

[HIGH COURT OF AUSTRALIA.]

THE KING

AGAINST

THE COMMISSIONER OF PATENTS AND OTHERS;

EX PARTE WEISS.

H. C. OF A. *Prohibition—Patent—Opposition—Functions of Commissioner of Patents—Notice of opposition in firm-name—Amendment of notice by substitution of names of partners—“ Person ”—Locus standi of opponent—Sufficiency of interest—Patents Act 1903-1935 (No. 21 of 1903—No. 16 of 1935), secs. 56, 57—Patents Regulations (S.R. 1912 No. 76), reg. 147.*

1939.

MELBOURNE,
March 2, 3, 6.

SYDNEY,
March 30.

Latham C.J.,
Rich, Starke,
Dixon and
Evatt JJ.

The Commissioner of Patents has power to amend a notice of opposition to the grant of a patent which has been given in a firm-name by substituting for the firm-name the names of the individuals constituting the firm. The amendment may be made after the time limited in accordance with sec. 56 of the *Patents Act* 1903-1935 for the giving of notice of opposition, if the notice was originally within the time. A notice given in a firm-name, though irregular, is not a nullity.

The question of the *locus standi* of a person claiming to oppose the grant of a patent is for the Commissioner of Patents to determine in the performance of his duty to “hear and decide the case” under sec. 57 of the *Patents Act* 1903-1935; his determination may be called in question on an appeal from his decision under sec. 57, but, inasmuch as it is within his jurisdiction to determine the matter, proceedings by way of prohibition are not an appropriate method of questioning the determination.

Observations on the question whether prohibition will go to the Commissioner of Patents.

Australian Radio Manufacturers’ Patents Association Ltd. v. Neutrodyne Pty. Ltd., (1937) 57 C.L.R. 27, referred to.

ORDER NISI for prohibition.

On 8th May 1935 the prosecutor, Adolph Weiss of New York, applied for a grant of two patents relating to rotary intaglio printing. The time for giving notice of opposition was extended to four months by the Commissioner of Patents under sec. 56 of the *Patents Act* 1903-1935, and on 1st July 1936, within four months from the advertisement of the acceptance of the complete specifications, a notice of intention to oppose the grants was given in the name of "E. Lufft & Son." Evidence in support of the opposition showed that "E. Lufft & Son" was the name of a firm consisting of Ernst Lufft and Stanley Lufft. Objection was taken by the applicant that the firm was not a person within the meaning of sec. 56 of the *Patents Act* 1903-1935 and that therefore the notice of opposition was bad, and also that in any event the opponents had no *locus standi* to oppose. Thereupon, on 13th November 1937, the opponents applied, pursuant to reg. 147 of the *Patents Regulations* (Statutory Rules 1912 No. 76), for leave to amend the notice of opposition by substituting for the name "E. Lufft & Son" the words "Ernst Lufft and Stanley Lufft, trading together in partnership as E. Lufft and Son." The deputy commissioner appointed a time for a preliminary hearing on the question whether the amendment should be allowed and whether the opponents had *locus standi*. The evidence on this latter question showed that the opponents were the agents in Australia for a New-York manufacturer of rotary intaglio presses, and that they did not themselves purchase any of such machines, but merely acted between the purchaser and the manufacturer on a commission basis. The opponents contended that they had a sufficient interest to enable them to oppose on the ground that, if the patents were granted, it was probable that their business of selling rotary intaglio printing-presses on commission would be prejudiced. The applicant objected that the opponents had no *locus standi*, as they were merely agents for the sale of such presses on commission and had no proprietary interest in the articles sold. On the first question the applicant objected that, as the notice of opposition had not been given by a person within the meaning of sec. 56 of the Act, the notice was bad and the deputy commissioner had no power to amend a non-existent notice of opposition. On 14th September 1938 the deputy commis-

H. C. OF A.

1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

sioner, in a reserved decision, decided that the opponents had sufficient *locus standi* and also that leave to amend the notice of opposition should be given in terms of the application therefor. The result of this decision was that the commissioner would in due course proceed with the hearing of the opposition under sec. 57 of the Act. On 4th November 1938 the applicant obtained from *Rich J.* an order nisi for prohibition returnable before the Full Court and directed to the Commissioner of Patents and Ernst Lufft and Stanley Lufft trading together in partnership as E. Lufft and Son, on the following grounds:—

1. That the notices of opposition given on 1st July 1936 in the name of “E. Lufft and Son” were not notices given by “any person” within the meaning of sec. 56 of the *Patents Act* 1903-1935.

2. That the commissioner had no jurisdiction to substitute for the name “E. Lufft and Son” in the said notices the names “Ernst Lufft and Stanley Lufft trading together in partnership as E. Lufft and Son” at a time beyond a maximum period of four months from the advertisement of the acceptance of the complete specification, namely, 5th March 1936.

3. That the notices of opposition given on 1st July 1936 in the name of “E. Lufft and Son” and/or the said notices as subsequently amended by order of the said commissioner were not notices given by persons who had a sufficient interest in the grant of the patents in question to enable them to oppose the same.

4. That in the absence of a valid notice of opposition given in accordance with sec. 56 of the *Patents Act* 1903-1935 the commissioner has no jurisdiction to proceed and determine the purported opposition by the said Ernst Lufft and Stanley Lufft trading in partnership as E. Lufft and Son.

