

H. C. OF A. recent Tasmanian Act is to confine it to “ criminal issues ” joined
1936. after the Act was passed. On that view the majority rule was
NEWELL inapplicable to the present issue.
v. THE KING. The appeal should be allowed.

Appeal allowed.

Solicitors for the appellant, *Shields, Heritage & Stackhouse*.
Solicitor for the respondent, *A. Banks-Smith*, Crown Solicitor for
Tasmania, by *F. G. Menzies*, Crown Solicitor for Victoria.

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[HIGH COURT OF AUSTRALIA.]

GOLDMAN APPELLANT ;

AND

BRAMLEY RESPONDENT.

H. C. OF A. Patent—Provisional specification—Amendment—Validity—Duty of commissioner—
1936. Patents Act 1903-1930 (No. 21 of 1903—No. 76 of 1930), sec. 42.

MELBOURNE,
June 4.
SYDNEY,
Aug. 13.
Starke, Dixon
and Evatt JJ.

The Commissioner of Patents communicated to an applicant for letters patent the contents of an examiner’s report to the effect that the provisional specification did not state the title of the invention and did not sufficiently describe the invention, and stated that “ if desired ” argument in rebuttal of the examiner’s objection or amendment with a view to the removal of the objection might be submitted. The applicant submitted another document as an amended specification, and the amendments were allowed.

Held that sec. 42 of the *Patents Act* 1903-1930 had been complied with. The section did not require that the precise amendments be directed or that a time be fixed within which amendment should be made.

APPEAL from the Deputy Commissioner of Patents.

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Edward Bramley applied for a grant of letters patent for an invention for "an improved automatic safety device for motion picture projectors." The application was dated 17th August 1932 and was accompanied by a provisional specification of the same date, which was referred to an examiner. The examiner reported that the provisional specification did not conform to the requirements of sec. 39 of the *Patents Act* 1903-1930. The Commissioner of Patents informed Bramley of this fact, and Bramley lodged an amended provisional specification dated 16th January 1933. On 14th July 1933 the examiner reported that the amended provisional specification removed the objections formerly taken. On 17th August 1933 Bramley lodged the complete specification. On 21st November 1933 Mark Goldman gave notice of opposition to the grant of a patent to Bramley, on the grounds that the complete specification described an invention other than that described in the provisional specification, and that such other invention formed the subject of an application made by Goldman in the interval between the leaving of the provisional specification and the leaving of the complete specification. The Deputy Commissioner of Patents dismissed the opposition and granted letters patent to Bramley.

From this decision Goldman appealed to the High Court.

Further facts appear in the judgments hereunder.

Dean, for the appellant. The amended provisional specification was irregular. There was no power to amend the original provisional specification without an order from the commissioner. The amended provisional specification is in fact a complete rewriting of the original provisional specification. If the respondent's amended specification has gone beyond the original specification, it is no bar to the appellant's application, as his specification was lodged after the original and before the amended specification of the appellant. There is no power to regard the amended specification (*Patents Act* 1903-1930, secs. 33, 35, 36, 39, 42, 43). The document which must be looked at is the document which accompanies the application. The only power given to amend a provisional specification is sec. 42, and that does not refer to a voluntary amendment, but refers only

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to one directed by the commissioner. Therefore, there was no power for the respondent to amend. His proper remedy was to make a new application. The history of the Act shows that this is so (*Patent Law Amendment Act 1852* (15 & 16 Vict. c. 83)). The English legislation does not allow voluntary amendment of provisional specifications. In the absence of a direction to amend by the commissioner there is no power to amend provisional specifications. The limited power to amend provisional specifications was recognized in *In re Dart's Patent* (1) and *Re Brackett and McLay* (2) (See *Terrell on Patents*, 8th ed. (1934), pp. 216, 219 ; *Fletcher Moulton on Patents* (1913), p. 279). Even if there is some power to make a voluntary amendment, this amendment goes beyond such power. This was a substitution of one document for another and was not merely an amendment. There was a clear departure in the amendment from the provisional specification. There was disconformity between the original provisional specification and the complete specification (*Terrell on Patents*, 8th ed. (1934), p. 118 ; *Pneumatic Tyre Co. Ltd. v. Ixion Patent Pneumatic Tyre Co. Ltd.* (3) ; *Tate v. Haskins* (4) ; *Dunlop v. Cooper* (5) ; *Bailey v. Robertson* (6) ; *Nuttall v. Hargreaves* (7)).

