

[HIGH COURT OF AUSTRALIA.]

WEISS APPELLANT ;

AND

LUFFT AND OTHERS RESPONDENTS.

Patents—Complete specification—Amendment—Amendment of claims—Amendment of body of specification to accord therewith—Patents Act 1903-1935 (No. 21 of 1903—No. 16 of 1935), secs. 36, 71, 78.

Where an inventor seeks to amend the claims in his specification by disclaiming some features thereof, it is essential that he should also amend the body of his specification to make it conform with the amended claim.

H. C. OF A. APPEAL from the Deputy Commissioner of Patents.

1941. Adolf Weiss applied for letters patent No. 22525/35 dated 8th May 1935 for an invention entitled “Improvements in and relating to rotary intaglio printing.” On 11th September 1937 a request for leave to amend the complete specification under sec. 71 of the *Patents Act 1903-1935* was left at the Patents Office, the reasons for the request being : “That it is desired to amend the claims to limit the same to more clearly define the scope of the invention.” In accordance with sec. 73 of the Act the request for leave to amend was advertised on 14th October 1937 and was opposed by Ernst Lufft and Stanley Lufft and R. Hoe and Company Incorporated.

MELBOURNE, May 15, 16, 19, 20 ; June 4.

Rich A.C.J., Starke, McTiernan and Williams JJ.

The application for leave to amend was heard by the Deputy Commissioner of Patents, who disallowed the amendments.

Weiss appealed to the High Court.

The relevant original claims, the amendments sought, the grounds of opposition, and the Deputy Commissioner’s reasons for disallowing the amendments, are set out in the judgments hereunder.

Ellis, for the appellant. On the question of “disclaimer, correction, or explanation”, the amendments are principally explanations and disclaimers, with a few corrections. In so far as the appellant

has grouped combinations of elements in claims, instead of leaving separate claims for those elements, that is a disclaimer, because it is narrower. As to the question whether the amended claims are "substantially larger or different," on examination each claim is related to, and is taken substantially from, the old claims; in particular, the "combination" method makes claims narrower, not larger. As to the question of ambiguity, the Deputy Commissioner was wrong in taking the view that the presence of irrelevant matter in the "body" could invalidate the amended claims by producing ambiguity. It does not matter how widely you put matter in the "body" or "description," provided the claim is limited enough (*In re Johnson & Johnson (Great Britain) Ltd.* (1)). If there is superfluous matter in the "body" it harms no-one. The specification should be read as a whole, and the court should not be astute to defeat a patent (*Hinks & Son v. Safety Lighting Co.* (2)). The claims themselves are not ambiguous; it is permissible to have a wide claim and successively narrower claims (*Halsbury's Laws of England*, 2nd ed., vol. 24, p. 550). *Cowper v. Paper Sacks Pty. Ltd. and The Commissioner of Patents* (3) is distinguishable. If any claim is ambiguous, it does not necessarily affect another (*Patents Act 1903-1935*, sec. 61).

Dean, for the respondents. As to the function of the Commissioner on an amended application, he has a double duty—to determine the opposition, and to determine what he would do if there were no opposition (*Patents Act 1903-1935*, secs. 76, 77; *Patents Regulations 1912*, reg. 102). He has a "discretion" whether he will allow the amendment or not—a judicial discretion—and it is not limited to the grounds of the opponent's opposition (*Potters Sulphide Ore Treatment Ltd. v. Minerals Separation Ltd.* (4); *Neilson v. Minister of Public Works (N.S.W.)* (5); *In re Parkinson's Patent* (6); *Fletcher-Moulton on Patents*, (1913), p. 282; *Terrell on Patents*, 8th ed. (1934), pp. 235, 237; *Frost on Patent Law and Practice*, 4th ed. (1912), vol. II., p. 105; *Halsbury's Laws of England*, 2nd ed., vol. 24, p. 710). As to the amendment being "substantially different," although an amendment may be in the form of a "disclaimer" the invention may nevertheless be thereby rendered substantially different (*Ralston v. Smith* (7); *In re I. G. Farbenindustrie Aktiengesellschaft's Application* (8)). This invention would

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(1) (1938) Ch. 283, at p. 294.