Sir *Robert Garran* K.C. (with him *Pape*), for the prosecutor. “E. Lufft and Son” is not a person within the meaning of sec. 56 of the Act. The person who may give notice of opposition is any person who has sufficient interest in the subject matter of the patent; neither E. Lufft and Son nor E. and S. Lufft had sufficient interest. The notice of opposition was bad, and the commissioner had no power after the expiration of the time to cure that defect. The

amendment really amounted to allowing new persons to give a new notice, which was out of time. These matters are collateral to the matter which the commissioner has to decide, that is, whether a patent should or should not be granted, and, being collateral, they go to jurisdiction, and prohibition is appropriate. "Person" is defined in the *Acts Interpretation Act* 1901-1937, sec. 22 (a), as including a body politic or corporate as well as an individual. The absence of specific provision in the *Patents Act* makes it clear that partners are not a "person": Cf. *Trade Marks Act* 1905-1936, sec. 4. Rights under the *Patents Act* are personal and individual. A firm cannot apply for a patent, and therefore cannot oppose a grant (*Ex parte Blain* ; *In re Sawers* (1) ; *Sadler v. Whiteman* (2)). Either the amendment effected nothing or it substituted one party for another, and that was done out of time. Up to the amendment there was no valid notice of opposition. The amendment purports to introduce a new opponent. The mere fact that the notice is in the firm-name shows that it is given by what is referred to as a firm. The power to make an amendment cannot be exercised to make a new case so as to revive a statute-barred right (*Marshall v. London Passenger Transport Board* (3) ; *Green v. Kursaal (Southend-on-Sea) Estates Ltd.* (4)). [He referred also to *Walcott v. Lyons* (5) ; *Tetlow v. Orela Ltd.* (6) ; *Re Heath and Frost's Patent* (7) ; *Comptroller's Ruling "C"* (8) ; *Barker v. Palmer* (9)]. As to *locus standi*, a person has sufficient interest to oppose if he has an interest in a prior patent which would be infringed by this patent or if there is a reasonable probability that he himself would be restrained as an infringer from what he is doing. The opponents had not a sufficient interest to oppose the application, that is, they were not persons interested (*Comptroller's Ruling "B"* (10) ; *Comptroller's Ruling "B"* (11) ; *Comptroller's Ruling "C"* (12)). An agent has not a sufficient interest to entitle him to oppose (*Comptroller's Ruling "B"* (13) ; *Re An Application for a Patent by New Things Ltd.* (14) ;

H. C. OF A
1939.
THE KING
v.
COMMISS-
SIONER OF
PATENTS :
EX PARTE
WEISS.

(1) (1879) 12 Ch. D. 522.	(8) (1910) 27 R.P.C. App. ii.
(2) (1910) 1 K.B. 868, at p. 889.	(9) (1881) 8 Q.B.D. 9.
(3) (1936) 3 All E.R. 83.	(10) (1911) 28 R.P.C. App. iii.
(4) (1937) 1 All E.R. 732.	(11) (1912) 29 R.P.C. App. v.
(5) (1885) 29 Ch. D. 584.	(12) (1912) 29 R.P.C. App. vii.
(6) (1920) 2 Ch. 24.	(13) (1913) 30 R.P.C. App. iii.
(7) (1886) Griffin, Patent Cases 288.	(14) (1913) 31 R.P.C. 45.

H. C. OF A.
1939.
THE KING
v.
COMMISSIONER OF
PATENTS :
EX PARTE
WEISS.

Re An application for a Patent by J. L. Wheeler (1). [He also referred to *Australian Radio Manufacturers' Patents Association Ltd. v. Neutrodyne Pty. Ltd.* (2) and *Romer on Patent Practice*, 2nd ed. (1926), at p. 43.] As to whether prohibition will lie.—Secs. 56 and 57 of the Act prescribe the commissioner's jurisdiction. He can decide a case only where a notice under sec. 56 is given, and such notice must be a notice given by a person, by one who is entitled to give notice, and given in the time limited.

Sholl, for the commissioner. The matter was determinable by the commissioner; it was a matter within his jurisdiction to determine; and his jurisdiction is not contingent on the existence, extraneously determinable, of a notice given within the proper time (*Parisienne Basket Shoes Pty. Ltd. v. Whyte* (3)). The notice of opposition given was a sufficient notice under the Act. There is no definition of giving notice in the Act. "E. Lufft and Son" was a sufficient description of opponents without reference to any question of partnership. If the name was intended as a firm-name, it was a sufficient description *per se* of the members of the firm (*Ex parte Harding*; *In re Smith, Fleming & Co.* (4); *R. v. Holden* (5)). Prima facie it is not the description of a nullity nor so intended. It is a sufficient signature or description for ordinary purposes to bind the firm. *W. H. Tuckett & Sons v. Ransom* (6) proceeded on the basis that a firm is a definite entity. A proceeding in a firm-name is at most an irregularity which can be cured (*Richardson, King's Bench Practice* (1792), vol. II., pp. 5, 6; *C. W. Baxter & Co. v. Hill and Christie* (7); *Ex parte Crystall* (8)). *R. v. Harrison* (9) is the only case where the word nullity is used in relation to a firm-name. That was a prosecution, not a civil proceeding. [He referred to *Bishop v. Chung Bros.* (10) and *Anonymous Case* 100 (11).] These cases show a distinction between criminal law and civil procedure. The attitude of criminal law can be explained on the

(1) (1925) 42 R.P.C. 509, at p. 510.

(2) (1937) 57 C.L.R. 27.

(3) (1938) 59 C.L.R. 369, at pp. 374, 375, 384-386, 389-391.

(4) (1879) 12 Ch. D. 557, at p. 567.

(5) (1912) 1 K.B. 483, at p. 487.

(6) (1914) V.L.R. 8.

(7) (1896) 22 V.L.R. 226; 17 A.L.T. 332.

(8) (1899) 20 L.R. (N.S.W.) 267, at p. 270.

(9) (1800) 8 T.R. 508; 101 E.R. 1516.

(10) (1907) 4 C.L.R. 1262.

(11) (1670) 1 Mod. Rep. 45; 86 E.R. 720.

ground that the order of the court was enforced against the person of the defendant by production of the court records alone. In civil courts there was a plea in abatement; and under the present procedure an error in description of parties is a mere irregularity. This applies *a fortiori* to a mere notice, and where the proceedings are not of the nature of a lawsuit (*Patents Act*, sec. 14A). The notice with or without amendment is valid. [He referred to *Norton on Deeds*, 2nd ed. (1928), at p. 195.] There is power to amend the name of opponents. There was a sufficient description of the two opponents without any reference to partnership. The notice is good. In any event, this is not a matter of prohibition. The question of the validity of the notice is within the jurisdiction of the commissioner, as is the question of *locus standi*. It is a matter to be decided by him in the ordinary course of his work (*Ex parte Mullen*; *Re Hood* (1)). It is not a judicial proceeding so as to be subject to prohibition (*R. v. Electricity Commissioners*; *Ex parte London Electricity Joint Committee* (1920) *Ltd.* (2)).