O'Bryan, for the Deputy Commissioner of Patents. The usual practice of the Patents Office was followed in this case. Sec. 32 (1) provides for an application being made ; sec. 33 (1) provides that the application is to be accompanied by a provisional or a complete specification ; and sec. 35 provides that the specification must describe the subject matter of the invention. Those provisions were followed and the examiner reported on the specification. The examiner reported adversely and the matter went to the commissioner. Then sec. 42 applied. The invariable practice is that if the commissioner agrees with the adverse report he notifies the applicant for the patent. There is a particular form of letter, and the sending of a letter in that form is the practice in the Australian Patents Office and also in England and in America. If the applicant

(1) (1885) *Griffin's Patent Cases* 308.

(2) (1930) 47 R.P.C. 335.

(3) (1897) 14 R.P.C. 853, at p. 869.

(4) (1935) 53 C.L.R. 594.

(5) (1908) 7 C.L.R. 146, at pp. 155, 156.

(6) (1878) 3 App. Cas. 1055, at pp. 1073-1075.

(7) (1892) 1 Ch. 23, at pp. 31, 32.

submits an amended specification, that is regarded as an amendment by direction. The commissioner allowed the amendment and accepted the specification. If the commissioner's view is incorrect very much inconvenience will ensue. Sec. 42 does not contemplate that the commissioner shall specifically point out matters required to be amended. It is sufficient to point out generally that the specification requires amendment (*In re C.'s Application for a Patent* (1)).

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Herring K.C. (with him *Adam*), for the respondent. The proper method of dealing with the matter was that adopted by the commissioner. He had already determined that the later document referred to the same application as that described in the original provisional specification. The complete specification must first be looked at and then you may look back at the original document (*Siddell v. Vickers* (2); *Woodward v. Sansum & Co.* (3); *Edison and Swan United Electric Light Co. v. Woodhouse and Rawson* (4); *Crompton v. Patents Investment Co. Ltd.* (5); *Gadd and Mason v. Mayor, &c., of Manchester* (6); *In re Newall and Elliott* (7); *Pneumatic Tyre Co. Ltd. v. Leicester Pneumatic Tyre and Automatic Valve Co.* (8)). *Crompton v. Patents Investment Co. Ltd.* (5) deals with the duty of the patentee to give the benefit of what he has discovered to the public. The invention described in the original provisional specification was the substantial invention and that document does describe the invention described in the complete specification. There is no disconformity between these two documents on a proper construction of them.

Dean, in reply. The commissioner has not in this case given any directions to be performed within a specified time as required by sec. 42, which requires some particularity. The later document is one lodged voluntarily and is not one lodged in consequence of a direction by him, and is one constituting substantially a new specification.

(1) (1890) 7 R.P.C. 250, at p. 251.

(2) (1888) 39 Ch. D. 92, at pp. 96, 103, 104.

(3) (1887) 4 R.P.C. 166, at p. 178.

(4) (1887) 4 R.P.C. 99, at pp. 103, 104.

(5) (1888) 5 R.P.C. 382, at p. 397.

(6) (1892) 9 R.P.C. 516, at p. 527.

(7) (1858) 4 C.B. N.S. 269 : 140 E.R. 1087.

(8) (1899) 16 R.P.C. 531, at p. 541.

H. C. OF A. The original provisional specification is much narrower than the
1936. complete specification.

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Cur. adv. vult.

Aug. 13.

The following written judgments were delivered :—

STARKE J. This is an appeal from a decision of the Deputy Commissioner of Patents dismissing the appellant's opposition to the grant of letters patent to the respondent, and granting the respondent letters patent for "an improved automatic safety device for motion picture projectors." The ground of appeal is that the complete specification describes or claims an invention other than that described in the provisional specification. The respondent's application for a patent was lodged on 17th August 1932, and was accompanied by a provisional specification, which was referred to an examiner, who reported that the title of the invention had not been stated and that the invention had not been described as prescribed by the Act, and he detailed various defects in these respects. In September 1932 the Commissioner of Patents advised the applicant of the report, and added: "In consequence of the examiner's adverse report, I hereby give you notice that in accordance with the provisions of the *Patents Act* 1903-1930 and the *Patents Regulations* 1912, I may have to exercise my discretion adversely to the applicant. If desired, argument in rebuttal of the examiner's objection, or amendment with a view to the removal thereof, may be submitted in writing if the applicant is not desirous of being heard personally or by his patent attorney on his behalf." The result of this notice was that an amended provisional specification was lodged on 16th January 1933, and referred to the examiner, who reported, on 14th July 1933, that the proposed amendments removed the objections formerly taken and that no objection now obtained. On 18th July 1933, the Deputy Commissioner of Patents indorsed the examiner's report: "Amendments allowed." The Chief Clerk, on 17th July 1933, further indorsed the report:—"Allowed amendments to be made in documents. Inform, and proceed under Regulation 13." And on 25th July 1933, the further indorsement was made: "Amendments made." Actually, as I gather, another

document was substituted for the original provisional specification (*Patents Regulations*, clause 93).

