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[HIGH COURT OF AUSTRALIA.]

SAMUEL TAYLOR PTY. LTD. . . . . APPELLANT ;

DEFENDANT,

AND

S.A. BRUSH COMPANY LIMITED . . . . . RESPONDENT.

PLAINTIFF,

ON APPEAL FROM THE SUPREME COURT OF  
SOUTH AUSTRALIA.

Patent Specification—Sufficiency of description—Improved manufacture of sweeping brush or broom—Manner of performing invention.

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Letters patent were granted in respect of a long bristled sweeping brush or broom of an improved kind, the improvement consisting in the successful arrangement and holding in place of the bristles in lines or tufts in a retaining cement in the broom. The specification of the letters patent stated : “ Accord- ing to this invention, a sweeping broom or brush having long bristles, comprises a wood stock or head, a recess formed in the face of the stock so as to provide a wall or flange integral with the stock or head around the edge of the stock, arranging the bristles, hairs, fibres or mixture with their roots or thick ends at one end, and securing the roots or thick ends of the bristles, hairs, fibres or mixture within the recess by cement, rubber or like filling the recess. The bristles, hairs, fibres, or mixtures may be formed in separate tufts or not as desired, and a perforated plate or gauze may be provided to cover the cement through which the bristles, hairs or fibres or mixture project ”.

*Held*, that the specification was insufficient to enable the invention properly to be carried into effect and the patent was, accordingly, invalid.

Decision of the Supreme Court of South Australia (*Abbott J.* affirmed).

APPEAL from the Supreme Court of South Australia.

Samuel Taylor Pty. Ltd. was the assignee of Australian letters patent No. 106694 in respect of improvements in or connected with brooms, brushes and the like. The specification contained the follow- ing description of the invention to which the patent related :— “ This invention relates to wood-headed sweeping brooms or brushes, in which long bristles, hairs, fibres or mixtures of these are employed,

ADELAIDE,

Sept. 25, 26,

27.

SYDNEY,

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and

Webb JJ.



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and has for its object to improve the construction of such class of brush so as to cheapen the cost of production.

“According to this invention, a sweeping broom or brush having long bristles, comprises a wood stock or head, a recess formed in the face of the stock so as to provide a wall or flange integral with the stock or head around the edge of the stock, arranging the bristles, hairs, fibres or mixture with their roots or thick ends at one end, and securing the roots or thick ends of the bristles, hairs, fibres or mixture within the recess by cement, rubber or like filling the recess. The bristles, hairs, fibres, or mixtures may be formed in separate tufts or not as desired, and a perforated plate or gauze may be provided to cover the cement through which the bristles, hairs or fibres or mixture project”.

S.A. Brush Co. Ltd., having been threatened by Samuel Taylor Pty. Ltd. with legal proceedings in respect of an alleged infringement by it of patent No. 106694 by the manufacture and distribution of a “pure bristle plastic set broom”, commenced an action in the Supreme Court of South Australia against Samuel Taylor Pty. Ltd., in which it alleged groundless threats of legal proceedings within the meaning of s. 91A of the *Patents Act* 1903-1946. The defendant counterclaimed, alleging infringement of the patent by the plaintiff. The plaintiff, in reply, alleged that the patent was invalid on the following grounds: (1) that the alleged invention was not a manner of new manufacture, (2) that the alleged invention was not new at the date of the letters patent, (3) that the alleged invention was not useful or, alternatively, not any improvement on prior methods, (4) that the alleged invention was obvious and did not involve any inventive step, and (5) that the specification was insufficient to enable the alleged invention properly to be carried into effect.

The evidence accepted by the trial judge established that long bristles had always been used for sweeping brooms, that brooms had for many years been made with wood stocks, that in the case of toilet brushes and clothes brushes the practice of forming a recess in the wooden body of the brush was well known, that long bristles were always supplied to broom manufacturers with their roots or thick ends together, and that for some years before the grant of the patent hair brushes and clothes brushes had been made with the bristles or hairs held in position by cement in a recess formed in the body of the brush. But, until the defendant in Australia, and its assignor in England, produced a broom known in Australia as the “Dustmaster”, no one had made a long-bristled broom with the bristles held in position in a recess by cement, either in tufts (as in the “Dustmaster”) or in lines. The



defendant did not disclose, either in the specification or at the trial, how it achieved this result.