H. C. OF A.
1939.
THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

[LATHAM C.J. The members of the court agree in opinion that the commissioner has jurisdiction to determine the question of *locus standi*. There may be an appeal, but it cannot be said that the determination by him of that question is beyond his jurisdiction.]

Dean, for the other respondents. The only question is whether two persons may oppose. If a firm can enter into a contract, there is no reason why a firm cannot sign a notice of opposition. [He adopted the arguments submitted to the court by counsel for the commissioner.]

Sir *Robert Garran* K.C., in reply. A firm is not in law a person for any purpose whatever. The doctrine of partnership is an extension of the law of agency. If a writ is issued in the name of X & Co., that does not make an individual, Y, a party to the writ. E. Lufft and Son meant the firm of E. Lufft and Son. If it is established that the firm of E. Lufft and Son could not be an applicant for a patent, then the firm could not hold any interest in the patent,

(1) (1935) 35 S.R. (N.S.W.) 289, at p. 302.

(2) (1924) 1 K.B. 171.

H. C. OF A.
1939.
THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

and it is only by holding an interest in a patent that there arises a right to oppose. The *Patents Act* grants monopolies and gives personal rights, and there must be an individual in his personal capacity to make application for a patent (*The Assunta* (1)). The condition of sec. 57 had not operated and therefore the commissioner's decision was made without jurisdiction (*Bunbury v. Fuller* (2)). The question of *locus standi* is appealable to the High Court (*Ex parte Simon* (3)). Prohibition is appropriate; the writ can go against the Attorney-General (*Halsbury's Laws of England*, 2nd ed., vol. 9, p. 833); it will lie to the Commissioner of Patents (*R. v. Local Government Board* (4); *Re Ystradgunlais Tithe Commutation* (5); *R. v. General Commissioners of Taxes for Clerkenwell* (6); *R. v. Electricity Commissioners* (7); *R. v. Legislative Committee of the Church Assembly*; *Ex parte Haynes-Smith* (8)). The commissioner in this case is acting judicially and ministerially (*R. v. Woodhouse* (9)). The commissioner has power to affect rights and is therefore a judicial officer (*R. v. Macfarlane*; *Ex parte O'Flanagan and O'Kelly* (10)).

Sholl, by leave, referred to *Tidd's Practice*, 9th ed. (1828), vol. I., at p. 697; *In re Vagliano Anthracite Collieries Ltd.* (11).

Cur. adv. vult.

March 30.

The following written judgments were delivered:—

LATHAM C.J. This is the return of an order nisi for a writ of prohibition against the Commissioner of Patents to prohibit him from proceeding to hear and determine opposition by “Ernst Lufft and Stanley Lufft trading together in partnership as E. Lufft and Son” to the grant of two patents relating to rotary intaglio printing which were applied for on 8th May 1935 by the prosecutor Adolf Weiss.

On 1st July 1936 “E. Lufft and Son” gave notice of intention to oppose the grants. This notice was given within four

(1) (1902) P. 150, at pp. 154, 155.

(2) (1853) 23 L.J. Ex. 29, at p. 35.

(3) (1888) 4 T.L.R. 754.

(4) (1882) 10 Q.B.D. 309.

(5) (1844) 8 Q.B. 32; 115 E.R. 785.

(6) (1901) 2 K.B. 879.

(7) (1924) 1 K.B. 171.

(8) (1928) 1 K.B. 411, at p. 414.

(9) (1906) 2 K.B. 501, at p. 535.

(10) (1923) 32 C.L.R. 518.

(11) (1910) 79 L.J. Ch. 769.

months from the advertisement of the acceptance of the complete specifications, the time for giving the notice having been extended by the commissioner under sec. 56 of the *Patents Act* 1903-1935. The evidence in support of the opposition showed that "E. Lufft and Son" was the name of a firm consisting of Ernst Lufft and Stanley Lufft. The business of the firm included the representation in Australia of a manufacturer of rotary intaglio printing-presses. The opposing firm claimed that it had sufficient interest to oppose because, if the patents were granted, it was probable that its business of selling printing-presses as agents would be prejudiced.

Objection was taken by the applicant that the firm was not a person within the meaning of sec. 56 of the *Patents Act*. Sec. 56 provides that "any person" may within the time prescribed by the section give notice of opposition to the grant of a patent. Sec. 57 is as follows: "Where such notice is given the commissioner shall give notice of the opposition to the applicant, and shall at the time and in manner prescribed hear and decide the case." Sec. 58 provides that any party aggrieved by the decision of the commissioner may appeal to the High Court or the Supreme Court. Sec. 59 provides that the High Court or the Supreme Court may hear the applicant and any opponent who in its opinion is entitled to be heard in opposition to the grant and may determine whether the grant ought or ought not to be made.

There is no definition of "person" in the *Patents Act*, and the definition in the *Acts Interpretation Act* 1901-1937, sec. 22 (a), includes in the meaning of "person" a body politic or corporate as well as an individual, but not a firm. In contrast the *Trade Marks Act* 1905-1936, sec. 4, provides that "person" includes a firm. The applicant relies upon *Sadler v. Whiteman* (1), where, in a well-known judgment, *Farwell* L.J. said that in English law a firm as such has no existence, the firm-name being "a mere expression, not a legal entity." (See also *Von Hellfeld v. Rechnitzer and Mayer Frères & Co.* (2).)

It was contended that the power of the commissioner to hear and decide the opposition existed only "where such notice is given" (sec. 57) and that, if no "such notice" of opposition had been given

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Latham C.J.

(1) (1910) 1 K.B. 868 at p. 889.

(2) (1914) 1 Ch. 748.

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Latham C.J.