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It is not contended that there is any disconformity between the amended provisional specification and the complete specification that was subsequently lodged. But it is contended that there is disconformity between the provisional specification originally lodged and the complete specification, and that the so-called amended provisional specification was lodged without any lawful authority, and is null and void as a specification for the purposes of the *Patents Act*.

Complete specifications may be amended in the manner allowed by secs. 71-83 of the Act, but the only provision for the amendment of a provisional specification is contained in sec. 42: "If the examiner reports adversely to the application or specification on any matter referred to in sections thirty-nine and forty, the commissioner may—(a) require compliance by the applicant within a specified time with such directions for the amendment of the application or the specification as the commissioner sees fit to give; or (b) direct that the application instead of dating from the time when it was lodged shall date from such later specified date not being later than the date of compliance with the directions for amendment." It was conceded in this case that the report of the examiner was adverse to the application and provisional specification and related to matters referred to in secs. 39 and 40. But it is insisted that sec. 42 confers no right upon an applicant himself to amend a provisional specification. The commissioner, it is conceded, may require an amendment, and he may refuse to accept the application and specification unless the applicant complies with his requirements or directions (sec. 46). So far the argument accords with the provisions of sec. 42. It is then said, however, that the commissioner in the present case did not require any amendment but rather suggested that the applicant should, of his own accord, amend the specification, a procedure unwarranted by sec. 42. But I think the real meaning of the commissioner's communication to the applicant was that he must amend unless he could satisfy the commissioner that the examiner's objections were untenable. It is not at all necessary, and would be quite impracticable, for the

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commissioner to direct the precise amendments that should be made. It is enough that he should state generally the nature and character of the amendment required, and this he did in the present case by communicating the examiner's report to the applicant. The applicant did not canvass the examiner's objection, but amended his provisional specification in accordance with what was regarded in substance as a direction from the commissioner. It is the function of the commissioner, and not the function of this court, to consider whether the amendments put forward by the applicant were within the ambit of the invention disclosed in the provisional specification, whether they complied with his requirements, and whether the application should, pursuant to the provisions of sec. 42 (b), be dated from a later date than the day of its lodgment.

A further argument must be referred to. The commissioner may require compliance with his direction for amendment within a specified time, and in this case no time was in fact specified. Doubtless an application or specification could not be refused unless the commissioner required compliance with his directions for amendment within a specified time. But an applicant may be willing to amend without any time being specified, or there may be reasons of convenience which make the immediate fixing of a time unnecessary, and even undesirable. There is nothing in the Act which expressly requires that the direction to amend should be given, and the time for compliance therewith fixed, contemporaneously. And in the absence of such a requirement, I see no reason for so limiting the power of the commissioner in administering the provisions of sec. 42. It is not, I conclude, essential to the validity of a direction to amend that the time for compliance therewith should be stated and fixed in or at the same time as the direction to amend is given.

The result is that the appeal fails, and should be dismissed.

DIXON J. This is an appeal from the decision of the Deputy Commissioner of Patents dismissing an opposition to an application for letters patent and directing a grant.

The grounds of opposition included disconformity; the opponent alleged that the complete specification claimed an invention other

than that described in the provisional and that such other invention formed the subject of an application made by him in the interval between the lodging of the provisional and the complete specification. The disconformity relied upon is between the complete specification and the actual document that accompanied the application when the applicant lodged it. Even if that document be taken to be the provisional specification with which the complete must be compared, the applicant says there is no disconformity; that there is nothing but the legitimate development and application of the invention described in the provisional. But he also says that, by amendment, the document accompanying his application came to be replaced by another document and that the later document constitutes his provisional specification, so that the comparison must be made with it and not with the original document accompanying his application. If this be so, admittedly the ground of disconformity fails. It appears that when the application was referred to an examiner pursuant to sec. 39 of the *Patents Act* 1903-1935 the examiner reported that the title it then bore was irregular, that the drawings were not sufficient, and that the invention had not been described with the aid of drawings in the required manner. The report said: "A provisional specification accompanied by drawings to comply with the requirements of sec. 35 of the Act should be drafted so as to set out:—(1) The aim and object of the invention; (2) A descriptive reference to each figure of the drawings such as " &c.; "(3) A clear and connected description of the nature of the constructional characteristics of the invention."