The trial judge found that the plaintiff had established the objections that the alleged invention was not a manner of new manufacture and that the specification was insufficient. He, accordingly, held the patent to be invalid and made an order restraining the defendant from threatening legal proceedings for alleged infringement and dismissing the defendant's counterclaim.

From this decision the defendant appealed to the High Court.

*G. E. Barwick* K.C. (with him *K. L. Ward* K.C., and *K. W. Asprey*), for the appellant. The trial judge erred in overlooking that there might be a valid patent, with an improved and secret mechanical technique for producing the article. If a competent workman can manufacture the product from the specification, the specification is sufficient: *No-Fume Ltd. v. Frank Pitchford & Co. Ltd.* (1); *Fox, Canadian Patent Law and Practice*, 3rd ed. (1948), pp. 342, 347, 348-349. Any tradesman could see a method of applying this patent. Insufficiency of description does not destroy the subject-matter: *Fox, Canadian Patent Law and Practice*, pp. 172, 178, 181.

*D. B. Ross* K.C. (with him *S. J. Jacobs*), for the respondent. The finding of insufficiency of description was a finding of fact, and there is evidence to support that finding. The specification did not disclose any method of carrying out the process. It is impossible to gauge the commercial utility of the invention without knowing the secret process. In considering commercial utility, you must look only to the specification. This was at most a discovery, and not an invention. [They referred to *Badische Anilin und Soda Fabrik v. Levinstein* (2); *Atkins v. Castner-Kellner Alkali Co. Ltd.* (3); *Lane-Fox v. Kensington and Knightsbridge Electric Lighting Co. Ltd.* (4); *Paper Sacks Pty. Ltd. v. Cowper* (5); *Willey and Whites Manufacturing Co. Ltd. v. Freeman and Letrik Ltd.* (6); *Willmann v. Petersen* (7); *Schwer v. Fulham* (8).]

*G. E. Barwick* K.C., in reply.

*Cur. adv. vult.*

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| (1) (1935) 52 R.P.C. 231.            | (6) (1931) 48 R.P.C. 405, at pp. 413, 414. |
| (2) (1887) 4 R.P.C. 449.             | (7) (1904) 2 C.L.R. 1, at p. 21.           |
| (3) (1901) 18 R.P.C. 281, at p. 296. | (8) (1910) 11 C.L.R. 249, at p. 254.       |
| (4) (1892) 9 R.P.C. 413.             |  |
| (5) (1935) 53 R.P.C. 31, at p. 53.   |  |



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The following written judgments were delivered:—

LATHAM C.J. The appellant, Samuel Taylor Pty. Ltd., is the assignee of Australian letters patent No. 106694 in respect of improvements in or connected with brooms, brushes and the like. The company threatened proceedings against the respondent, S.A. Brush Company Ltd., for infringement of the patent. The latter company then took proceedings for alleged groundless threats of legal proceedings under s. 91A of the *Patents Act* 1903-1946. The appellant counterclaimed, alleging infringement of the patent, and the respondent in reply alleged that the patent was invalid, raising most of the objections to the validity of a patent, namely, not a manner of new manufacture, not new, prior publication, not useful, no improvement, no invention, specification insufficient to enable the alleged invention properly to be carried into effect. In the Supreme Court of South Australia Abbott J. held against these objections except in relation to the first objection, which was that the subject matter of the patent was not a manner of new manufacture, and the last objection based on insufficiency of directions in the specification to enable the alleged invention to be carried into effect. The appellant appeals to this Court, contending that the patent is valid. The respondent has repeated in this Court and supported by argument most of the objections to the patent which were taken in the Supreme Court.