(that is, notice of opposition by a person (sec. 56)), the commissioner had no power to proceed with the hearing and determination of the opposition. Upon the hearing before the commissioner on 13th November 1937 application was made for an amendment of the notice of opposition. The applicant for the patent objected that the commissioner had no power to amend a non-existent notice of opposition and that to allow a so-called amendment would really amount to allowing a notice of opposition to be given at a time long after the expiration of the maximum period of four months for giving such a notice (sec. 56). The commissioner, acting under reg. 147 of the *Patents Regulations* (Statutory Rules 1912, No. 76), amended the notice of opposition on 25th February 1938 so that the notice now purports to be given by "Ernst Lufft and Stanley Lufft trading as E. Lufft and Son." The applicant further objected that the opponents had no *locus standi* inasmuch as they were merely agents for the sale of a commodity (*Re Wheeler's Application* (1); *Comptroller's Ruling "B"* (2)).

The commissioner, however, proposes to proceed with the hearing of the opposition, and the applicant has obtained an order nisi for prohibition upon the grounds to which reference has been made above.

In my opinion the commissioner had jurisdiction to decide the question of *locus standi*. If an objection based on absence of *locus standi* is raised, the commissioner must decide the point as part of his procedure in "hearing and deciding the case" (sec. 57); cf. *Australian Radio Manufacturers' Patents Association Ltd. v. Neutrodyne Pty. Ltd.* (3), where the court entertained an application for a mandamus to the commissioner to hear and determine a question of *locus standi*, though in the result the application was dismissed. I may add with reference to that case that the ground of the decision that no appeal lay from a decision that an opponent to the amendment of a specification had no *locus standi* was that the commissioner had not made an order allowing or disallowing the amendment (See sec. 75) and that therefore there was no appealable order at the stage when all that the commissioner had done was to give a ruling on *locus standi*. I do not regard that case as deciding, in relation

(1) (1925) 42 R.P.C. 509.

(2) (1911) 28 R.P.C. App. iii.

(3) (1937) 57 C.L.R. 27.

to opposition either to amendments or to grants, that no question as to *locus standi* can be raised when an appeal from an appealable order is properly made, though an appeal on such a question alone might not have a great chance of success.

The ground upon which the prosecutor mainly relied was that, as a firm is not a person, no notice of opposition had been given by a person within the meaning of sec. 56 and that therefore the commissioner had no authority to proceed to hear and decide the case or to amend the notice. The question which this objection raises is the perpetually recurring question whether a tribunal which it is sought to prohibit is or is not intended to decide upon a particular matter which is a condition of its power to act. The question is whether or not the opinion of that tribunal is made the test of the existence of the relevant matter (*Colonial Bank of Australasia v. Willan* (1)): See articles by Mr. D. M. Gordon in the *Law Quarterly Review*, vol. 45, p. 459, and vol. 47, p. 386. The distinction is clearly put in *Colonial Bank of Australasia v. Willan* (2). The relevant distinction for the purposes of the case is between "certain proceedings which have been made essential preliminaries to the inquiry" and "facts or a fact to be adjudicated upon in the course of the inquiry." Mr. Gordon points out in the articles mentioned that, when a court is empowered to impose a penalty for an assault, the court has to determine the question whether there has been an assault and that it may determine it rightly or wrongly, but that it is a mistake to say that the actual objective happening of an assault is a condition of the jurisdiction of the court to impose a penalty. Where it is provided, as, for example, in a contract, that upon the happening of a specified event certain rights or obligations shall arise, the question of whether or not the specified event has happened must, in the event of controversy, be determined by a court and not by the opinion of either of the parties, unless that opinion is plainly made the relevant test. But, where a court which or a person who is required to act judicially is authorized to hear and decide a case, the whole matter of "the case" is submitted for the consideration of the court or person.

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Latham C.J.

(1) (1874) L.R. 5 P.C. 417

(2) (1874) L.R. 5 P.C., at p. 443.

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS ;
EX PARTE
WEISS.

Latham C.J.

In the present instance the authority of the commissioner is "to hear and decide the case," that is, the questions arising upon the opposition. The prosecutor contends, however, that, as there can be no opposition except by a person, the commissioner cannot, by deciding that there is opposition when in truth there is no opposition, give himself authority to proceed. The argument can be put shortly by saying that the commissioner can hear and decide a case only when there is a case. There are, in my opinion, two answers to this argument. The first depends upon the general considerations already mentioned. When any tribunal or person is authorized to hear and decide a matter, it is *prima facie* left to that tribunal or person to determine whether those who appear or purport to appear before the tribunal have made out a case. I can see no real distinction between the provisions of sec. 56 and the example relating to an assault which I have above taken from Mr. *Gordon's* articles. When the objection is taken that no notice of opposition has been given, the commissioner decides upon that objection as he decides upon any other question that arises in the opposition. The commissioner may decide this question either rightly or wrongly. He may have decided it wrongly in the present case. If he has decided it wrongly, the aggrieved party has at a later stage an opportunity of appeal under sec. 57, but the decision upon this particular question is as much an exercise of the jurisdiction of the commissioner as any other decision made in the course of dealing with an application for a patent.

The second answer to the argument for the prosecutor is that the proceeding before the commissioner is not merely a proceeding by way of opposition. The commissioner is actually concerned in dealing with applications for patents. It is only in the course of the discharge of his duties in dealing with these applications that opposition can arise. He has power to decide all the questions which may arise as incidental to the discharge of his duty in determining whether or not a patent should be granted. Any other view would erect many procedural rules into essential preliminaries to jurisdiction. If the opposition had been an original proceeding, it might have been necessary to consider such a case as *R. v. Arkwright* (1), where it

(1) (1848) 12 Q.B. 960 ; 116 E.R. 1130.

was held that the giving of a notice ought to have preceded the inquiry which a statute authorized and that the absence of the notice was the absence of "that which the legislature had made an essential preliminary to the exercise of jurisdiction": See *Colonial Bank of Australasia v. Willan* (1). But in the present case the commissioner is seised of the whole matter when the application for the patent is made, and it cannot be said that the giving of a notice of opposition is an essential preliminary to action by the commissioner in relation to the patent. But, apart from this consideration, I am of opinion that the first answer which I have stated to the objection made is in itself sufficient.