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A letter from the commissioner informed the applicant of the contents of this report. The letter included a printed statement notifying the applicant that, in consequence of the examiner's adverse report, the commissioner might have to exercise his discretion adversely to the applicant. It informed him that, if he desired, "argument in rebuttal of the examiner's objection, or amendment with a view of removal thereof, may be submitted in writing." It went on to tell him that he might be heard personally and might obtain a decision or determination of the commissioner. In a printed note a warning was given that "unless amendment is expressly allowed by the terms of this letter," proposed amendments

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in answer to the examiner's report must be submitted in a particular form and not made until allowed. In consequence of this notice the applicant prepared the document which he says now constitutes his provisional specification and lodged it as an amended specification. The examiner reported that the amended specification overcame the previous objections and the Deputy Commissioner directed that the amendments be allowed.

In support of his appeal to this court, the opponent contends that the purported amendment is a nullity and the earlier document accompanying the application constitutes the provisional specification. The contention does not turn on the fact that the intended amendment was carried out by the substitution of a new document for the original specification. For clause 93 of the *Patents Regulations* 1912-1935 (S.R. 1912 No. 76) provides that when an amendment is allowed a new document may be lodged in substitution for the old if the extent of the amendment warrants it. The objection is that the power conferred on the commissioner by sec. 42 of the Act was not exercised and no other power to amend a provisional specification exists. Sec. 42 is as follows:—"If the examiner reports adversely to the application or specification on any matter referred to in sections thirty-nine and forty, the commissioner may—(a) require compliance by the applicant within a specified time with such directions for the amendment of the application or the specification as the commissioner sees fit to give; or (b) direct that the application instead of dating from the time when it was lodged shall date from such later specified date not being later than the date of compliance with the directions for amendment."

The examiner did report adversely to the application, but, according to the contention, the commissioner did not thereupon proceed under par. a of the section. He did not, it is said, give any directions for the amendment of the provisional specification; he did not specify a time; and he did not require compliance with such directions, if any.

The objection that the amendments were not directed appears to me to be altogether distinct from the objections that no time was named and that compliance was not required. The provision made by par. a of sec. 42 is compendiously expressed. When it is

analyzed, two authorities, not a single authority, are found within its terms. It confers, first, a discretion upon the commissioner to give directions for the amendment of the application or the specification. Secondly, it authorizes him to require compliance with his directions and to fix a time within which it must be done. It appears to me that the power to name a time and require compliance within it is given to the commissioner in order that he may enforce his directions. It is not beyond the commissioner's power to give directions for amendment without at the same time taking the further step of requiring compliance within a specified time. There may be no need to set time running against the applicant. The section does not contemplate amendment at the instance of the applicant. A complete specification may be amended under secs. 71-75 at the applicant's request, but these sections do not apply to a provisional specification. In enabling the commissioner to call for an amendment of a provisional, sec. 42 does not, in my opinion, make the validity of the amendment depend on his exercising the powers it confers to their full extent and requiring compliance within a named time as well as giving the directions for the amendment. The section does contemplate that the amendment shall be the result of the commissioner's demand as opposed to the request of the applicant. But, in my opinion, the commissioner did give directions for the amendment of the provisional specification. The directions were neither final nor detailed, but they were directions for amendment. When his letter to the applicant is considered as a whole, it amounts to an intimation that he must amend in the manner stated in the examiner's report unless he can make out some other answer to the objections it raises. He is informed by the letter that the examiner has recommended a re-drafting of his specification so as to give the object of the invention, to describe its nature and its constructional characteristics and to depict it by proper drawings. He is told, in effect, that he should submit an amended specification as the examiner recommends, unless he wishes to controvert what the report contains, and the amendments submitted will not take effect unless allowed.

I do not think that the conditional or provisional nature of the request for an amendment is fatal. If the applicant does not avail

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himself of the condition and show cause against the report, then to amend becomes his only course. Nor do I think that the amendments required need be stated with any greater precision than appears in the examiner's report set out in the commissioner's letter to the applicant. It was for the commissioner to decide whether the amendments brought in complied with his directions. No doubt, if he allowed amendments which went altogether beyond and outside his directions, his allowance of the amendments might be examined by the court, unless, in spite of its place in the Act, sec. 79 applies. But, in the present case, the document substituted by way of amendment cannot be considered as so outside the scope of the directions to amend as to be incapable of allowance by the commissioner as made pursuant thereto. It follows that, in my opinion, the amendment allowed by the commissioner cannot be treated as a nullity and the substituted document constitutes the provisional specification.

On this footing there can be no disconformity and that ground of opposition fails. No other ground was relied on in support of the appeal to this court.

I think the appeal should be dismissed with costs.

EVATT J. I concur with the judgment of my brother *Dixon*.

Appeal dismissed with costs. Appellant also to pay the costs of the Commissioner of Patents.

Solicitor for the appellant, *Alan H. Robinson*.

Solicitor for the Deputy Commissioner of Patents, *W. H. Sharwood*,
Crown Solicitor for the Commonwealth.

Solicitors for the respondent, *Arthur Robinson & Co.*

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