[HIGH COURT OF AUSTRALIA.]

A.R.C. ENGINEERING COMPANY PROPRIETARY LIMITED . . . . Opponent, } Appellant;

AND

RENDAN HOLDINGS LIMITED . . . Applicant, Respondent.

Patent—"*Convention*" *application*—*Opposition*—*Want of novelty*—*Prior publication*—*British specification for same invention published in Australia before Australian application*—*Patents Act* 1903-1935 (*No.* 21 *of* 1903—*No.* 16 *of* 1935), *ss.* 56 (*e*), (*f*), 121—*Patents, Trade Marks, Designs and Copyright* (*War Powers*) *Act* 1939 (*No.* 66 *of* 1939), *s.* 9.

On an application under s. 121 of the *Patents Act* 1903-1935 for the grant of a patent for an invention in respect of which an application has already been made in another country to which sub-s. 1 of the section applies, sub-s. 2 precludes an opponent from relying on publication or use in Australia between the date of the application in the other country and the date of the application in Australia.

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Melbourne, *Oct.* 13.

Latham C.J., Starke, McTiernan and Williams JJ.

Appeal.

On 18th March 1941 Rendan Holdings Ltd. lodged at the Patents Office an application for a patent for an invention under s. 121 of the *Patents Act* 1903-1935. The applicant had applied in England on 18th January 1939 for a patent for the same invention, and the British specification was published in Australia on 7th November 1940. The Australian application was opposed by A.R.C. Engineering Co. Pty. Ltd. on the grounds of want of novelty and prior publication, the notice of opposition stating that these grounds were based solely on the publication in Australia (after the date of the British application and before the date of the Australian application) of the applicant's British specification. The period of twelve months limited by s. 121 (1) of the *Patents Act* had expired before the Australian application, but the time was extended by the Commissioner under

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s. 9 of the *Patents, Trade Marks, Designs and Copyright (War Powers) Act* 1939. The Commissioner granted the application, and the opponent appealed to the High Court.

Dean, for the appellant. The object of s. 121 is to give priority over other applicants, but the section does not mean that the application is to be granted as of course. It must be dealt with as an ordinary application, and it is open to all the usual objections. It can be opposed on any ground mentioned in s. 56. [He referred to *Frost* on *Patent Law and Practice*, 4th ed. (1912), vol. 2, p. 313; *Romer, Patents and Designs Practice*, 2nd ed. (1926), p. 29.] The reference in s. 56 (*f*) to "the date of the application" can only mean the date of the Australian application: This is borne out by ss. 33 (3), 38, 42 (*b*), 64, 67, 69, 86 (4). If there is no opposition to an application under s. 121 and a patent is granted, then s. 121 (2) applies notwithstanding that there was publication or use before the date of the Australian application, but sub-s. 2 does not apply until the grant has been made. The present case falls within the plain meaning of s. 56, and there is nothing in s. 121 to destroy the effect of the objections.

There was no appearance for the respondent.

Coppel, for the Commissioner of Patents. Section 121 is intended to put the applicant in the same position as if he had applied in Australia by means of, and at the date of, his foreign application (*Re Coutant* (1)). The sole purpose of opposition proceedings is to see that patents which would be obviously bad shall not be allowed to encumber the register (*McGlashan* v. *Rabett* (2), per *O'Connor* J.; *Henry Berry & Co. Pty. Ltd.* v. *Potter* (3)). Sections 33, 54, 56 and 121 must be read together, and the only way in which a sensible coherent meaning can be given to s. 121 is to say that the relevant date to determine novelty or prior publication is the date of the application abroad. Section 121 (2) means that publication or use between the date of the application abroad and the date of the application in Australia shall not prevent the grant of a valid patent; this construction is supported by the provisions of s. 54. [He referred to *In re Brearley's Patent* (4); *Acetylene Illuminating Co.* v. *United Alkali Co.* (5).]

Dean, in reply.

(1) (1928) 48 R.P.C. 1, at pp. 3, 4.
(2) (1909) 9 C.L.R. 223, at p. 229.
(3) (1924) 35 C.L.R. 132, at p. 138.
(4) (1933) V.L.R. 5, at pp. 11, 15, 31.
(5) (1902) 1 Ch. 494.

The following judgments were delivered :—

LATHAM C.J. This is an appeal from a decision of the Commissioner of Patents dismissing opposition to an application for a patent made under s. 121 of the *Patents Act*—what is ordinarily known as a convention application.

The respondent to the appeal was the applicant and the appellant opposed the application upon the ground of prior publication. The grounds stated in the notice of opposition were in the following terms :—" (1) That the invention is not novel. (2) That the invention has been described in a book or other printed publication published in the Commonwealth before the date of the Application or is otherwise in possession of the public. The above grounds are based solely upon the publication in Australia, before the date of the above application, of the British complete specification No. 522,295 (Application date 18th January 1939 No. 1806/39) in the name of the Applicant." The applicant relied upon the British application just mentioned, that application having been made on 18th January 1939. On 7th November 1940 the specification mentioned was published in Australia. The convention application was lodged at the Patents Office on 18th March 1941, so that date became the date of the Australian application.