(2) (1876) 4 Ch. D. 607, at p. 612.

(3) (1932) A.C. 709; 49 R.P.C. 601.

(4) (1909) 8 C.L.R. 779, at pp. 800, 801.

(5) (1914) 18 C.L.R. 423, at p. 431.

(6) (1896) 13 R.P.C. 509, at p. 514.

(7) (1865) 11 H.L.C. 223 [11 E.R. 1318].

(8) (1928) 46 R.P.C. 271.

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be rendered substantially different if these amendments were allowed. Alternatively, as to ambiguity, it is impossible to tell what new claims 1 and 2 do mean to cover.

Sholl, for the Commissioner of Patents. As to the amendment being “substantially larger or different,” the Commissioner determined this in favour of the appellant; at any rate, he did not decide affirmatively that there would be any substantial difference. As to ambiguity, the Commissioner considered, and the Court can consider, ambiguity in two aspects:—(i) the “body,” by its irrelevant matter, and by its misleading reference to this, that, or the other, as the “invention” affects the claims; (ii) the claims themselves are internally ambiguous.

As a result:—(a) The patent is invalid, and in the Commissioner’s discretion, he is entitled to refuse the amendments; alternatively, (b) the patent is embarrassing and obscure, and his discretion extends to refusal in such circumstances; alternatively, (c) owing to ambiguity, the applicant does not establish that the amendments are by way of disclaimer, correction, or explanation, or that they do not make the invention substantially larger or different; and he therefore fails in his application, the onus being on him (*Cowper v. Paper Sacks Pty. Ltd. and The Commissioner of Patents* (1)).

The Commissioner is entitled, and the Court is entitled, to go further, and consider:—(iii) The prolixity, obscurity, and irrelevance of the “body,” as showing non-compliance with sec. 36 of the *Patents Act* 1903-1935.

As to (i) and (ii): The legal principles applicable are:—1. Importance of clarity; manner in which ambiguity vitiates patent, or application for amendment, is illustrated in *Cowper v. Paper Sacks Pty. Ltd. and The Commissioner of Patents* (2); *Terrell on Patents*, 8th ed. (1934), p. 134, citing *Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co. Ltd.* (3), per Lord Loreburn; *Terrell on Patents*, 8th ed. (1934), p. 235. 2. The importance of consistency between description and claims (*Mullard Radio Valve Co. Ltd. v. Philco Radio and Television Corporation of Great Britain Ltd.* (4); *Patents Act* 1903-1935, sec. 36; *Terrell on Patents*, 8th ed. (1934), p. 134; *Re Airspeed Ltd. and A. H. Tiltman’s Letters Patent* (5); *British Ore Concentration Syndicate Ltd. v. Minerals Separation Ltd.* (6),

(1) (1932) A.C., at p. 714; 49 R.P.C., at p. 619.

(2) (1932) A.C., at p. 713; 49 R.P.C., at p. 618.

(3) (1908) 25 R.P.C. 61, at p. 83.

(4) (1936) 53 R.P.C. 323.

(5) (1940) 57 R.P.C. 313, at p. 326.

(6) (1909) 27 R.P.C. 33, at p. 47.

per Lord *Halsbury*). 3. Possible evil results in subsequent interpretation by trade or litigants, in case of ambiguity in claims, dissonance between description and claims (*Natural Colour Kinetograph Co. Ltd. v. Bioschemes Ltd.* (1), per Earl Loreborn L.C.). 4. Discretionary nature of power on application for amendment: Cf. *In re British Thomson-Houston Co. Ltd.'s Patent* (2).