The patentees in Great Britain were Beechwood Ltd. and E. A. Woodcock. The patent was granted in Australia under s. 121 of the *Patents Act* 1903-1921. The complete specification stated that the invention related to “wood-headed sweeping brooms or brushes, in which long bristles, hairs, fibres or mixture of these are employed, and has for its object to improve the construction of such class of brush so as to cheapen the cost of production”. The evidence showed that brooms had, since time immemorial, been made by inserting bound tufts of bristles or hair &c. into holes bored in wooden stocks or heads, the tufts being held in position by being forced into the holes and by the use of some cement or other sticky material. The invention claimed relates to a broom having the following characteristics—(1) long bristles as distinct from short bristles; (2) a wood stock or head; (3) a recess formed in the stock; (4) arranging the bristles, &c. with their roots or thick ends at one end; (5) securing the roots or thick ends of the bristles, &c. within the recess by cement, rubber or like filling the recess; (6) it was stated that the bristles &c. might be formed into separate tufts or not (e.g. they might be arranged in rows) as desired.



The evidence which was accepted by the learned trial judge showed that sweeping brooms had always necessarily been made with long bristles. There is a distinction between a brush used for brushing and a broom used for sweeping; a broom must have long bristles, hairs or fibres. It is common knowledge that brooms have been made for many years with wood stocks. The evidence as to toilet brushes and clothes brushes showed that the practice of forming a recess in the wooden body of the brush was well known. The evidence also showed that long bristles, which were much better than hairs for brooms, were always supplied to broom manufacturers with their roots or thick ends together and that those ends were always placed in the stock so that the flag end was used in contact with the surface which was being swept, the flag end being split to some degree and being much better adapted to sweeping than the thick end. The evidence, particularly the evidence as to Hinde's brushes, was that for some years before the grant of the patent hair brushes and clothes brushes had been made with the bristles or hairs held in position by cement in a recess formed in the body of the brush, but that no broom had ever been made with the bristles held in position by cement either in tufts or in lines. There were practical difficulties which had prevented the manufacture of a long bristled broom of this type until the patentees in England and the appellant, the assignee to the patent in Australia, produced a broom which is known in Australia as the "Dustmaster". This broom satisfies the description of the broom described in the patent and has been a great commercial success. The bristles of this broom are long, as in the case of all brooms, and are set in cement in tufts, the cement being a phenol formaldehyde cement which became commonly known not long before the application for the patent in 1936. The respondent, the plaintiff in the action, has in recent years made a broom known as the "Sweepiest" broom, in which the hairs are set in cement contained within a recess in a wooden stock arranged in tufts round the outside but in lines on the inside of the head of the broom. The respondent's experts have not yet been able to solve the problem of arranging the hair in tufts in cement in a broom, but it is not disputed that the respondent has infringed the patent.

All the evidence shows that these brooms, and in particular the "Dustmaster", the defendant's broom, are a great improvement upon their predecessors and that they can be made more cheaply than the former hand-made or pan set broom with the tufts forced into holes in the stock and held in position by cement. The defendant claims that a broom made in accordance with the invention is an

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improvement upon former brooms by reason of various features. Bristles, particularly in recent years, are expensive, and a broom made in accordance with the invention is successful and effective with a smaller quantity of bristles than the older style of broom. It was further argued that about half an inch of bristle or more had to be held in position within the holes in the wooden stock, whereas three-sixteenths of an inch of bristle only had to be held in the cement. This, however, is not an advantage mentioned in the specification, and the drawings attached to the specification show that the depth of the recess might be as large as half the depth of the wooden stock. Accordingly this saving of length of bristles, which makes possible the utilization of shorter and cheaper bristles than would otherwise be the case, is not an advantage which is either disclosed or claimed in respect of the alleged invention.

It is not necessary to examine all the objections to the patent. It is plain that the broom described is a manufacture. The evidence also shows that it is useful in that it is an improvement in the product, viz. the broom manufactured. The question as to whether any invention in the sense of ingenuity was required for the purpose of making the improvement can be determined only after the invention as described in the specification has been accurately described.

