[HIGH COURT OF AUSTRALIA.]

DABSCHECK . . . . . PETITIONER;

AND

HECLA ELECTRICS PROPRIETARY LIMITED RESPONDENT.

H. C. OF A. 1936.

MELBOURNE, *Sept.* 21-23; *Oct.* 26.

Starke J.

Patent—Specification—Several claims—Invalidity of one claim—Validity of other claims unaffected—Patents Act 1903-1935 (*No.* 21 *of* 1903—*No.* 16 *of* 1935), *sec.* 61.

Sec. 61 of the *Patents Act* 1903-1935, which provides that "where the complete specification contains two or more claims in respect of the invention the invalidity of any one claim shall not affect the validity of any other claim or the validity of the patent so far as it relates to any valid claim," enables the court to revoke letters patent as to claims that are bad, and to allow claims that are good, or are not attacked, to stand.

PETITION to revoke letters patent.

The petitioner, Woolf Dabscheck, sought the revocation of letters patent dated 26th July 1932 granted to the respondent, Hecla Electrics Pty. Ltd., on the grounds (*a*) that the patent was obtained by the respondent in fraud of his rights, and (*b*) that the petitioner was the true inventor.

The facts and arguments sufficiently appear in the judgment hereunder.

Ashkanasy, for the petitioner.

Dean and *O'Bryan*, for the respondent.

Cur. adv. vult.

STARKE J. delivered the following written judgment :—

Petition seeking the revocation of letters patent dated 26th July 1932, No. 8436 of 1932, granted to the respondent, Hecla Electrics Pty. Ltd. The invention relates to improvements in plugs or connecting means for placing electrical appliances into an electric circuit. In the use of these appliances, an escape of the electrical current was not uncommon, and persons using them were subject to electrical shocks, more or less severe. The main purpose of the invention was to protect users of such appliances from injury. The general nature of the invention is stated in the specification : it is an electrical device or plug or connecting means with enclosed contacts connected to the current supply wires and a spring contact secured to a shroud or guard surrounding the current supply terminals in the appliance, connected to contact plates on the plug by means of bolts or screws and to an earthing wire. By these means, any current escaping in the use of the electrical appliance was gathered up and discharged to earth. The petitioner alleges that he was the first and actual inventor of the invention the subject matter of the letters patent granted to the respondent, that the letters patent were obtained in fraud of his rights, and that the invention the subject of the letters patent was not novel and was published before the date of the application for the same.

The petitioner, who is of Russian nationality, was the managing director of a limited company known as Wembley Modes Pty. Ltd. which used electric irons in the course of its business as a manufacturer of mantles, frocks, &c. He took some interest in electrical appliances, and in 1929 and 1930 obtained letters patent for improvements in and relating to them. In the year 1931 he made what he regarded as a great improvement in plugs or connecting means for placing electrical appliances such as electric irons into an electric circuit : an electric iron exhibits a model of this improvement, which, but for some minor details which I shall mention later, has the same elements, and functions in the same manner, as the connecting means in the letters patent granted to the respondent. It is a plug or connecting means with enclosed contacts connecting to the current supply wires, and a spring contact secured to a

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shroud or guard surrounding the current supply terminals in the appliance connected to a contact plate or shield surrounding the plug by screws, and to an earthing wire. About the same time, the petitioner made a plug with a spring contact mounted on the exterior thereof. He applied for letters patent in respect of these devices, and lodged provisional specifications. About July 1931 he submitted the devices to the State Electricity Commission, whose electric inspector advised him in writing as to their suitability for establishing an earth connection. About 1931, he used the plug with the spring contact attached to the shroud or guard in the business of Wembley Modes Pty. Ltd. A presser used the plug in an electric iron for some months in that business openly and without being restricted in any way as to its disclosure. He also, about the year 1931, showed and explained the plug to an engineer in the employ of A. M. Cook & Co. Ltd., which dealt in electrical appliances, and endeavoured to induce that company to take and deal in his device, but without success. He also, about July of 1931, showed and explained his device to the respondent's governing director, who told him it was no good and that he was wasting his time on it.