If this view is right, then it follows that the commissioner, having decided that there was a notice of opposition, had power to amend the notice under reg. 147 of the *Patents Regulations*. He may have exercised this power wrongly. If there was no notice of opposition, there was nothing to amend. The commissioner cannot, by purporting to exercise a power of amendment, make nothing into something, but, if he had the power to decide whether or not there was a notice of opposition, then he also had power to amend the notice if he decided that there was a notice. Again the remedy must be sought in an appeal and not by way of prohibition: Cf. *Barker v. Palmer* (2).

I agree, however, with the contention for the prosecutor that the amendment actually made is, in any event, wrong in form. The result of the amendment is that the opponents are described as two named persons "trading as E. Lufft and Son." I know of no authority for allowing any person to oppose other than simply as a person. He cannot qualify his opposition by stating that he opposes only as trading in conjunction with some other person. But this, again, is not an objection which can be dealt with on prohibition proceedings.

There has been some argument (but not very full argument) upon the question whether prohibition will go to the commissioner in any circumstances. In *R. v. Electricity Commissioners* (3) a wide view was taken of the scope of the very valuable remedy of prohibition,

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Latham C.J.

(1) (1874) L.R. 5 P.C., at p. 444.

(2) (1881) 8 Q.B.D. 9.

(3) (1924) 1 K.B. 171.

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS :
EX PARTE
WEISS.

Latham C.J.

and, as at present advised, I am of opinion that the proposition of *Atkin* L.J. (1) is applicable in the case of the commissioner. The learned Lord Justice was dealing with both prohibition and certiorari, and he said :—" It is to be noted that both writs deal with questions of excessive jurisdiction, and doubtless in their origin dealt almost exclusively with the jurisdiction of what is described in ordinary parlance as a court of justice. But the operation of the writs has extended to control the proceedings of bodies which do not claim to be, and would not be recognized as, courts of justice. Wherever any body of persons having legal authority to determine questions affecting the rights of subjects, and having the duty to act judicially, act in excess of their legal authority they are subject to the controlling jurisdiction of the King's Bench Division exercised in these writs." But in the view which I take of sec. 56 it is not necessary actually to decide the question whether prohibition will in any circumstances go to the commissioner.

For the reasons stated I am of opinion that the order nisi should be discharged.

RICH J. It was first objected that the firm in question was not a person within the meaning of sec. 56 of the *Patents Act* 1903-1935. The word "firm" is derived from an Italian word which means simply "signature" (*Churton v. Douglas* (2)). In law a firm has no existence; the firm-name is a mere expression, not a legal entity (per *Joyce J.*, in *re Vagliano Anthracite Collieries Ltd.* (3), quoting *Sadler v. Whiteman* (4)). In the old days, where the plaintiff misnamed himself the misnomer was pleadable in abatement. I adopt what was said by *Rooke J.* in *Mayor and Burgesses of Stafford v. Bolton* (5): "I think we ought not to be more strict than they were in the days of the Year Books." *Heath J.*, in the same case took his illustration from a Year-Book case which, although exemplifying the more spiritual interests of the medieval law, showed that in the yet more temporal concerns of modern law the misnomer of aggregates of people should be considered an irregularity exposing the proceedings to objection, it is true, but not entitling the opposite

(1) (1924) 1 K.B., at p. 205.

(2) (1859) 28 L.J. Ch. 841, at p. 845.

(3) (1910) 79 L.J. Ch. 769.

(4) (1910) 1 K.B. 868, at p. 889.

(5) (1797) 1 B. & P. 40, at p. 44;
126 E.R. 767, at p. 769.

party to treat them as completely null, a thing of nought. He said: "In 22 Ed. 4, 34, which was an assize by the Master, and brethren of the fraternity of the Nine Orders of Angels in B., and the defendant pleaded, that they were incorporated by the name of the Master and Brethren of the Fraternity of All Saints, and the Nine Orders of Angels in B.; the writ was abated, which shows that a misnomer may be pleaded in abatement, where the plaintiff misnames himself"

(1). And *Eyre* C.J. said: "In the case of a mistake in the name or description of an existing person having a right to sue, it may be pleaded in abatement . . . for if he be misnamed, he may have a new writ by the right name; but if there be no such body politic or such person, then he cannot have an action"(1). "To make it pleadable in bar," said *Buller* J. (1), "it must appear that there is no such corporation. The Year Books are decisive." In these days the objection is overcome by amendment and not by the defendant pleading in abatement and offering a better writ or proceeding to the plaintiff. Accordingly I think that the commissioner acted rightly in amending the notice of opposition.

It was next objected that, as the opponents were merely agents for the sale of a commodity, they had no *locus standi*. The commissioner took the view that their interest was deeper than that of agency. In my opinion the whole question of the sufficiency of an opponent's interest to give him a *locus standi* is one which falls to be decided in the proceedings upon opposition, first by the commissioner, and then on appeal. It is not a question which is external to the proceedings and preliminary to their validity. If the commissioner's decision were wrong, he did not usurp any power he did not possess by making such an error.

I am therefore of opinion that no case has been made out for prohibition.

STARKE J. Order nisi for a prerogative writ of prohibition.

The writ goes to restrain inferior courts and any persons or authorities exercising judicial functions from exceeding the jurisdiction committed to them (*R. v. Electricity Commissioners* (2); *Parisienne Basket Shoes Pty. Ltd. v. Whyte* (3)). But the writ does

H. C. OF A.

1939.

THE KING

v.

COMMISSIONER OF
PATENTS:
EX PARTE
WEISS.

Rich J.

(1) (1797) 1 B. & P., at p. 44; 126 E.R., at p. 769.

(2) 1924) 1 K.B. 171.

(3) (1938) 59 C.L.R. 369

H. C. OF A.

1939.

THE KING

v.

COMMISSIONER OF

PATENTS :

EX PARTE

WEISS.

Starke J.

not go to persons exercising administrative or ministerial and not judicial functions.

