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[HIGH COURT OF AUSTRALIA.]

WALKER AND ANOTHER . . . APPELLANTS ;
DEFENDANTS,

AND

ALEMITE CORPORATION . . . RESPONDENT.
PLAINTIFF,

ON APPEAL FROM THE SUPREME COURT OF
VICTORIA.

Patent—Infringement—Lubricating apparatus—Grease-cup—Closure member held by spring between closure member and pin extending through walls of hollow member and beyond—Claim for particular construction—Claim for combination—Manufacture and sale of part of combination.

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MELBOURNE,

May 30;
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Rich, Starke,
Dixon, Evatt
and McTiernan
JJ.

The specification of an invention relating to lubricating apparatus claimed a patent with respect to a device consisting in part of a cup or equivalent receptacle for containing grease or the like having a hollow member with one end flanged inwardly to provide a seat for a closure member which is normally held seated by a spring or the like confined between the closure member and a pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom. The appellants adopted a device for a similar purpose, but substituted for the pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom, a collar round the hollow member with pins or lugs projecting outwardly therefrom (and not through its walls) so as to form a bayonet coupling, the spring being confined between the ball constituting the closure member and the walls and the end of the cylinder or hollow member.

Held that the device adopted by the appellants was not a mere mechanical equivalent of the respondent's patent or a colourable imitation of the patented article, and that the respondent's patent was not infringed.

Held, also, that a patent for a combination of various parts is not infringed by the manufacture or sale of the separate parts.

Decision of the Supreme Court of Victoria (McArthur J.): *Alemite Corporation v. Walker*, (1933) V.L.R. 154, reversed.

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The Alemite Corporation, being incorporated under the laws of the State of Delaware in the United States of America and being the owner of letters patent in respect of improvements in certain lubricating apparatus under the *Patents Acts* of the Commonwealth, brought an action against Henry Montague Walker and Daisy Jeannette Walker, who carried on business under the name of the Rox Manufacturing Company, alleging that the defendants had infringed the plaintiff's patent rights, and claiming an injunction and damages in respect of the alleged infringement. The plaintiff's particulars alleged that the defendants manufactured and sold in the State of Victoria grease-cups or nipples which were manufactured in infringement of claiming clauses 1, 4-11 and 13 (which are set out hereunder) in the complete specification of the plaintiff's letters patent.

The defendants alleged that the claiming clauses of the specification should be read, in view of the prior art, as claiming merely the particular construction described, illustrated and claimed therein and should not be so construed as to render the defendant's grease-cups or nipples an infringement thereof; and, alternatively, that the plaintiff's letters patent were invalid on the ground that the invention was not novel, but had been previously used and published in Australia. The prior publication alleged was of letters patent granted in the United States of America to one Putnam and to one Brown, and, in England, to one Alley and to one Seng. They also alleged that the invention was not a proper subject matter for a grant of letters patent, having regard to the common general knowledge at the date thereof, and alleged that the invention claimed merely the use of a well known attachment device in accordance with its normal and well known purpose for connecting together two well known things, namely, a grease-cup or nipple and a grease-gun, and alleged that the claims of the specification did not sufficiently define the monopoly which the plaintiff intended to claim, inasmuch as they did not clearly indicate that anything beyond the precise construction described and illustrated was claimed.

The plaintiff's invention, as described in the specification, related to lubricating apparatus, and was particularly concerned with the provision of means for supplying lubricating grease to bearings which were more or less inaccessible. One object of the invention was to provide a novel grease-pump which co-operated with a grease-cup of novel construction to fill entirely the grease-cup without wasting any of the lubricating grease. Further objects of the invention were: To provide novel coupling means for connecting the grease-pump with the parts to be lubricated, the coupling means being so constructed that when the coupling members were uncoupled or disconnected from each other there would be no excess lubricant on the outer ends of the coupling members; to provide novel means for effectively sealing the joint between the coupling members so that the lubricant might be forced between the parts to be lubricated under a very heavy pressure; and to provide novel means to assist in attaching and detaching a tubular coupling member to a part to be lubricated.