The opponent therefore relied upon the publication in Australia after the date of the British application and before the date of the Australian application of the applicant's own British specification, which was the foundation of the Australian application.

The period of twelve months referred to in s. 121 (1) had expired before the application was made in Australia, but under the *Patents, Trade Marks, Designs and Copyright (War Powers) Act* 1939, s. 9, an extension of time for making the application under s. 121 was granted by the Commissioner of Patents, and no argument has been addressed to the Court to show that that extension of time was not effective. Indeed, it appears to be quite plain from the terms of the section that the extension of time was quite effective to substitute the extended period for the period of twelve months under s. 121 (1).

Section 121 provides in sub-s. 1 as follows :—" 121.—(1) If the King is pleased by Order in Council to apply section one hundred and three of the Imperial Act called the *Patents Designs and Trade Marks Act* 1883 (or any provision enacted in substitution for that section) to the Commonwealth, then any person who has applied for protection for any invention in the United Kingdom or the Isle of Man, or in any foreign State with the Government of which His Majesty has made an arrangement under the said section for

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mutual protection of inventions or the legal representative or assignee of that person, shall be entitled to a patent for the invention under this Act in priority to other applicants, and such patent shall have the same date as the date of the application in the United Kingdom or the Isle of Man or such foreign State as the case may be :

Provided that such application shall be made within twelve months from such person applying for protection in the United Kingdom or the Isle of Man or the foreign State with which the arrangement is in force :

Provided also that nothing in this section contained shall entitle the patentee to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in the Commonwealth."

Thus this section provides that an application may be made in Australia based upon an application made in another country to which s. 103 of the Imperial Act (the *Patents, Designs, and Trade Marks Act* 1883) has been applied, there being a proviso that the application shall be made within twelve months of the application in the other country.

Section 56 in pars. *e* and *f* provides that when an application is made for a patent opposition may be notified upon the following grounds :—

" (*e*) That the invention is not novel or has been already in possession of the public with the consent or allowance of the inventor ;

(*f*) That the invention has been described in a book or other printed publication published in the Commonwealth before the date of the application or is otherwise in the possession of the public."

The opponent relies upon these grounds. Section 121 (2) provides that :—

" (2.) The publication in the Commonwealth during the respective periods aforesaid of any description of the invention or the use therein during such periods of the invention shall not invalidate the patent which may be granted for the invention."

The question which arises is this :—Are the objections mentioned in s. 56, pars. *e* and *f*, to which I have referred, open upon a convention application when the publication or use relied upon by the opponent is a publication or use in Australia between the application for letters patent in the other country and the date of the application in Australia ?

Section 121 provides that when a patent is granted in pursuance of an application made under this section the patent shall have the same date as the date of the application in the other country. When

any patent is granted it cannot be challenged by reason of any publication of the invention or any use of the invention which is published or made after the date of the patent.

Section 121 (2), which I have already read, refers to " the respective periods aforesaid." It therefore relates to publication or use during certain periods. Those periods must be the two periods mentioned in the immediately preceding proviso. Those periods are, first, the period described in the words " twelve months from such person applying for protection " in the other country. In this case it was an extended period—more than twelve months. The second period is the period " prior to the date of the actual acceptance of his complete specification in the Commonwealth."

Such publication or use—that is, publication or use in these periods—could not after the grant of a patent affect the validity of a patent which bore the date of the beginning of those periods. Therefore in my opinion if the section is to have any operation it must be allowed to have an effect during the periods to which express reference is made in the sub-section. It can have such operation only if it excludes opposition to the grant upon the grounds of the publication or use mentioned in the section. It would have no operation and no effect, in my view, if it were construed so as to apply only after the grant of a patent by providing that publication or use during the period after the date which the patent bore should not affect the validity of the patent. The words I think are capable of the meaning suggested. They are intended to bring about the result that the publication or use mentioned shall not prevent the grant of a valid patent upon an application made under the section.

Reference has been made to the case of *Re Coutant* (1), in which there appears a quotation from a judgment of Sir *John Simon*, as Law Officer, from which I read these words :—" I think s. 91 intends to do nothing more than this. It intends to put the man who is an applicant in a foreign country for protection at a certain date in the same position as though he had applied in this country by an identical application at the same date ", and the Assistant-Comptroller, continuing, used the following words : " This principle of ' presumptive simultaneity,' involving the same treatment of a foreign applicant applying under the International Convention as he would have obtained if he had made a simultaneous and identical application here."

I agree with that view of the section and accordingly, for the reasons which I have stated, in my opinion the appeal should be

(1) (1928) 48 R.P.C. 1.

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dismissed. The respondent has not appeared, and I do not think there should be any order for costs.

STARKE J. I agree.

McTIERNAN J. I agree.

WILLIAMS J. I agree.

Appeal dismissed.

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

Solicitor for the Commissioner of Patents, *H. F. E. Whitlam*, Crown Solicitor for the Commonwealth.

E. F. H.