As to proposition (iii), the prolixity, obscurity, and irrelevancies of "body" and claims show non-compliance with sec. 36 of the *Patents Act* 1903-1935. The appellant has not "fully described and ascertained the invention" (*In re Francis' Application* (3)). It is the Commissioner's duty to take this objection at any time before grant; the fact that he may, by an examiner, have accepted the complete specification, cannot affect the matter (*Tate v. Haskins* (4); *Halsbury's Laws of England*, 2nd ed., vol. 24, p. 569).

Ellis, in reply.

Cur. adv. vult.

The following written judgments were delivered:—

RICH A.C.J. I have had the opportunity of reading the judgment of *Williams J.*, and concur in it.

In my opinion the order should be that the appeal and cross-appeal be dismissed and the appellant pay the costs of the Deputy Commissioner and of the respondents of this appeal.

STARKE J. Appeal from a decision of the Deputy Commissioner of Patents refusing the appellant leave to amend his complete specification (1935, No. 22,525) for an invention entitled "Improvements in and relating to rotary intaglio printing."

In 1935 application was made for letters patent for the invention; the complete specification was accepted in 1936 and advertised in the same year. Apparently notice of opposition was then given by the respondents or some of them to the grant of letters patent, and in September of 1937 the appellant applied for leave to amend his specification pursuant to the provisions of the *Patents Act* 1903-1935. This application was also opposed by the respondents. The Act, by sec. 71, provides that amendments may be allowed by way of disclaimer, correction or explanation, and, by sec. 78, that no amendment shall be allowed that would make the specification as amended claim an invention substantially larger than or substantially different from the invention claimed by the specification before

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(1) (1915) 32 R.P.C. 256, at p. 266.

(3) (1909) 27 R.P.C. 86.

(2) (1919) 36 R.P.C. 251, at pp. 257,
263.

(4) (1935) 53 C.L.R. 594, at pp. 611,
612.

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amendment. It is, within reason, a matter of discretion whether amendments should be allowed. The conduct of the patentee may be considered, the drafting of his specification, the ambiguity and the "covetousness" of his claims, and so forth (*In re Farbenindustrie Aktiengesellschaft's Patents* (1); *In re British Thomson-Houston Co. Ltd.'s Patent* (2); *Mullard Radio Valve Co. Ltd. v. British Belmont Radio Ltd.* (3); *Cowper v. Paper Sacks Pty. Ltd. and The Commissioner of Patents* (4)).

The *Patents Act*, by sec. 36, prescribes that a complete specification must fully describe and ascertain the invention and the manner in which it is to be performed, and must end with a distinct statement of the invention claimed. It is difficult to ascertain from the body of the specification, in the present case, though there are fifty-six columns of closely printed description, what the appellant invented. The specification commences with the assertion that the invention is particularly useful in printing a plurality of component parts, that the mechanism of intaglio printing has been extremely bulky, that printing speed has been limited, and servicing difficult. The objects of the invention, according to the specification, are to provide a compact machine, improved methods for attaining operative speed, and efficient operation and servicing. The specification then refers to drawings, attached to the specification, numbering no less than thirty-two figures, and adds that the general features of the machine will first be described by way of introduction and in order to present a clear understanding of the general travel of the web and relative location of the principal units of the invention, the embodiment of which takes the form of a rotary intaglio printing press comprising a plurality of printing stages each of which may represent a different colour. An introductory statement follows, and then the structural details of the machine are described with particularity under such headings as "Frame Structures," "Conveyor Belt Drive," "Printing Units," "Cylinder Drive and Adjustments," "Doctor Reciprocating Mechanism," "Pressure Roller," "Webb Tensioning Means," "Ink and Solvent Supply and Circulation," "Circulating Pump and Float Control Means," "Operation," "Registration," and "Fluid Circulation." In describing the "Doctor Reciprocating Mechanism" the appellant refers to it as "one important phase of the invention, i.e., the provision of means for retarding the escape of volatile ink ingredients from the ink housing in order to materially retard and preferably prevent evaporation of the ink," and also states that "the provision to maintain a seal

(1) (1930) 47 R.P.C. 289.