The specification stated that the improved grease-cup or the like comprised a hollow member having one end flanged inwardly to provide a seat for the closure member which was normally held seated by a spring or the like confined between the closure member and a pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom. In its application to a grease-cup or the like, the latter, as well as the pump, had means for coacting with the couplings interchangeably to connect either end of the conduit with the pump and cup respectively so that it was possible to gain access to grease-cups in comparatively inaccessible places. The improved lubricating apparatus also comprised two members adapted to be detachably connected, the arrangement being such that the connection was sealed by a device positioned between such members and held against one of them by the pressure of the lubricant.

The claims set forth in the specification were :—

1. A cup or equivalent receptacle for containing grease or the like, comprising a hollow member having one end flanged inwardly to provide a seat for a closure member which is normally held seated by a spring or the like confined between the closure member and a

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pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom.

2. A grease-pump comprising a discharge opening and a discharge conduit provided at one end with a straight coupling and at the other end with a substantially L-shaped coupling or bend, such couplings and pump being provided with coacting means for connecting either of the couplings with the pump.

3. A grease-pump according to claim 2, adapted to co-operate with a grease-cup or the like, such as set forth in claim 1, which, with the grease-pump, has means for coacting with such couplings interchangeably to connect either end of the conduit, which is flexible, with the pump and cup respectively.

4. Lubricating apparatus, comprising two members adapted to be detachably connected, such connection being sealed by a device positioned between such members and held against one of them by lubricant pressure.

5. Lubricating apparatus according to claim 4, wherein excess lubricant is removed from the ends of the members when the latter are disconnected, this being preferably effected by creating a slight suction during this disconnecting operation which causes any lubricant which might otherwise remain on the outer end of one member to be sucked off by the sealing device in the other member.

6. Lubricating apparatus according to claim 4, wherein the sealing device is initially held against the said members by a yielding force, such as from a spring.

7. Lubricating apparatus according to claim 4, 5 or 6, wherein the sealing device comprises a flexible member, such as a gasket or the like, formed with an aperture for the passage of the lubricant and having one face subjected to the pressure of the lubricant.

8. Apparatus according to claim 4, wherein one of the coupling members contains the sealing device and is connected by a flexible conduit with a pump which delivers the lubricant to such member under pressure, and the other member is connected with the apparatus to be lubricated.

9. Apparatus according to claim 8, wherein the first-mentioned member is formed with a bayonet slot adapted to be engaged by

an element on the other member for connecting the same, the transverse portion of the slot being inclined from the inner end of the longitudinal portion thereof toward the outer end of the coupling member.

10. Apparatus according to claim 7, wherein the sealing device is mounted to reciprocate in a bore of the member containing the same, and has its movement toward the other member limited, such as by abutting against a shoulder formed by an enlargement of the said bore.

11. Lubricating apparatus according to claim 4, wherein one of the coupling members is constituted by a grease-cup comprising a tubular member having a closure member normally held against a seat by a spring interposed between the closure member and a pin extending through and projecting from both sides of the tubular member, such pin coacting with means on the discharge end of a conduit from a grease-pump for detachably securing such end with the grease-cup, such discharge end preferably consisting of the coupling member containing the aforesaid sealing device and associated parts.

12. Apparatus according to claim 8, wherein the last-mentioned coupling member is connected with the apparatus to be lubricated by means of a conduit and is located in an accessible position such as on the dash or foot board of an automobile.

13. Lubricating apparatus having its parts constructed and adapted to operate substantially as herein described with reference to accompanying drawings.

The defendants in the present case substituted, for a pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom, a collar round the hollow member with pins or lugs projecting outwardly therefrom (and not through its walls) so as to form a bayonet coupling, the spring being confined between the ball constituting the closure member and the walls and the end of the cylinder or hollow member.

The action was tried by *McArthur J.* who granted an injunction and ordered an inquiry as to damages.

From this decision the defendants now appealed to the High Court.