The petitioner has satisfied me that he publicly used and displayed the device or plug before the date of the letters patent granted to the respondent, and was "the first and actual inventor thereof." But he has also charged the respondent with fraud in obtaining its letters patent. He swears that he showed his device to its governing director—who, however, emphatically denies the statement. The petitioner and the governing director both gave evidence before me, and I had no fault to find with the demeanour of either of them in the witness box. Neither, I am satisfied, was conscious of stating that which he knew was untrue. But I think the governing director was mistaken in denying that he ever saw the petitioner's device before the grant of letters patent to his company. He is, of course, a skilled and experienced man in his business, and I think he regarded the petitioner as out of his depth in connection with electrical appliances, got rid of him as quickly and as politely as he could, and forgot all about both him and his device. Soon afterwards, the respondent's governing director went abroad, and on

his return proceeded to fashion the device which is now the subject of the letters patent in the name of Hecla Electrics Pty. Ltd. It is, I think, possible, perhaps probable—though I am not sure—that the petitioner's device originated in the governing director's mind the device for which letters patent were subsequently obtained by his company, but I am satisfied that he did not consciously revert to the petitioner's device when fashioning his own, and, indeed, that he believes that he never saw it, though in fact he did see it and has forgotten the fact. I have not overlooked his evidence that he would not have forgotten the petitioner's device if he had ever seen it, but that is not an uncommon type of assertion when a man's memory is at fault. An allegation in a petition, however, that a patent was obtained in fraud of the petitioner's rights implies some dishonest action : a mistake honestly made does not establish fraud (See *Re Avery's Patent* (1) ; *In the Matter of Ralston's Patent* (2)). Nevertheless, as I have already indicated, the facts proved in this case establish to my satisfaction that the petitioner was the originator of the plug or connecting device shown in exhibit A and exhibit A1 ; he invented the device and first disclosed it to the public (See *Frost, Patent Law and Practice*, 4th ed. (1912), pp. 15 et seq.). Hecla Electrics Pty. Ltd. and its governing director were not its first and actual inventors.

Claims 1, 3, 4 and 5 admittedly include the device of the petitioner and cannot be supported.

In these circumstances, no question arises as to the locus of the petitioner to present his petition without the authority of the Attorney-General (*Patents Act* 1903-1935, sec. 86 (4) (*d*)).

At common law, the invalidity of any claim would avoid the patent and afford good ground for its revocation (*Morgan* v. *Seaward* (3)). But now sec. 61 of the *Patents Act* 1903-1935 provides : " Where the complete specification contains two or more claims in respect of the invention the invalidity of any one claim shall not affect the validity of any other claim or the validity of the patent so far as it relates to any valid claim."

(1) (1887) 4 R.P.C. 322. (2) (1909) 26 R.P.C. 313, at pp. 318, 319.
(3) (1837) 1 Web. Pat. Cas. 187.

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This provision enables the court, as I have said in the cases of *In re Rainsford's Patent*; *Ex parte J. Fielding & Co. Ltd.** and *Paper Sacks Ltd.* v. *Cowper* (both unreported on this point), to revoke letters patent as to claims that are bad, and to allow claims that are good, or are not attacked, to stand.

The petitioner has not alleged a general want of subject matter in the claims of the respondent, but has confined himself to allegations that he was the first and actual inventor of the invention the subject matter of the letters patent granted to the respondent, that the letters patent were obtained in fraud of his rights, and that the invention the