(2) (1919) 36 R.P.C., at pp. 257, 258.

(3) (1938) 56 R.P.C. 1, at p. 21.

(4) (1932) A.C. 709; 49 R.P.C. 601.

with the reciprocating doctor is an important feature of the invention." But, he adds, "obviously the sealing may be accomplished by various means other than those described specifically herein." Again, under heading "Ink and Solvent Supply and Circulation," the appellant states that the means of supplying and circulating the ink and solvent forms an important part of the invention.

It might be gathered from the body of the specification that the printing press, which is described with such detail, was the appellant's invention, and that the doctor reciprocating mechanism and the ink and solvent supply and circulation were important features of that invention. The appellant, having, as the specification states, fully described and ascertained his invention and the manner in which it is to be performed, then sets forth no less than thirty-two claiming clauses. In none of these does he claim a printing press constructed in accordance with the description upon which so many columns of printed matter have been lavished. In the main, his claims are for various features or elements in the intaglio printing press, and not for the machine constructed and made according to his specification and illustrated by the drawings attached to the specification.

The specification does not, to my mind, observe the direction contained in sec. 36 of the Act, and ought not to have been accepted in the form in which it was lodged at the Patents Office. But the question now is whether the Deputy Commissioner was right in refusing leave to amend the specification.

The learned counsel who appeared for the appellant stated, in answer to the Court, that the appellant would prefer to withdraw his present application for leave to amend unless he obtained leave to cancel claims 1, 2 and 3 and substitute therefor a new claim, which was numbered 1 in the application to amend.

Claims 1, 2 and 3 in the specification lodged in the Patents Office were:—"1. A rotary intaglio printing press of the type wherein there is an ink housing adapted to receive a rotatable printing cylinder therein, and a reciprocable wiping means normally in wiping engagement with the cylinder, characterized by the fact that there are means co-operating with the wiping means, housing and cylinder to close the housing and prevent substantial evaporation of ink. 2. The structure set forth in claim 1, wherein the closing means includes a relatively stationary sealing element constituting a sealing extension of the wiping means during the reciprocation thereof. 3. The structure set forth in claim 1, wherein the wiping means is in the form of a reciprocable doctor, and the evaporation

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is prevented by a closure which engages the housing, cylinder and doctor.”

The new claim numbered 1 is as follows :—“ 1. A rotary intaglio printing press of the type wherein there is an ink housing adapted to receive a rotatable printing cylinder therein, and reciprocable wiping means or doctor normally in wiping engagement with the cylinder, characterized by the fact that there are means co-operating with the wiping means or doctor, housing and cylinder to close the housing and prevent substantial evaporation of the ink, such closing means including a relatively stationary sealing element constituting a sealing extension of the wiping means or doctor during the reciprocation thereof.”

This new claim neither corrects nor explains anything. And in my opinion it disclaims nothing. It is either a repetition of the old claim 2 or a wider and substantially different invention from that set forth in old claim 2. Claim 2, it will be observed, is for the structure set forth in claim 1, wherein the closing means includes a specified arrangement. In that context, the word “includes” probably claims that the closing means is an element of the structure claimed, but the word often means one of a number of things, or that particularized as well as other means. New claim 1 sets forth in almost the identical words of old claim 1 the structure claimed in old claim 2, but instead of repeating the words “wherein the closing means includes” &c. substitutes the words “such closing means including” the same particularized arrangement. If the word “including” means that the closing element particularized is an element of the structure claimed, then it is a mere repetition of claim 2 and disclaims nothing. But if it means, in the new context, that the closing arrangement particularized is only one of several arrangements that are claimed, then the claim is wider than old claim 2 and is certainly not a disclaimer, but an invention substantially different from that claimed in the specification. The wider meaning of the word is, I think, its proper construction in the new context, and the language of the body of the specification supports this view.