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Dean, for the appellants. The claim was for a cup containing the features set out and nothing else. The inventor claimed only a field consisting of a nipple and a pin going through the wall, and claimed no other form of nipple. This was not a mere colourable imitation (*Dudgeon v. Thomson* (1)). The question is whether the essential features were taken, for without that no infringement arises (*Drew, Robinson & Co. v. Shearer* (2)); and, if a material part is omitted, it is no longer the same combination (*Consolidated Car Heating Co. v. Came* (3)). There can be no colourable imitation unless substantial identity exists (*Frost, Patent Law and Practice*, 4th ed. (1912), vol. I., p. 339; *Edmunds on Patents*, 2nd ed. (1897), p. 340). Should the claim be read widely, as being for any method of lugs with a nipple, sealed by a ball and spring, there could be no subject matter and no novelty, as the use of the seal and the bayonet catch were old, and a combination of old elements is not patentable unless there is something new in addition (*Williams v. Nye* (4); *Moore and Hesketh v. Phillips* (5); *Wood v. Raphael* (6)). Mere intention to infringe, without actual infringement, is not sufficient (*Terrell on Patents*, 7th ed. (1927), p. 142).

Wilbur Ham K.C. (with him *Barry*), for the respondent. The nipple is a combination of several elements, each of which may be found in other connections, and the claim is not only to a nipple used in the way described but to one which is capable of functioning in more than one way, the patentee specifying that which is, in his opinion, the best way, that is, with a pin going completely through. There was not sufficient disclosed in the specifications to enable a man of science to make a nipple like the respondent's without the exercise of further inventiveness (*Pope Alliance Corporation v. Spanish River Pulp and Paper Mills* (7)). The use by an infringer of inferior and more expensive forms to attain the end achieved by the patent is a matter of significance (*Fletcher Moulton on Patents* (1913), p. 140). A mere colourable variation of one of the parts may amount to infringement, as may the use of one only of the

(1) (1877) 3 App. Cas. 34, at p. 44.

(2) (1914) 18 C.L.R. 209.

(3) (1903) 20 R.P.C. 745, at p. 765.

(4) (1890) 7 R.P.C. 62.

(5) (1907) 4 C.L.R. 1411.

(6) (1896) 13 R.P.C. 730.

(7) (1929) A.C. 269, at p. 276.

parts of the combination (*Lake and Elliott v. Rotax Motor Accessories Ltd.* (1)). The nipple is protected as an essential part of the coupling, so far as it is new. This is the only coupling which saves the waste of grease under high pressure. It is an infringement to use a new part of a combination, though the patent does not cover the part which was old (*Dunlop Pneumatic Tyre Co. v. David Moseley & Sons Ltd.* (2) ; *Newton v. Grand Junction Railway Co.* (3) ; *Sellers v. Dickinson* (4)). [He also referred to *Akeroyd v. Strange* (5) ; *Chapman and Cook and Electro Linx Ltd. v. Deltavis Ltd.* (6).]

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Dean, in reply. The patentee has the onus of establishing infringement, and in case of doubt the specification should be construed most strongly against the patentee. The claiming clause operates as a disclaimer of that which is not claimed (*Fellows v. Thomas William Lench Ltd.* (7)). The respondent cannot have protection for the nipple as distinct from the gun and coupling, because he has not made that claim (*Clark v. Adie* (8)). Had the patentee intended to claim a principle or an idea he should have stated it (*Ridd Milking Machine Co. v. Simplex Milking Machine Co.* (9)). [He also referred to *Wilfley Ore Concentrator Syndicate Ltd. v. Guthridge* (10) (as to whether the specifications in the earlier cases disclosed sufficient to enable the apparatus to be made), and *Henry v. A. B. Dick Co.* (11) (as to what constituted contributory infringement).]

Cur. adv. vult.

RICH J. I regret that I feel constrained to the view that the defendant has succeeded in constructing a lubricating appliance which does not infringe the plaintiff's monopoly although it contains many points of resemblance to one of the components of the plaintiff's implement. The problem in cases of this kind is clearly stated by *Astbury J.* during the argument in *Rondo Co. v. Gramophone Co.* (12) :—" A patent can be either for improving something or for

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(1) (1911) 28 R.P.C. 32.

(2) (1904) 1 Ch. 164.

(3) (1850) 5 Ex. 331.

(4) (1850) 5 Ex. 312.

(5) (1332) 50 R.P.C. 23.

(6) (1930) 47 R.P.C. 163.