* In this case His Honour said:— One of the conditions of a grant is that letters patent are void if the invention is not a new invention (See *Patents Act* 1903-1921, First Schedule). And, under English law, if a patent were granted for two or more inventions when one was not new, the patent was void, because the consideration for the grant was the novelty of all, and, the consideration failing, the Crown was deceived in its grant (*Morgan* v. *Seaward*, (1837) 2 M. & W. 544; 1 Web. Pat. Cas. 187). A patent now is granted for one invention only, "but may contain more than one claim, but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention" (*Patents Act*, secs. 33, 65; English *Patents and Designs Act* 1907, sec. 14 (2)). But I apprehend that under the English law if a patentee lays claim to something that is not new, the letters patent are void, because, as before, the consideration for the grant is the novelty of all that is claimed, and, the consideration failing, the Crown is deceived (*Wilson Brothers Bobbin Co. Ltd.* v. *Wilson & Co. (Barnsley) Ltd.*, (1903) 20 R.P.C. 1, at p. 19; *Murchland* v. *Nicholson and Gray*, (1893) 10 R.P.C. 417; *Deeley* v. *Perkes*, (1896) A.C. 496). The Commonwealth *Patents Act*, sec. 61, however, provides: [His Honour read the section, and proceeded:—] The section is placed under Part IV., "Procedure," Division 2, "Opposition," which suggests that the section is confined in operation to the procedural steps leading up to the granting of a patent, and therefore affords no protection in infringement or revocation proceedings. But the final words, "or the validity of the patent so far as it relates to any valid claim," satisfy me that the protection of the section operates after the grant of letters patent, and must, therefore, extend to infringement or revocation proceedings. This final phrase of sec. 61 may be compared with the words occurring in sec. 60, "or affect the validity of the patent when granted." Moreover, "Revocations of Patents" forms Division 7 of Part IV., "Procedure." Can letters patent, then, be revoked, which contain some claims that are invalid, and some that are valid, or are not attacked? "Letters patent" is the name given to the document conferring a monopoly of trade or manufacture upon the subject. The revocation of a patent involves not only the cancellation of this document, but also the annulment of the rights thereby granted (Cf. *Bynner* v. *The Queen*, (1846) 9 Q.B. 523; 115 E.R. 1373; *R.* v. *Eastern Archipelago Co.*, (1854) 4 DeG.M. & G. 199; 43 E.R. 483). The effect of sec. 61 is that the letters patent may be valid as to one or more claims, but invalid as to others. The provision has some analogy in the American law (See *Walker* on *Patents*, 5th ed. (1917), p. 226, par. 177, p. 279, pars. 210 et seq.). The office of a claim is "to define and limit with precision what it is that is claimed to have been invented," and hence the various claims particularize the invention—they form distinct entities of invention. Therefore I see no reason, since the enactment of sec. 61, why a patent should not be revoked as to claims that are bad and allowed to stand as to claims that are good or are not attacked. The letters patent —the document—cannot in such a case be cancelled or destroyed, but various rights and privileges granted thereby may be annulled and vacated by judgment in revocation proceedings.

subject of the letters patent was not novel and was published before the date of the letters patent by reason of the publication of the petitioner's device. The respondent now insists that many of his claims contain combinations that are new, and substantially different and far outside and removed from the petitioner's device. These combinations introduce what I have called minor details into the general nature of the invention. Claim 2 differs from the petitioner's device in that means are claimed in combination with other elements for connecting a coiled guard on the plug to an earthing wire as well as the external contact plate. But that, I think, is covered by the objection that this claim is not novel and was published before the date of the letters patent by reason of the publication of the petitioner's device. It merely adapts the petitioner's device to the coiled guard in a manner analogous to the means used by the petitioner for the same purpose. It is, no doubt, advisable so to connect the guard, but the addition does not constitute a new combination.

Claim 2 therefore falls ; and claims 9, 14 and 15 fall with it.

[His Honour then considered claims 6-19 and concluded :—]

The result is that the letters patent must be revoked as to the invention claimed in clauses 1 to 9 both inclusive, 13 to 17 both inclusive, and 19.

The petitioner made a charge of fraud, and though it has failed, the circumstances are so exceptional that he should have his costs of the petition.

Order that letters patent No. 8436 *of* 1932 *granted to Hecla Electrics Pty. Ltd. be revoked as to claims* 1-9, 13-17 *and* 19.

Solicitors for the petitioner, *Norris & Norris.*

Solicitors for the respondent, *Whiting & Byrne.*

H. D. W.