The writ in this case is sought pursuant to sec. 75 of the Constitution against the Commissioner of Patents, who is an officer of the Commonwealth. The prosecutor applied under the *Patents Act* 1903-1935 for letters patent for inventions entitled "Improvements in and relating to rotary intaglio printing." The applications were accepted and duly advertised. E. Lufft & Son were granted an extension of time for giving notices of opposition to the grant of patents, and they gave such notices within the extended time. The notices were in the form, "We, E. Lufft & Son of 337 Kent Street Sydney in the State of New South Wales, Commonwealth of Australia, printing suppliers, hereby give notice of our intention to oppose the grant" of letters patent upon certain grounds.

The prosecutor later sought to amend the specification of his inventions, and E. Lufft & Son also opposed these amendments. The commissioner heard the parties upon the right of E. Lufft & Son to be heard. It was argued for the prosecutor that the name "E. Lufft & Son" indicated a partnership firm, as was the fact, and that the *Patents Act* only conferred the right to oppose the grant of letters patent upon some legal entity and that in English law a partnership firm as such had no existence. It was further argued that E. Lufft & Son had no interest sufficient to support their opposition.

The commissioner allowed E. Lufft and Son to amend their notices of opposition by inserting the names "Ernst Lufft and Stanley Lufft trading together in partnership as E. Lufft & Son" in lieu of E. Lufft & Son. He further held that Ernst Lufft and Stanley Lufft trading together in partnership had established an interest sufficient to support their opposition. But the application for the letters patent and the opposition thereto stood over. And the prosecutor in the meantime obtained this order nisi for prohibition.

The argument before this court sought to establish that the commissioner, in acting as he did, exercised a judicial function in excess of the power committed to him. It was said that the authority or jurisdiction of the commissioner to hear and determine the opposition never attached, because a preliminary condition of that

jurisdiction was never fulfilled, namely, the giving of notices of opposition required by the statute. It was suggested that the notices in fact given were bad and mere nullities in point of law for several reasons:—(1) That the notices were not given by an entity known to the law but by a partnership firm which had no existence in law. (2) That the commissioner had no authority to amend void notices. (3) That, if the commissioner had authority to amend the notices, then the opposition was beyond the period allowed by the Act (sec. 56) for giving notices of opposition. (4) That Ernst Lufft and Stanley Lufft trading together in partnership as E. Lufft & Son had no interest sufficient to support their opposition.

But little attention was devoted in the argument to the question whether the commissioner had any judicial function in relation to the grant of letters patent and of opposition thereto or merely an administrative or ministerial function. The question depends upon the nature of the function rather than upon the form of the proceedings, though the form cannot be disregarded. It is quite true that judicial functions may be conferred upon an administrative body as distinguished from a court strictly so called. But it by no means follows that an administrative body is exercising judicial functions because it can hear and determine some matter or call and examine witnesses or award costs and so forth: Cf. *Shell Co. of Australia Ltd. v. Federal Commissioner of Taxation* (1). A judicial function requires some determination affecting the rights of subjects or imposing some obligation upon them: See *R. v. Local Government Board* (2); *R. v. Electricity Commissioners* (3).

A subject is, no doubt, entitled as of right to the grant of a patent for an invention if he complies with conditions required by the *Patents Act*. But the determination of the commissioner, whether there be or be not opposition, that a “grant ought to be made” (sec. 59) is no adjudication of the validity of the grant or of its effect (sec. 62) but rather whether he is satisfied on the preliminary investigations directed by the statute (secs. 39, 40, 41, 56-60) that the conditions required by the statute for the grant of a patent exist. In my opinion such a determination is, in substance, administrative

H. C. OF A.

1939.

THE KING

v.

COMMISSIONER OF
PATENTS:
EX PARTE
WEISS.

Starke J.

(1) (1931) A.C. 275.

(2) (1882) 10 Q.B.D. 309, at p. 321.

(3) (1924) 1 K.B. 171.

H. C. OF A.
 1939.
 THE KING
 v.
 COMMISSIONER OF
 PATENTS :
 EX PARTE
 WEISS.
 ———
 Starko J.

or ministerial and not a judicial function. Consequently the prerogative writ of prohibition is not an appropriate remedy (*Re Grosvenor and West End Terminus Hotel Co. Ltd.* (1); *Re Wingate's Patent* (2); *Re Hall* (3); *Re Van Gelder's Patent* (4); *R. v. London County Council* (5)). But, even if the determination of the commissioner be a judicial function, still in my judgment the writ of prohibition should in this case be refused inasmuch as the commissioner has acted throughout in accordance with his statutory duty and without any excess of his jurisdiction. A statute may, as was pointed out in *R. v. Commissioners for Special Purposes of the Income Tax* (6) and in *R. v. Bloomsbury Income Tax Commissioners* (7), provide that if a certain state of facts exist a tribunal shall have jurisdiction but not otherwise. In such a case the tribunal cannot conclusively decide whether that state of facts exists or not, and, if it exercises jurisdiction without the existence of those facts, then what it does may be questioned in appropriate proceedings, such as proceedings in prohibition. An illustration of this class of case may be found in the case of *R. v. Commonwealth Court of Conciliation and Arbitration; Ex parte Broken Hill Pty. Co. Ltd.* (8). But the statute may entrust the tribunal with a jurisdiction "which includes the jurisdiction to determine whether the preliminary state of facts exist as well as the jurisdiction, on finding that it does exist, to proceed further or do something more" (9). In such a case it "is an erroneous application of the formula to say that the tribunal cannot give themselves jurisdiction by wrongly deciding certain facts to exist because the legislature gave them jurisdiction to determine all the facts . . . and if they were given jurisdiction so to decide then there is no excess of jurisdiction" (10). Such a case was *R. v. Bloomsbury Income Tax Commissioners* (7), and also *R. v. Swansea Income Tax Commissioners* (11), and such a case is that now before us.

An application for letters patent must be left with or sent to the Patent Office (sec. 33). It then becomes the duty of the commissioner

(1) (1897) 13 T.L.R. 309; 76 L.T. 337.

(2) (1931) 2 Ch. 272.