(7) (1916) 34 R.P.C. 45.

(8) (1877) 2 App. Cas. 315, at p. 320.

(9) (1916) 2 A.C. 550, at p. 552.

(10) (1906) 4 C.L.R. 202.

(11) (1912) 224 U.S. 1.

(12) (1929) 46 R.P.C. 378, at p. 386.

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producing a new thing for the first time. There is always a wide distinction in cases where the inventive step is an improvement of detail, as distinct from a novelty per se. Where the details constitute the invention, if one does not take the details one does not take the invention. That is the *Curtis v. Platt* (1) case. In the other case the details are only incidental, they are of little importance, excepting that there must be a way shown of doing the particular thing claimed." The question entirely depends upon the claiming clauses in the plaintiff's specification. I find it impossible to construe the first claim, which seeks independent protection for the cup or nipple, in the manner contended for by the respondent. The pin which confines the spring and extends through the walls and projects outwardly therefrom appears to me an essential part of the combination. The appellant's article cannot be regarded as a mere mechanical equivalent or colourable imitation because, however unimportant the variations may be from the point of view of function, the inventor in his specification has chosen to make the mode of construction an essential ground of his monopoly. The attempt to support the judgment appealed from by reference to the claims for the entire lubricating appliance cannot, in my opinion, succeed in face of the authorities which establish that the sale of a component part of a combination claim for an entire machine is not an infringement of a combination (*Dunlop Pneumatic Tyre Co. v. David Moseley & Sons Ltd.* (2)). I find it unnecessary to enter into more detail in view of the treatment which the matter has received in the judgments of other members of the Court.

The appeal should be allowed.

STARKE J. This is an appeal from a judgment of the Supreme Court of Victoria restraining the appellants from infringing the respondent's letters patent for improvements in lubricating apparatus. "The apparatus is designed," as the learned trial Judge said, "for the purpose of lubricating various parts of motor cars and other vehicles, particularly such bearings and other parts as are not easily accessible. It consists of three main parts—a grease-gun, a flexible tube and a grease-cup or 'nipple.' The grease is placed in the

1) (1876) 3 Ch. D. 135 (n).

(2) (1904) 1 Ch. 612; 21 R.P.C. 53, 274.

grease-gun, the flexible tube is connected at one end by a bayonet coupling to the grease-gun and at the other end by a bayonet coupling to the grease-cup or nipple" (1). The infringement alleged is that the appellant manufactured and sold or offered for sale grease-cups or nipples, not the whole of the lubricating apparatus, claimed by the respondent.

The specification must be construed with reference to the state of knowledge at the time it was published. This is perhaps best stated in the evidence of Mr. W. E. Bassett, a distinguished engineer, upon whose evidence the learned Judge relied:—

"Q. You have told us of course that you are familiar with the various features of the Alemite design of nipple gun and cup. A. Yes.

"Q. Taking these elements in turn you agree I think at once that the idea of the ball and spring method of sealing the entrance conduit for a lubricating bearing is a very old and well known thing? A. Yes.

"Q. I mean old prior to the conduit of the Alemite specification. A. I should think so—yes.

"Q. And you will agree I suppose that the method of fastening two articles together by a bayonet coupling is equally old? A. Yes.

"Q. And would you say it was old prior to the Alemite specification? A. That is so.

"Q. And that particular method of fastening of course has a great many exemplifications of its use? A. Yes.

"Q. And flexible couplings of course are a very old practice are they not? A. Qualified, yes, for low pressure. . . .

"Q. I suppose you agree also that the use of washers, cup washers, was old in 1919? A. Yes.

"Q. And the function of a cup washer in old practice was to seal a joint between two ends that were coupled together? A. I do not know of any cup washer being used to seal a joint. Cup washers for sealing pumps have been known for a great number of years."