At all events, the amended claim is so ambiguous that it ought not to be allowed. Further, I do not think the amendment should be allowed unless radical alterations are made in the body of the specification, bringing it more in accord with the directions contained in sec. 36 of the Act.

The result is that the appeal should be dismissed.

McTIERNAN J. I agree that the appeal and cross-appeal should be dismissed. H. C. OF A.
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The amendments sought are principally by way of disclaimer of a substantial part of the monopoly claimed. The request to amend is limited to the claims. It is clear that if it were granted substantial amendments would need to be made in the body of the specification. Otherwise the specification as amended would not conform to the requirements of sec. 36 of the *Patents Act* 1903-1935. The amendments which the appellant requests to be made do not include any such amendments to the body of the specification. The request should, in my opinion, be refused on this ground. This ground is discussed in the reasons for judgment of my brother *Williams*, and it is unnecessary to add anything. The proposed new claim 1 was also criticized on the ground that the word "including" leads to an ambiguity as to the scope of the claim. To my mind, no ambiguity is produced by the word "including" as used in the new claim, but if the proposal to amend be further pursued it would appear to be desirable to make such verbal amendments as would be necessary to meet this criticism.

The Deputy Commissioner decided that the present respondent had failed to make out the ground of opposition that the amendment, if allowed, would make the specification as amended substantially different from the invention claimed in the specification before amendment. In my opinion the Deputy Commissioner's decision is correct. I think, therefore, that the order of the Deputy Commissioner refusing the respondents their costs of the proceedings before him was justified, and that the cross-appeal should be dismissed. The appellant, however, should pay the costs of the respondent of this appeal and also the costs of the Deputy Commissioner: See *Tate v. Haskins* (1).

WILLIAMS J. This is an appeal against the disallowance by the Deputy Commissioner of Patents of certain proposed amendments to the claims contained in the complete specification for application for letters patent No. 22525/35. The application and specification were accepted by the Commissioner of Patents, and the acceptance of the specification advertised as required by sec. 50 of the *Patents Act* 1903-1935 on 5th March 1936. The granting of letters patent was opposed in accordance with sec. 56 of the Act. On 11th September 1937, before the opposition was decided, the applicant applied under sec. 71 for leave to amend his claims, the reason given for the amendments being "that it is desired to amend the claim

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to limit the same to more clearly define the scope of the invention.” The request for leave to amend and the nature of the proposed amendments were advertised in accordance with sec. 73 of the Act. The granting of leave was opposed by the respondents, Ernst Lufft and Stanley Lufft (trading as E. Lufft & Son) and R. Hoe & Company Incorporated. The grounds of opposition were :—(1) that the proposed amendments, if allowed, would make the specification as amended claim an invention substantially different from the invention claimed by the specification before amendment, and (2) that the subject matter mentioned in the amendment was not novel. In view of No. 102 of the *Patents Regulations* 1912, the Deputy Commissioner held that the second ground of objection was not open to the opponents.

The Deputy Commissioner of Patents refused leave to amend, for the reason that the amendments, if allowed, would introduce ambiguity into the specification. It is against the refusal that the applicant has appealed to this Court. The Deputy Commissioner held that the opponents failed to establish the ground of opposition open to them, and they have cross-appealed.

The Deputy Commissioner pointed out in the reasons for his decision that, while the specification described the whole construction of an intaglio printing press in great detail, the claims were not for the press as described but for all rotary intaglio printing presses containing certain improvements in general and somewhat ambiguous terms, the ambit of which it was impossible to ascertain from the construction of the specification as a whole. He went on to say that, although the proposed amended claims were more restricted than the original claims, they were still ambiguous, and that the body of the specification, which it was not proposed to amend, made the determination of their ambit even more difficult than in the case of the original claims.