(3) (1888) 21 Q.B.D. 137.

(4) (1888) 6 R.P.C. 22.

(5) (1893) 2 Q.B. 454, at pp. 459, 465, 467.

(6) (1888) 21 Q.B.D. 313.

(7) (1915) 3 K.B. 768.

(8) (1909) 8 C.L.R. 419.

(9) (1915) 3 K.B., at p. 782.

(10) (1915) 3 K.B., at p. 783.

(11) (1925) 2 K.B. 250.

to investigate the application (secs. 42, 44, 45, 46, 49 and 50). If he accepts the application and specification, then he advertises the fact, and the next step in the proceedings is open. Any person may within the time prescribed give notice of opposition (sec. 56). It is then the duty of the commissioner to hear and decide the case, which is whether the grant of a patent ought to be made. But the case cannot be decided unless the commissioner determines whether the notice of opposition is good or bad, whether, in other words, it is given by a party entitled to give it, whether that party has sufficient interest to support the opposition, and whether it is given in due time. It is part of his jurisdiction to determine these questions, and it is not in excess of his jurisdiction if he determines them wrongly. If he decides wrongly, that is a matter for appeal if any appeal be provided, and if no appeal is provided then the decision is final and the courts cannot interfere by means of the prerogative writ of prohibition. I need only refer in this connection to sec. 58 of the Act and the case of *Australian Radio Manufacturers' Patents Association Ltd. v. Neutrodyne Pty. Ltd.* (1).

It is plain, I think, that the object of the legislature was to make the decision of the commissioner final unless disputed in the manner provided by sec. 58. In this view, ample power to amend the notices of opposition was conferred by reg. 147 of the *Patents Regulations*.

The order nisi should be discharged.

DIXON J. This is an application for a writ of prohibition directed to the Commissioner of Patents prohibiting him from proceeding to hear and determine an opposition, or, rather, two several oppositions.

The writ is sought by the applicant for letters patent in respect of two alleged inventions. To each application a notice of opposition was lodged in purported pursuance of sec. 56 of the *Patents Act* 1903-1935. The notices described the opponents by the firm-name of E. Lufft and Son. It is the title of a partnership consisting of Ernst Lufft and Stanley Lufft. At the instance of the opponents, the commissioner, or, rather, a deputy commissioner empowered under sec. 11, amended the notice of opposition, in the exercise of the

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Starke J.

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Dixon J.

discretion obtained under reg. 147, by substituting the individual names of the partners for that of the firm. The applicant objected to this course on the ground that a notice in the firm-name was no opposition and the defect could not be cured by amendment, particularly as the time for opposition had then expired. In any case, the applicant objected that the opponents, whether considered as a firm or as individuals, were not interested and were not entitled to oppose. His objections having been overruled, the applicant, with a view of obtaining a judicial determination of the competence or validity of the oppositions before entering upon an expensive hearing, obtained an order nisi for a writ of prohibition.

It has not yet been decided that the Commissioner of Patents, even when dealing with proceedings by way of opposition, is a judicial tribunal or officer to whom a writ of prohibition lies. He forms part of the administrative organization established by statute for carrying out a function of the Crown which formerly depended upon the prerogative and was essentially executive. The very foundation of the principle upon which grants of letters patent are treated as not conclusive, but as liable to be held void, is to be found in the executive nature of the limited power under which grants of monopoly may be made. But a great extension of the scope of the writ of prohibition has been effected in England in late years by judicial decision. The writ has been sent to many administrative bodies acting only quasi-judicially: See *R. v. Electricity Commissioners* (1); *R. v. Legislative Committee of the Church Assembly* (2) (*contra*: *R. v. Minister of Health*; *Ex parte Davis* (3); *R. v. North Worcestershire Assessment Committee*; *Ex parte Hadley* (4); *R. v. Minister of Health*; *Ex parte Villiers* (5); *Estate and Trust Agencies* (1927) *Ltd. v. Singapore Improvement Trust* (6)); and compare, per Isaacs and Rich JJ., *Waterside Workers' Federation of Australia v. Gilchrist, Watt & Sanderson Ltd.* (7); and see *R. v. Optical Board of Registration*; *Ex parte Qurban* (8). No distinction appears to have been drawn between the kind of tribunal to which certiorari will go and that to which prohibition lies. Notwithstanding this

(1) (1924) 1 K.B. 171.

(2) (1928) 1 K.B. 411.

(3) (1929) 1 K.B. 619.

(4) (1929) 2 K.B. 397.

(5) (1936) 2 K.B. 29.

(6) (1937) A.C. 898.

(7) (1924) 34 C.L.R. 482, at p. 515.

(8) (1933) S.A.S.R. 1.

modern development, doubts seem still to exist as to the propriety of addressing prohibition to the Comptroller-General of Patents (*Re Wingate's Patents* (1)). But, assuming a writ of prohibition will lie to the Commissioner of Patents prohibiting him from hearing and determining opposition proceedings where he has no authority to do so, I do not think that a case has been shown in the present instance of such a complete lack of authority as to found prohibition. It may be taken that, under sec. 66, the applicant for a patent becomes entitled to a grant, that is, in the sense and subject to the qualifications explained in *Tate v. Haskins* (2), if no valid opposition is lodged. A notice of opposition, therefore, intercepts the applicant's right to a grant. It also imposes upon the commissioner a duty of hearing and deciding the opposition. Sec. 57 provides that, where such notice is given, the commissioner shall give notice of the opposition to the applicant and shall at the time and in manner prescribed hear and decide the case. "Such notice" means the notice of opposition referred to in sec. 56. In my opinion, unless it can be said that a purported notice of opposition is void so that the commissioner may and should ignore it and proceed under sec. 66 to complete a grant by causing a patent to be sealed, he must act under sec. 57 and hear and decide the case.