The respondent, it is clear, has not put forward any new principle or idea, nor claimed a mode of carrying a principle into effect. Modestly enough, the specification describes the invention as improvements in lubricating apparatus. "The improved grease-cup or the

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like,” according to the specification, “ comprises a hollow member having one end flanged inwardly to provide a seat for the closure member which is normally held seated by a spring or the like confined between the closure member and a pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom. In its application to a grease-cup or the like, the latter, as well as the pump, has means for coacting with the couplings interchangeably to connect either end of the conduit with the pump and cup respectively so that it is possible to gain access to grease-cups in comparatively inaccessible places.” Again, “ the novel grease-cup comprises a tubular member . . . having the screw threads . . . at one end thereof for securing it to a bearing, and the other end thereof being flanged inwardly . . . for the purpose of providing a seat for the ball closure. . . . This closure is urged against its seat by means of a compression spring . . . which is confined between the pin . . . and the closure. . . . The central portion of my grease-cup is hexagonal in cross-section, . . . thereby providing means for receiving the jaws of a wrench to screw the cup into place.” The drawings show that the pin extends from and through the walls of the tubular member. The specification states that the description therein contained is a “ preferred embodiment of the invention.” The pin holds the spring in position against the ball, and its projection beyond the walls of the tubular member forms part of the bayonet coupling. The engineers called for the respondent, Mr. Bassett and Mr. Draffin, both speak of the pin as being mechanically an important feature of the invention. Thus Mr. Bassett deposes :—

“ Q. It would take some ingenuity to put that pin through the nipple and using the pin to retain the spring against the ball ? A. Yes.

“ Q. That pin would be an important feature, would it, of the Alemite nipple ? A. Not necessarily, no.

“ Q. You regard the pin’s going through the nipple, going through the wall to retain the spring as being unimportant ? A. I think it is the best solution of the problem of the manufacture of that bayonet nipple for that work.

“ Q. Then it is important ? A. Yes.

"Q. You agree with Mr. Draffin that it is an important feature of the invention? A. Yes."

The first claim is "a cup or equivalent receptacle for containing grease or the like, comprising a hollow member having one end flanged inwardly to provide a seat for the closure member which is normally held seated by a spring or the like confined between the closure member and a pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom." The object of the claim is to delimit the invention, to define what is the new thing that is claimed. Anything that is not claimed is disclaimed. What then is the essence or substance of the invention the subject of claim 1? It is the precise combination and arrangement of the grease-cup specified in the claim. A pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom is as essential a feature of the cup as are the hollow member and the closure member or ball held seated by a spring. It is not, however, the law that a person can "escape on the ground of non-infringement simply because he has departed in some particular from the combination which has been chosen by the" inventor. "But of course there must be a limit, and the limit . . . must be ascertained by considering really what it is that the inventor claims as the subject of his patent" (*Bunge v. Higginbottom & Co.* (1)). In the present case, the inventor has tied himself to a form of grease-cup in which the closure member is held seated by a spring retained by a pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom.

Unless this construction of the specification is right, then, in my opinion, Alley's specification anticipates the claim. Alley describes a lubricator of the cylindrical type, having a non-return ball valve pressed by a spring against a seat piece secured at the top of the lubricator, and the spring is confined between the ball and the walls and end of the cylinder. The means of securing the pump upon the lubricator is a screw thread, but Alley points out that this method may be modified, and instead of a coarse pitch screw a bayonet or like catch may be used. The appellant in the present

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case has substituted for a pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom, a collar passing round the hollow member (and not through its walls) with pins or lugs projecting outwardly therefrom so as to form a bayonet coupling. The spring is confined between the ball and the walls and end of the cylinder or hollow member.

Consequently in my opinion the appellant's invention is not an infringement of the first claim, but, if it were held to be an infringement of this claim, then, for the reasons already given, the claim is too wide and cannot be supported.

But the respondent also relies upon the infringement of other claims in its patent, claims 4, 5, 6, 7, 8, 9, 10, 11, and 13. These claims are for combinations as a whole, and it is clear that the appellant has not taken any of the combinations so claimed. It was argued that these claims are for coacting devices, each of which is new ; that the manufacture of any of the devices is the manufacture of a material part of the invention claimed ; and that the restraint of such manufacture does not deprive the public of anything it had before. One answer, if I am right in my construction of the specification, is that the appellant has not taken, in the grease-cup, any coacting device claimed by the respondent. Another is that when a patent is for a combination of various parts, the manufacture of the single parts is no infringement. Such a manufacture is in itself lawful, and knowledge, even on the part of the manufacturer, that the single parts will be used for the purposes of infringement is not enough to render him liable as an infringer (*Townsend v. Haworth* (1) ; *Sykes v. Howarth* (2) ; *McCormick v. Gray* (3) ; *Dunlop Pneumatic Tyre Co. v. David Moseley & Sons Ltd.* (4)).