The specification, which is intituled “ Improvements in and relating to rotary intaglio printing,” states that “ an object of this invention is to provide a compact machine capable of accommodating the desired number of printing cylinders, while requiring only a relatively small floor space area and one in which a web path of travel between cylinders is reduced to a minimum, and having its operative control and adjustment means so arranged and at such close proximity that operative effort is reduced to a minimum. Another object is to provide methods and apparatus for carrying out the same which permits an increase in operative speed of from one hundred to two hundred per cent as compared with current practice while producing work of the highest character. Another object is to provide improved

methods and apparatus for carrying out the same which permit extremely efficient and expeditious operation and maintenance servicing, and specifically with reference to inking and in cleaning the parts subjected to ink.”

It then proceeds to describe the whole press in profuse detail, the applicant stating that this is necessary, “in order to present a clear understanding of the general travel of the web and the relative location of the principal units of the present embodiment of the invention which embodiment takes the form of a rotary intaglio printing press comprising a plurality of printing stages each of which may represent a different colour.”

It would appear that such a press at the date of the specification consisted of one or more engraved cylinders, each revolving in a separate housing containing a sump filled with ink. As the cylinder travelled through the sump its submerged surface became covered with this ink. The ink on the unengraved portion of the surface was removed by a wiper called a doctor, which reciprocated to right and left across the surface of the cylinder prior to its coming in contact with the web, so that only that portion of the paper which was forced upon the engraved portion of the surface of the cylinder became printed. The web was pressed on to the surface of the cylinder at the point of contact by a roller. Where it was desired to engrave the paper with more than one colour, so that more than one cylinder was required, one colour would be printed on the paper by the first cylinder and the other colours by the succeeding cylinders, the paper passing like a belt from one cylinder to the others, the cylinders being lined up so that the exact portion of the paper to be printed by each cylinder would meet the engraved surface of that cylinder. It is plain that the machinery to carry out such an object would be complicated, and that the success of the whole engraving would depend upon an accurate adjustment and functioning of the various component parts of the whole press. The main object of the invention was to produce a press having these general characteristics which would be compact, would operate at a greatly increased speed, and would be easy to dismantle and reassemble to change the cylinders or for cleaning purposes. In order to increase the speed it was necessary to use a highly volatile and quickly drying ink which rapidly evaporated. The evaporation of the ink was to some extent prevented by the sides of the housing, the cylinder, and the doctor; but avenues of escape still existed through the spaces between the cylinder and the end and side walls of the housing. The applicant pointed out in the specification that one important phase of the invention was the provision of means for substantially preventing

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the escape of the volatile ingredients of the ink from the housing. He said: "This is of extreme importance not only when highly volatile or rapidly drying inks are employed, as is contemplated in practicing the invention in its present preferred form, but also when relatively less volatile inks are employed, since even in relatively less volatile ink there are certain ingredients which are readily volatile, and it is the elimination or escape from the inks of these readily volatile agents which is one of the serious drawbacks in the art of printing as it is practised in general to-day. In other words it is to be clearly understood that while the present preferred embodiment of the invention contemplates the use of extremely highly volatile inks, nevertheless the invention has also proven of great merit when employed in the use of inks of the character in general use to-day. One of the difficulties in retarding, and more particularly in substantially preventing the escape of volatile ingredients from the ink housing is encountered where a reciprocating doctor is employed, and, since the use of a reciprocating doctor is highly desirable, if not necessary, to produce the best possible results in printing, the provision to maintain a seal with the reciprocating doctor is an important feature of the invention." The applicant then proceeded to describe means for sealing the spaces to which I have referred, including an extension of the doctor to seal the openings on one side of the cylinder between the ends of the cylinder and end walls of the housing during reciprocation. In order to ensure the efficient supply of ink to the cylinder, it was necessary to provide adequate means to circulate the ink in the housing and maintain the parts in a clean state, and these means were stated to be an important part of the invention.

In the case of the sealing means the inventor stated that "obviously the sealing may be accomplished by various means other than those described specifically herein," and also that "the sealing at the doctor side of the cylinder may be effected by means other than those previously described. For example, the flexible sealing strip beneath the knife may be dispensed with, and as a substitute therefore a seal may be established with the holder or slide bracket."