To make an objection in the firm's name was irregular. The firm-name is the description of the partners acting in conjunction for the purposes and within the scope of the partnership. It may be conceded that, not only does it insufficiently identify the individuals constituting the partnership, but it indicates an association of persons acting in a particular capacity or right. But I do not think that the misdescription or misnomer involved in the use of the partnership name makes the notices of opposition mere nullities. Under the power to make regulations contained in sec. 108, it would, I think, be possible to authorize the use of the firm-name in a notice of opposition. In fact the regulations prescribe a form requiring the full names of the opponents. But the regulations also confer a power of amendment. A firm-name is, after all, a reference to persons, and, notwithstanding its inadequacy and the limitation of capacity

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Dixon J.

(1) (1931) 2 Ch. 272, at pp. 276, 277, 279, 286.

(2) (1935) 53 C.L.R. 594, at pp. 611, 612.

H. C. OF A.
1939.

THE KING
v.
COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Dixon J.

or legal relationship implied, it notifies a real intention to oppose by real persons. In my opinion it forms a sufficient foundation to entitle the commissioner to proceed. It is needless to add that in a proper case irregularity in a notice may justify dismissal of the opposition. In the present case, however, it has been thought right to allow an amendment and thus to make the notice regular.

The second ground relied upon by the prosecutor is that the opponents have *no locus standi*. But again I think that this objection does not go to the validity of the notice of opposition as a proceeding which the commissioner must hear and decide. It is an objection which may be relied upon before him and afterwards upon appeal as showing that the opposition ought not to be sustained or even heard upon the merits. But it is a matter which it is within the province of the commissioner to determine. The necessity of interest no doubt is the result of more than departmental practice. It is a requirement spelt out of the provisions of the Act. But want of interest does not make the notice a merely void piece of paper.

The order nisi should be discharged with costs.

EVATT J. This is an application to the court for a writ of prohibition to prohibit the Commonwealth Commissioner of Patents from proceeding to hear and determine two oppositions by Ernst Lufft and Stanley Lufft (trading together in partnership as E. Lufft and Son) to the grant of two several patents for inventions relating to rotary intaglio printing applied for by the present applicant on May 8th, 1935. The grounds upon which the applicant disputes the jurisdiction of the Commissioner of Patents to hear and decide the oppositions are: (1) that sec. 56 of the *Patents Act* 1903-1935, which provides that "any person" may give notice of opposition, does not enable such a notice to be given in a mere partnership name even although the notice has been authorized by the members of the firm; (2) that the opening words in sec. 56, "any person," should be interpreted as limited to "any person having a sufficient interest to oppose," and that even in respect of their trading partnership the two respondents Lufft had not sufficient interest to oppose.

Sec. 56 occurs in Division 2 of Part IV. of the *Patents Act*, which is headed "Procedure." It is, of course, possible, though *a priori* very unlikely, that the jurisdiction of the commissioner to decide an opposition to a grant may be subjected to a provision which operates to make compliance with some procedural requirement an essential condition precedent to the exercise of his jurisdiction. Whether such condition precedent is set up depends upon the construction of the Act. Here the crucial provision is sec. 57, which runs: Where such notice is given, the commissioner shall give notice of the opposition to the applicant, and shall at the time and in manner prescribed hear and decide the case.

The applicant here is forced to contend that the authority of the commissioner to "hear and decide the case" comes into existence only if a notice of opposition which in all respects conforms to sec. 56 has been given at the Patents Office. Sec. 57 contains two distinct commands. The first directs the commissioner to give notice of the opposition to the applicant "where such notice is given." The second directs the commissioner to "hear and decide the case" wherever "such notice is given." According to the applicant the commissioner is under no duty to give the applicant notice of the opposition unless the filed opposition complies with sec. 56. On this view, presumably, the commissioner should determine in advance whether sec. 56 has been complied with. In my opinion the commissioner's duty under the first part of sec. 57 is purely administrative. He is not empowered to ignore any *de-facto* notice, but must in all cases notify the applicant that an opposition has been lodged. In other words, "such notice" in the phrase "where such notice is given" means a notice which purports to comply with sec. 56 and which has in fact been lodged by some person at the Patents Office. If this is so, the commissioner's jurisdiction to "hear and decide the case" (which is also made dependent upon the event "where such notice is given") cannot be conditioned by the existence of a valid notice. It is sufficient that a *de-facto* notice is given. If this is so, the commissioner is intended by sec. 57 to have jurisdiction to determine the case and, in the course of doing so, to determine whether the *de-facto* notice given complies with sec. 56 and also to determine whether, if it does not so comply, it can or should be

H. C. OF A.

1939.

THE KING

v.

COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Evatt J.

H. C. OF A.

1939.

THE KING

v.

COMMISSIONER OF
PATENTS;
EX PARTE
WEISS.

Evatt J.

amended. But this is only another way of saying that in this particular case nothing has happened to place the decision of what sec. 57 calls "the case" outside the commissioner's jurisdiction, and that in turn is only another way of saying that the application for a writ of prohibition should be dismissed.

While I express no opinion as to the two points of law upon which the application was founded, I reject the contention that in no case can a writ of prohibition for excess of jurisdiction be directed to the Commissioner of Patents. It is true that his functions include matters of administration and that, strictly speaking, he is not a judicial officer. But when he has to "hear and decide the case," as sec. 57 of the Act requires, it is incumbent upon him to exercise judicial or quasi-judicial functions. Since the decision of the Court of Appeal in *R. v. Electricity Commissioners* (1) it is too late to ask the courts to hold that administrative tribunals of the character described by *Atkin* L.J. possess an immunity from the writ of prohibition. In the present case it is to be noted that the decision of the commissioner under sec. 57 is subject to appeal to the High Court or the Supreme Court of a State, which strongly supports the conclusion that the commissioner can be made subject to the writ of prohibition.

But, for the reasons already given, the present application fails and should be dismissed.

Order nisi discharged. Applicant to pay costs of the opponents and of the Commissioner of Patents.

Solicitors for the prosecutor, *Madden Butler Elder & Graham.*

Solicitor for the commissioner, *H. F. E. Whitlam*, Commonwealth Crown Solicitor.

Solicitors for *E. Lufft and S. Lufft, Waters & Stewart.*

H. D. W.

(1) (1924) 1 K.B. 171.