The appeal should therefore be upheld and the action dismissed.

DIXON J. In my opinion the grease-cup or nipple made by the appellants avoids infringement of the respondent's patent.

The lubricating implement or device, for which the patent was obtained, contained several parts. The parts are composed of subsidiary devices or expedients, none of which were new. The

(1) (1875) 12 Ch. D. 831 (n). (3) (1861) 7 H. & N. 25 ; 158 E.R. 377.
(2) (1879) 12 Ch. D. 826. (4) (1904) 1 Ch. 612 ; 21 R.P.C. 274.

merit of the invention lies in judiciously applying means already known in the construction of the several parts and in so combining them as to produce an efficient and convenient implement. A grease-cup or nipple is an essential part. Into or through it the lubricant is injected. It is screwed into the orifice of the duct or channel leading to the bearing that requires lubricating and remains in that position. Grease is fed into it under pressure by a grease-gun, the nozzle of which is at the end of a flexible tube. The nozzle consists of a bayonet socket containing a washer or seal. The nipple is provided with projections to engage with and hold the bayonet socket, and, by this means, a junction which will not leak is formed between the grease-cup or nipple and the grease-gun when in use. When out of use the grease-cup is closed by a valve consisting of a ball or the like. A ball within the grease-cup is pressed against the opening by a spring, which yields, when the grease-gun is applied, to the pressure of the lubricant issuing from it. The description which the specification gives of this part of the contrivance calls it an improved grease-cup or the like, and says that it comprises a hollow member having one end flanged inwardly to provide a seat for the closure member which is normally held seated by a spring or the like confined between the closure member and a pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom. The purposes of the pin are, according to the evidence, three in number. Its protruding ends serve to engage in the bayonet coupling of the socket. Within the grease-cup, it serves as a seat for the spring which presses the ball to the opening. Its protruding ends also serve to engage a key by which the grease-cup may be screwed into the duct leading to the bearing. The use of a ball, pressed by a spring within, against the mouth of the lubricating conduit to close it as an access for dirt or as an escape for grease was old and well known. A bayonet coupling consisting of projecting pins and bayonet slots as a fastening was in common use in all sorts of appliances. It does not appear, however, that a pin had previously been used for the double purpose of providing the projections and forming a seat for a spring.

In the first claim, the patentee seeks protection for the grease-cup or nipple independently of the lubricating appliance considered as

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a combination. The specification claims "a cup or equivalent receptacle for containing grease or the like, comprising a hollow member having one end flanged inwardly to provide a seat for a closure member which is normally held seated by a spring or the like confined between the closure member and a pin extending from and through a wall or the walls of the hollow member and projecting outwardly therefrom."

The appellant's grease-cup is designed so as to fit the bayonet socket of the nozzle at the end of the flexible tube of the grease-gun. But the lugs or pins which enter the slots are not formed of a pin "extending from and through a wall or the walls of the hollow member." They are projections from a collar sunken in and fastened round the grease-cup. The ball or "closure member" is not at the end of the cup. The orifice of the cup leads into an antechamber and the valve is in the middle of the cup. Necessarily, the aperture against which it is pressed is not the flanged end but an annular shoulder within the cup. The spring which holds the ball or "closure member" against it is seated on a small loose cone which is based upon or rests against a similar annular shoulder at the other end of the cup.

