that the seasoning agent cannot be thoroughly or uniformly disseminated throughout the minced or chopped material, so that parts of the latter may be excessively seasoned whilst other parts contain insufficient of the seasoning medium. A further objection to the existing method of seasoning such materials is the presence therein of unsightly and undesirable specks, stalks, plant fibre and the like from the dried herbs, spices and/or peppers employed. In addition, the full flavouring value of the herbs, spices and peppers is not obtained owing to the drying treatment to which they are subjected and the fact that the dried material is frequently kept for long periods before use. The primary object of the present invention is to provide an improved method of incorporating a seasoning medium into sausage-meat and like material by combining therewith a liquid flavouring or seasoning agent consisting of an emulsified essential oil or oils from the desired herbs, spices and/or peppers, in lieu of the present method of seasoning with the dried flavouring substances as above mentioned. By thus emulsifying the essential oil or oils of the desired flavour or flavours, such oil is rendered miscible with water so that it will readily and intimately combine with the minced meat or like material and become thoroughly disseminated and permeated throughout the mass thereof.

"It is well known that essential oils have hitherto been employed for flavouring beverages, pastry and the like, also for medicinal and other purposes, such oils being treated or "broken down" with alcohol spirit to form an essence of the desired flavour and strength. Such essences would, however, be unsuitable for the purpose of the present invention owing chiefly to their excessive cost and volatility, the latter property causing the flavouring essence to quickly lose its strength. Furthermore, such essences would not as readily and effectively mix with the water content of the minced or chopped meat substance as the emulsified essential oil seasoning in accordance with the invention, and, so far as we are aware, it is entirely new to employ an emulsified essential oil or oils for this purpose.

"The invention thus not only ensures the distinct advantage of

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complete and uniform dissemination and permeation of the flavouring or seasoning agent throughout the product but also entirely eliminates specks, fibres, dust and the like, which are inseparable from the present method of seasoning with the dried flavouring substances. Furthermore, the emulsified essential oil or oils of the herbs, spices and/or peppers possess a distinct hygienic value which is not obtained from the dried seasoning substances. The wholesomeness of the product is thus increased and the maximum flavouring value of the herbs, spices and peppers is obtained."

The claims made in the specification were as follows:—"(1) An improved method of incorporating a seasoning medium into sausage-meat and like butchers' small-goods which consists in combining therewith an essential oil or oils possessing the necessary flavour or flavourings and which has or have been rendered miscible in water by emulsification for the purpose set forth. (2) An improved method of incorporating a seasoning medium in sausage-meat and like butchers' small-goods which consists in mixing with the requisite quantity of water an emulsified essential oil or oils having the necessary flavour or flavourings and subsequently combining such mixture with the minced or chopped meat substance whereby the liquid seasoning medium permeates throughout the mass substantially as described. (3) A liquid seasoning agent for sausage-meat and like butchers' small-goods consisting of an essential oil or oils of herbs, spices and/or peppers having the required flavour or flavourings and rendered miscible in water by emulsification. (4) Improvements in the seasoning of sausage-meat and like butchers' small-goods substantially as herein described and for the purpose set forth."

The application was opposed by Henry Berry & Co. Pty. Ltd. on the grounds that (1) the alleged invention was not novel and had been already in the possession of the public with the consent or allowance of the inventors, and (2) the alleged invention had been described in a book or other printed publication published in the Commonwealth before the date of the application or was otherwise in the possession of the public.

The Commissioner of Patents dismissed the opposition and decided to allow the grant of a patent.

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

During the argument the third claim in the specification was abandoned.

Latham K.C. (with him *Sproule*), for the appellant. The alleged invention is no more than putting flavouring into sausages, and the respondents are not entitled to a patent for it. [Counsel was stopped.]

Robert Menzies (with him *Dean*), for the respondents. The applicants, having a problem before them which had until then been unsolved, solved it by applying to a new purpose essential oils, which were known, prepared in a way which was known. It required the exercise of ingenuity to apply the new process to flavouring sausages. The new process is commercially useful. The onus is on the opponent to show that the process is not novel and that no invention is involved (*McGlashan* v. *Rabett* (1); *Stamp* v. *W. J. Powell Pty. Ltd.* (2)). A new idea involving invention and a means of carrying the idea into practice is good subject matter for a patent (*Muntz* v. *Foster* (3); *Crane* v. *Price* (4)). The application should be allowed if there is any possibility of their being merit in the invention (*Moore & Hesketh* v. *Phillips* (5)).

[ISAACS J. referred to *Lyon* v. *Goddard* (6).]