A careful perusal of the body of the specification would, therefore, lead a reader to expect that the claims would be for the whole apparatus there described, with subsidiary claims for the process and means for sealing the openings already mentioned, for the means described for supplying the ink to the cylinder, and for those described for dismantling and reassembling the machine.

The specification contains thirty-two claims, the first being:—
"(1) A rotary intaglio printing press of the type wherein there is

an ink housing adapted to receive a rotatable printing cylinder therein, and a reciprocable wiping means normally in wiping engagement with the cylinder characterized by the fact that there are means co-operating with the wiping means, housing and cylinder to close the housing and prevent substantial evaporation of the ink."

The word "characterized" shows what is alleged to be new in the first claim is the provision of means to prevent the evaporation of the ink by closing the spaces already mentioned. No reference is made to the use of any particular ink, so that the claim is wide enough to cover the sealing of such spaces by any means in any intaglio printing press using any kind of ink. Even for the purpose of this wide claim the reference to the whole press described in the body of the specification as the invention is misleading. Such a detailed description could only be justified provided the inventor made it clear that the purpose of its insertion was merely to show how such a high-speed press embodying his improvements could be manufactured and that what he claims as an invention is not the whole press but only the improvements.

Sec. 36 of the Act provides that a complete specification must fully describe and ascertain the invention and the manner in which it is to be performed, and must end with a distinct statement of the invention claimed. The present specification does not, even in relation to the original claims, describe the invention, because it purports to describe as an invention the whole press, whereas the invention is restricted to certain of its parts.

The principal amendment provides for the deletion of original claims 1, 2 and 3 and a substituted new claim 1 in the following terms:—"A rotary intaglio printing press of the type wherein there is an ink housing adapted to receive a rotatable printing cylinder therein, and reciprocable wiping means or doctor normally in wiping engagement with the cylinder, characterized by the fact that there are means co-operating with the wiping means or doctor, housing and cylinder to close the housing and prevent substantial evaporation of the ink, such closing means including a relatively stationary sealing element constituting a sealing extension of the wiping means or doctor during the reciprocation thereof." In order that an amendment may be allowed the applicant must show (sec. 71) that the amendment is by way of disclaimer, correction, or explanation, and (sec. 78) that the amended specification does not claim an invention substantially larger than or substantially different from the invention claimed by the specification before amendment. In *Cowper v. Paper Sacks Pty. Ltd. and The Commissioner of Patents* (1), the Privy Council

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(1) (1932) A.C., at p. 713 ; 49 R.P.C., at p. 618.

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pointed out that "this necessarily involves that his amendment must be unambiguous, otherwise the onus upon him cannot be discharged." In *Mullard Radio Valve Co. Ltd. v. British Belmont Radio Ltd.* (1) the Master of the Rolls said: "If the amendment allowed is ambiguous, the judge has not exercised his statutory power as it is not really an amendment at all."

In the present case the appellant's contention is that the amended claim 1 is a disclaimer, because it is a claim for a combination of integers which previously had been separately claimed.

A disclaimer can be effected by such a combination of independent claims, and the amendment may be allowed, where the new combination was indicated in the original disclosure, and it appears that the object of the amendment is not to claim a substantially different or larger invention, but to narrow the description so as to define the real scope of the invention, having regard to the knowledge disclosed by prior grants which were unknown to the inventor at the date of his application (*In re Goltstein's Application* (2); *In re Thomson's Patent* (3)).

In the present case the appellant says in substance that, at the time he lodged his application, he believed that the method of sealing the spaces already mentioned was novel so that a wide claim to cover this method by any means was justified, provided he indicated one way of doing so; but that he now finds on further research that, although this method has been anticipated, the means described in the body of the specification of providing a sealing extension of the doctor are novel. He therefore desires to restrict his claim relating to the sealing of these spaces to means which necessarily include this sealing extension.