McArthur J., who tried the action, found that these differences in design were variations deliberately made by the appellant in the hope or expectation of avoiding infringement of the respondent's patent. He considered that, at best, the variations amounted to no more than the adoption of mechanical equivalents and that, in any case, the appellants' cup was a colourable imitation of the patented article. He accordingly held that the first claim had been infringed. I am unable to agree in this conclusion, because I think an essential feature of the claim is the use of the pin to confine the spring and to extend through the walls and project outwardly therefrom. "A claiming clause operates as a disclaimer of what is not specifically claimed, and for such disclaimer there may be reasons known to the inventor but not to the Court" (per Lord *Parker, Fellows v. Thomas William Lench Ltd.* (1)). It cannot be known, at any rate with certainty, why the draughtsman of the specification

should restrict the monopoly he claimed by so definitely including in his description the manner in which the spring is confined between the closure member and the pin extending through and projecting outwardly from the walls. But in such a claim in respect of the nipple as a separate member of the whole combination, common knowledge, and even prior publication, may well have suggested the unwisdom of widening the claim so that it would not depend upon this feature, a feature to which originality might more plausibly be ascribed. The thing claimed is not the mechanical embodiment of a new principle. It is not a particular application of some inventive idea which may be applied to produce the same new result in other ways. It describes and claims an appliance of definite construction exhibiting specified features in combination. The claim to protection *ex facie* appears to be based upon the association of these features so as to produce the useful result. The question is not whether the differences of construction in the respondent's nipple and in that of the appellant are material to the utility of the appliance or to the manner of performing its function or whether ingenuity is involved in the changes. The question is: How wide is the monopoly? Once it is determined that the discarded features are essential to the claim, the substitution of other means of performing the like function cannot amount to infringement by colourable variation, or by the use of a mere mechanical equivalent. The changes are not insubstantial variations in detail under colour of which the thing claimed is taken. They are not other mechanical embodiments of the inventive idea for which protection has been obtained. The claim itself makes them cardinal. The intention of the appellant to take advantage of the narrowness of the monopoly is, of course, immaterial.

The respondent, however, relied upon the remaining claims of the specification which relate to the appliance considered as a whole, and contended that the manufacture and sale of the grease-cup or nipple involved the appellant in liability for infringing these claims because the grease-cup would or must inevitably be used with the other parts of the respondent's invention. The general proposition under our law was not denied that "where the

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patent is for a combination there is no infringement in making or selling the separate elements of the combination, even though the manufacturer or vendor knows perfectly well that the separate elements are destined eventually to be combined so as to constitute an infringement" (*Terrell on Patents*, 7th ed. (1927), p. 161). But it was said it did not extend beyond cases where the separate elements had an independent use, and, at any rate, was not true of cases where the separate element is itself new and has no use except as part of the patented appliance. The appellant does not admit that the nipple is new or that it has no use except as part of an infringing appliance. But, in any event, it is settled law that the exclusive property in a combination invention is not infringed upon by the sale of the components (*Townsend v. Haworth* (1)); that selling articles to persons to be used for the purpose of infringing a patent is not an infringement of the patent (per *Fry J., Sykes v. Howarth* (2)); and that sale with a knowledge that the purchaser will use the articles for infringement is not itself an infringement although the vendor gives the purchaser an indemnity: the vendor must have made himself a party to the act of infringement (per *Mellish L.J., Townsend v. Haworth* (3); *Dunlop Pneumatic Tyre Co. v. David Moseley & Sons Ltd.* (4)). Further, in the opinion of *Vaughan Williams L.J.*, it is not enough that the article sold has no other use than a use in the course of what amounts to infringement (5). The basis upon which these rules rest is that whatever is not included in the monopoly granted is *publici juris* and may be freely used as of common right. Narrow as this view of what constitutes participation in infringement may appear, it requires us, in my opinion, to hold that the claims 4 to 11 of the specification were not infringed.

In my opinion the appeal should be allowed.

EVATT J. In this case I concur in the judgment of my brother *Starke*.

(1) (1875) 12 Ch. D. 831 (n).

(2) (1879). 12 Ch. D., at p. 833.

(3) (1875) 48 L.J. Ch., at p. 773 (n).

(4) (1904) 1 Ch., at pp. 616, 620.

(5) (1904) 1 Ch., at pp. 616, 618, 619.

McTIERNAN J. I have read the judgment of my brother *Dixon* and agree with it. H. C. OF A.
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Appeal allowed with costs. Order of the Supreme Court discharged and in lieu thereof order that the action be dismissed with costs.

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Solicitor for the appellants, *D. S. Abraham.*

Solicitor for the respondent, *A. C. Cray.*

H. D. W.