Latham K.C. "Tabasco," which is an emulsified essential oil of pepper, is a well-known material for flavouring meat, cooked or uncooked, and its use for flavouring sausages would be an infringement of a patent if granted in this case. All that the appellant has done is to conceive the idea of mixing a known liquid flavouring material with sausages. That does not involve any inventive skill, and is not subject matter for a patent (*Gum* v. *Stevens* (7); *Aeolian Co.* v. *Stoddard* (8); *In re Mertens' Patent* (9); *Blakey & Co.* v. *Latham & Co.* (10); *Lane-Fox* v. *Kensington and Knightsbridge Electric Lighting Co.* (11); *Bamlett* v. *Picksley* (12); *Murray* v. *Clayton* (13);

(1) (1909) 9 C.L.R. 223.
(2) (1918) 24 C.L.R. 339.
(3) (1844) 2 Web. Pat. Cas. 96.
(4) (1842) 1 Web. Pat. Cas. 393, at p. 409.
(5) (1907) 4 C.L.R. 1411, at p. 1425.
(6) (1893) 10 R.P.C. 334, at p. 343.
(7) (1923) 33 C.L.R. 267.
(8) (1915) 19 C.L.R. 452, at pp. 454, 456.
(9) (1914) 31 R.P.C. 373, at p. 383.
(10) (1888-89) 6 R.P.C. 184, at pp. 187, 189.
(11) (1892) 9 R.P.C. 413, at p. 416.
(12) (1875) Griff. Pat. Cas. 40.
(13) (1872) L.R. 7 Ch. 570, at p. 584.

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Frost on Patents, 4th ed., vol. I., p. 60). If the objection fails, the order should be in the form in *May* v. *Higgins* (1).

[ISAACS J. referred to *Lyon* v. *Goddard* (2); *Re A.F.'s Application* (3); *Vickers, Sons & Co.* v. *Siddell* (4).]

Dean, in reply, referred to *Lancashire Explosives Co.* v. *Roburite Explosives Co.* (5); *Hickton's Patent Syndicate* v. *Patents and Machine Improvements Co.* (6).

Cur. adv. vult.

NOV. 6. The following written judgments were delivered:—

ISAACS A.C.J. AND GAVAN DUFFY J. This matter comes before us under secs. 58 and 59 of the *Patents Act* 1903-1909. The respondents are applicants for a patent, the appellant gave notice of opposition under sec. 56; and, on hearing the case under sec. 57, the Commissioner dismissed the opposition and decided to allow the grant of the patent. The appellant having appealed, we have to determine, in the words of sec. 59, "whether the grant ought or ought not to be made."

The patent applied for is for "Improvements relating to the seasoning of sausage-meat and like butchers' small-goods." From time whereof the memory of man runneth not to the contrary sausages have been a common article of manufacture, and, indeed, part of the daily food of the civilized world. The word "sausage," itself allied to the word "sauce," indicates that the article, which is minced meat, is highly seasoned. It needs no prompting to satisfy the judgment that all methods of seasoning that would suggest themselves to skilful manufacturers of that commodity would have long since been adopted. Nevertheless, according to the specification of the applicants and the evidence that so far has been placed before the Court, the methods adopted prior to what is claimed as the applicants' invention were confined to the primitive system of introducing dried herbs, spices and peppers. This system was attended with certain drawbacks, including the

(1) (1916) 21 C.L.R. 119.
(2) (1893) 10 R.P.C. 334, at p. 343.
(3) (1913) 31 R.P.C. 58.
(4) (1890) 7 R.P.C. 292, at p. 304.
(5) (1895) 12 R.P.C. 470.
(6) (1909) 26 R.P.C. 339.

following: first, a want of complete and uniform dissemination of the seasoning medium throughout the food material; next, the presence of specks, stalks and plant fibre, from the dry seasoning substances used; third, the loss of seasoning flavour through the drying and keeping of the seasoning substances; and, lastly, the unsightliness they gave, and the unwholesomeness they produced in the finished product after a little time. The applicants' method for which they claim a patent consists in incorporating into the food material a liquid flavouring material being an emulsified essential oil or oils from whatever herbs or condiments are desired. The effect is, it is claimed, to overcome the disadvantages of the usual method that have been mentioned.

The opposition is on two grounds specified in sec. 56, namely: (1) want of novelty, under par. (*e*); (2) prior publication, under par. (*f*).

It is undoubted that essential oils have been long used for flavouring beverages, pastry, confectionery and medicines. But, either from their volatile nature or their inability while unemulsified to mix so readily and effectively with the food substance of minced meat preparations, they are not so suitable as the emulsified oils. There is no question whatever that, except for the use of a sauce called "Tabasco" and described in *Webster's Dictionary* as "a pungent condiment sauce made of cayenne peppers," there has been no suggestion that the method described by the applicant was ever applied to the manufacture or use of the articles mentioned. But reliance is placed on a statement on the package that it "is proportionately more valuable when cooked into food and its flavour diffused thoroughly through it." It is difficult to see that the use of a sauce limited to the act of "cooking" minced meat as an already completed article of manufacture has a decisive bearing on the prior manufacture of minced meat into that completed commercial article destined in the future for cooking.