The appellant would be entitled to such an amended claim 1 in lieu of the original claims 1, 2 and 3 provided that the new claim is precise and clear to this intent, and that the body of the specification is amended so as to bring "the descriptive part of the specification into conformity with the more restricted statement of claim" (*In re Battig's Application* (4)). The much debated word "including" in the proposed amendment indicates to my mind that the ambit of the claim is confined to closing means comprising a sealing extension of the doctor during its reciprocation, but I can see that it is possible that it could be construed as wide enough to include means which omitted this extension. The latter construction is assisted by the references in the specification to the obvious existence of various other means of effectively sealing the offending

(1) (1938) 56 R.P.C., at p. 8.
(2) (1910) 27 R.P.C. 289.

(3) (1934) 51 R.P.C. 241.
(4) (1929) 49 R.P.C. 415, at p. 416.

spaces. It appears to me the insertion of a word such as “ necessary ” or “ always ” before “ including ” would effectively cure the ambiguity, and I am of the opinion that the Court would have power in a proper case to allow such an amendment without further advertisement (*Broadbent v. Davies* (1); *British Acoustic Films Ltd. v. Nettlefold Productions* (2); *Mullard Radio Valve Co. Ltd. v. British Belmont Radio Ltd.* (3)).

But the question remains whether it would be proper to allow the amendment while the body of the specification remains unaltered. The complete specification must fully describe and ascertain the invention. In this description and ascertainment the body of the specification plays an important role, because the function of the claims is to state definitely the invention claimed, and there have been many cases where the inventor has failed to claim the whole of his invention. He must not only discover his gold mine, he must also peg out his claim (*Shave v. H. V. McKay Massey Harris Pty. Ltd.* (4)). If, therefore, an inventor, in the light of further knowledge acquired after the date of his application, has ascertained that some features of his invention which he believed to be novel have been anticipated, and he desires to amend his claims to disclaim those features, it is, in my opinion, essential that he should also amend the body of his specification so as to make it conform to the more limited invention which he now desires to describe and ascertain. A perusal of the English cases shows that it is the practice there to so amend the body of the specification at the same time as the claims are amended: See, for instance, *In re Thomson’s Patent* (5); *British Acoustic Films Ltd., A. Poulsen and A. C. G. Petersen v. Nettlefold Productions* (6); *In re Butherus and British Sangamo Co.’s Patent* (7); *Mullard Radio Valve Co. Ltd. v. British Belmont Radio Ltd.* (8); *In re Miller’s Patent* (9); *Re Airspeed Ltd. and A. H. Tiltman’s Letters Patent* (10). This does not mean that the description must be completely rewritten. Each case must depend upon its own circumstances. In some instances the description might not have to be altered at all. But generally speaking it would not be permissible to amend the claims substantially without at the same time amending the body of the specification.

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(1) (1916) 21 C.L.R. 253, at p. 262. (6) (1936) 53 R.P.C. 221, at p. 246;
(2) (1935) 53 R.P.C. 221, at p. 246. (1937) 54 R.P.C. 267.
(3) (1938) 56 R.P.C. 1. (7) (1938) 56 R.P.C. 139.
(4) (1935) 52 C.L.R. 701. (8) (1938) 55 R.P.C. 197; 56 R.P.C.
(5) (1934) 51 R.P.C. 241. 1.
(9) (1939) 57 R.P.C. 16.
(10) (1940) 57 R.P.C. 313.

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In the present case the body of the specification should be amended by the deletion of all reference to preferred forms, and it should be made clear that only parts of the press are claimed to be new. When this has been done I can see no reason why a fresh application for the amendments now asked, all ambiguity having been removed from the amended claims, should not succeed. As the appellant does not ask for any of the present amendments to be allowed, if the new claim 1 is refused, the others need not be considered.

The appeal and cross-appeal should both be dismissed.

Appeal and cross-appeal dismissed. Appellant to pay costs of appeal of Deputy Commissioner and of respondents in this Court.

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

Solicitors for the respondents, *Waters & Stewart.*

O. J. G.