The opponent contends that, since essential oils were well known in the manufacture of some articles of food, their use, even when emulsified for the purpose mentioned, is not "novel" because it is the mere application of a well-known product to an analogous use. It is compared with (say) the well-known illustration of the

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use of a spoon for eating peas and applying it to eating beans, or the invention of a telescope for looking over the land and applying it to looking over the sea. If the matter were similarly comparable the opposition would succeed. If, notwithstanding the natural and constant desire for serving the human palate, the countless generations of men failed to observe and apply what the opponent declares to be an obvious and almost obtrusive expedient, Carlyle's celebrated aphorism erred only in moderation. The illustrations mentioned are always used as showing what every man in his senses would inevitably do if the occasion arose. Here the occasion has arisen not once or twice, and yet only now and by the applicants has the expedient been suggested. Then, with what result? According to the evidence before us, uncontradicted and unchallenged, at least 200 butchers and small-goods manufacturers have already taken to using the applicants' method, and in practically every instance they have discontinued the old method. There is no evidence to the contrary as to the origination of the method by the respondents or the useful and advantageous result of its application. There is conflicting evidence by experts as to how far the old use of essential oils would suggest the use as now claimed.

In our opinion, when the nature of the present proceedings is considered, the respondents should succeed, without anything amounting to a final pronouncement by the Court as to the eventual validity of the patent. The opposition under sec. 56 is a proceeding intended only to intercept a patent which would be clearly invalid on one of the grounds specified in the section (*McGlashan* v. *Rabett* (1) and *Stamp* v. *W. J. Powell Pty. Ltd.* (2)). It has some resemblance in principle to the summary proceedings under Order XIV. of the *Supreme Court Rules*. The issue for the Court—as for the Commissioner—is whether for the reasons specified the matter is so plain that the application ought to be at once ended and not left to the fuller consideration of more deliberate examination. The law limits, not only the issue and the grounds of objection, but also the persons who are qualified at this stage to object (*R.* v. *Comptroller-General of Patents*; *Ex parte Tomlinson* (3)). A

(1) (1909) 9 C.L.R. 223. (2) (1918) 24 C.L.R. 339.
(3) (1899) 1 Q.B. 909.

member of the public would not have a *locus standi* merely because he was using something which it is said would infringe the patent for which application is made (*In re New Things Ltd.* (1)).

When we pass from this narrow range of summary interpretation to the broader field of novelty, it soon becomes evident that the matter is not one for the application of secs. 58 and 59. It is clear, in the first place, that, unless there is the mere application of an old contrivance to an analogous use and therefore no invention in the relevant sense, the opposition should fail. In the very recent case of *British Thomson-Houston Co.* v. *Corona Lamp Works Ltd.* (2) Lord *Shaw* said:—"The law has not on that subject varied, so far as I know, from what was laid down by Chief Justice *Abbott* in *R.* v. *Wheeler* (3) on the subject matter of a patent. 'It may perhaps extend also to a new process to be carried on by known implements or elements acting upon known substances and ultimately producing some other known substance but producing it in a better or more expeditious manner or of a better or more useful kind.' To this I may add the observation of Chief Justice *Tindal* in *Crane* v. *Price* (4): 'There are numerous instances of patents which have been granted where the invention consisted in no more than the use of *things* already known, the acting with them in a *manner* already known, the producing effects already known but producing these *effects* so as to be more economically or beneficially employed by the public.' These are the things that it is still legitimate to look at and that go deeply into the question of patentable subject matter; efficiency production in a better or more expeditious manner or of a better or more useful kind; effects more economically achieved or more beneficial to the public." To the same effect see also the *British Vacuum Cleaner Co.* v. *London and South-Western Railway Co.* (5). As one working test of invention reference may be made to *Penn* v. *Bibby* (6), approved by Lord *Shaw* in the case last mentioned. The passage is: "In every case of this description one main consideration seems to be, whether the new application lies so much out of the track of the former use as not naturally to

(1) (1913) 31 R.P.C. 45, at p. 46, per Sir *Stanley Buckmaster* S.-G.
(2) (1922) 39 R.P.C. 49, at p. 87.
(3) (1819) 2 B. & Ald. 345, at p. 350.
(4) (1842) 4 Man. & G. 580, at p. 603.
(5) (1911-12) 29 R.P.C. 309, at p. 329.
(6) (1866) L.R. 2 Ch. 127, at p. 136

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suggest itself to a person turning his mind to the subject, but to require some application of thought and study." This is a question of fact; and, having regard to the whole of the circumstances mentioned, the utter absence of such an application to this commodity, although all the integers of the method had long separately existed, the subsequent demand for the product so manufactured (see per Lord *Herschell* in *Thomson* v. *American Braided Wire Co.* (1)), the unquestionable utility and benefit of the result, are sufficient, at all events, to stamp the matter as not clearly a mere workshop improvement—a mere use of known devices without any inventive exertion of the mind.

For these reasons we are of opinion that the appeal should be dismissed and the patent ought to be granted.

STARKE J. Potter and Shmith applied for letters patent for an invention entitled "Improvements relating to the seasoning of sausage-meat and like butchers' small-goods." This application was granted by the Commissioner of Patents, and from his decision an appeal has been brought to this Court. Sausages, as is well known, are ordinarily seasoned with dried herbs, spices and peppers. The applicants conceived the idea of a liquid seasoning, and claim the introduction into sausages and small-goods of a seasoning medium "which consists in combining therewith an essential oil or oils possessing the necessary flavour or flavourings and which has or have been rendered miscible in water by emulsification." Essential oils possess the characteristic flavour of the plants or vegetable substances from which they are obtained. They have been extensively used for flavouring purposes, as with perfumery, liqueurs, aerated beverages and other drinks, and with confectionery and many dietetic articles. (See *Encyclopædia Britannica* (1911), vol. xx., p. 52.) Further, it was well known that the essential oils were miscible in water by emulsification. Indeed, a sauce known as "Tabasco," which is an emulsion of the essential oils of cayenne pepper, has been used for some time as a relish or seasoning for table and kitchen purposes.

It is not surprising that an objection was taken to the grant of a

(1) (1889) 6 R.P.C. 518, at pp. 527-528.

patent on the ground that the invention claimed is not novel (*Patents Act*, sec. 56 ; see *Gum* v. *Stevens* (1) ; *Wilson* v. *Wilson Bros. Bobbin Co.* (2) ; *Re Max Müller's Patent* (3)). The law is clear enough. It is well settled that " any real invention, though a slight one, producing a practical beneficial result " has sufficient novelty to support the grant of a patent. The invention may no doubt " lie in an idea," if a method of carrying out the idea is disclosed, although no invention is involved in such method itself. Again, the Court should not refuse to allow the grant of a patent unless it is quite clear that it cannot stand upon the ground of want of novelty, for the grant of a patent is no decision that the patent will be valid when granted (*McGlashan* v. *Rabett* (4) ; *Stamp* v. *W. J. Powell Pty. Ltd.* (5)). But, as *Lindley* L.J. said in *Blakey & Co.* v. *Latham & Co.* (6), " if a patent is to be held good for any departure, however slight, from that which was known before, just consider what it means. It would put a stop to all improvements. That is a very serious matter. There must be a *quid pro quo*. A patent means that nobody except the patentee can do what he patents. . . . That is a very serious matter to the public, and one of extreme inconvenience. Now, in consideration of a patent, a patentee must give the public something. What is it that this patentee has given them ? " He has simply suggested that essential oils, which are perfectly well known as flavouring substances, and extensively used for that purpose, should be used for the purpose of flavouring or seasoning sausages in place of the dry herbs, spices and peppers which are commonly used. You cannot have a patent for the application of a well-known article or process or method to a use merely analogous to that to which it has already been applied unless there be some ingenuity or invention in the adaptation or mode of application (*Harwood* v. *Great Northern Railway Co.* (7) ; *Elias* v. *Grovesend Tinplate Co.* (8) ; *Wallace and Williamson on Patents*, p. 143). Still less, in my opinion, can you have a patent, as in this case, for a method of flavouring a particular substance when that

(1) (1923) 33 C.L.R. 267.
(2) (1911) 28 R.P.C. 733, at p. 737, per *Fletcher Moulton* L.J., *in arguendo*.
(3) (1907) 24 R.P.C. 465, at p. 479.
(4) (1909) 9 C.L.R., at p. 228.
(5) (1918) 24 C.L.R. 339.
(6) (1888-89) 6 R.P.C., at pp. 188-189.
(7) (1865) 11 H.L.C. 654.
(8) (1890) 7 R.P.C. 455, at p. 468.

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method is well known and extensively used in connection with other substances, unless there be some ingenuity or invention in the adaptation or mode of application. The patentee has simply used with sausages, flavouring oils which others have used for flavouring purposes with perfumery, beverages, confectionery and other articles. I deplore the legal ingenuity which enables the applicants to obtain the grant of a patent for their method of seasoning sausages, but there is, in my opinion, no other ingenuity, or invention, or novelty, in the case. "My opinion," to use the words of *Lindley* L.J. in *Blakey's Case* (1), "is that this is a very rubbishy patent, and mischievous, and" the Court "ought" to have said so.

Appeal dismissed.

Solicitors for the appellant, *W. B. & O. McCutcheon.*
Solicitors for the respondents, *Moule, Hamilton & Kiddle.*

B. L.

(1) (1888-89) 6 R.P.C., at p. 189.