The invention claimed is not a claim for a process. No process of manufacture is described. It is a claim for a product—a broom head which possesses certain characteristics—long bristles set in a recess with their root ends inward, the recess containing cement, the bristles arranged either in tufts or otherwise. As already stated, all the features mentioned were well known except that long bristles had not successfully been set in cement. The specification gives no direction as to how to bring about the improved result which it describes. It is contended for the defendant that the description of the broom in the specification is such that a competent workman would be able with the use of ordinary skill to make a broom according to the specification. Much evidence was given upon this aspect of the case. It appeared that when the plaintiff company was in treaty with one of the patentees in England for an assignment of the patent the patentee informed it that the patent itself was not very important. It was the secret technique of manufacture which was important and it was stated by the patentee that if the plaintiff company knew this technique they ought not to be greatly concerned if the application for the grant of the patent in Australia should fail. The witnesses for the defendant, when giving evidence, refused to disclose the method so successfully adopted by the defendant for making the “Dustmaster” broom. It was suggested by these



witnesses that any workman could make a broom in accordance with the specification by arranging bristles between cardboard or other slips with the ends projecting, holding the cardboard slips with the interposed bristles in position by some means and merely inserting the ends of the contained bristles into waiting cement in a recess. The learned trial judge was not satisfied that an effective broom with the necessary splayed ends and edges could be so manufactured, and there is no evidence that such means were practical or that they would in any circumstances, to use the words of the specification, “improve the construction of the brooms” so as to “cheapen the cost of production”. The method suggested by the defendant’s witnesses as obvious to a skilled workman would not, as one of the plaintiff’s witnesses said, produce anything that could be called a broom “if one wishes to sell it.”


The evidence for the plaintiff was to the effect that persons who were expert in broom manufacturing had conducted a long series of experiments in order to produce a broom with bristles held in position by cement, that they had not succeeded in producing such a broom with all the bristles set in tufts, but that they had, but only after many experiments, produced the “Sweepiest” broom which, however, had the internal bristles arranged in rows. The learned trial judge accepted this evidence and accordingly held that the patent was invalid because the specification was insufficient to enable the invention properly to be carried into effect.

In my opinion his Honour’s decision was correct. It was objected that his Honour had held against the defendant because the defendant had not disclosed the best and effective technique which it has been using for some years in the manufacture of the “Dust-master” broom, and it was pointed out that there was no evidence that the defendant or the patentees who were the assignors to the defendant had been aware of such a method when the patent was granted in Great Britain in 1936. There was no such evidence and I am of opinion that it should not be held that the patent is invalid on the ground that the invention did not disclose the best method of carrying it into effect. The objection which in my opinion is fatal to the patent is that no method whatever of carrying out the invention is disclosed by the specification. A result is disclosed. The description of the result does not provide, expressly or impliedly, to a skilled workman any information as to a method of carrying out the invention. Even now no persons other than those employed by the defendant have been able to arrange bristles in tufts in cement in a broom. The specification contains the statement that “the bristles, hairs, fibres or mixtures may be formed into separate

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tufts or not as desired". There is no indication whatever as to how this is to be done so as to hold them in position in a recess filled with cement.

I am therefore of opinion that the patent is invalid upon the ground that the specification is insufficient to enable the invention properly to be carried into effect and that therefore the appeal should be dismissed

MCTIERNAN J. I agree that the appeal should be dismissed

The invention which is the subject of this case is a sweeping brush or broom of an improved type. Its wood stock or head with a recess is commonplace. The leading characteristic is the length of the bristles. The inventive step is that the bristles are secured by cement, rubber or other retaining agent poured into the recess, the roots or thick ends of the bristles being put singly or in tufts in the retaining agent in the recess. In regard to the manner of doing both these things the specification says only this: "arranging the bristles, hairs, fibres or mixture with their roots or thick ends at one end, and securing the roots or thick ends of the bristles, hairs, fibres or mixture within the recess by cement, rubber or like filling the recess".

One of the objections made by the respondents to the letters patent for the invention was in these terms: "That the Specification of the Letters Patent is insufficient to enable the alleged invention properly to be carried into effect in that 'no sufficient directions are given for the manner means or method whereby the hairs are caused to fill the recess or arranged to all lie in one direction, or whereby the roots are inserted into cement filled into the recess, or whereby the hairs can be arranged in tufts and the roots of the hairs forming the tufts are secured by cement in the recess at distances apart, or whereby the hairs can be arranged in rows in the cement'."

*Abbott J.* upheld this objection. His Honour applied the principles by which *Lindley L.J.* in *Edison & Swan Electric Light Co. v. Holland* (1), said that the question of the sufficiency of a specification should be determined. In that case Lord *Lindley* said: "On the one hand, the Patentee must make the nature of his invention, and how to perform it, clear and intelligible; on the other hand, it is not necessary for him to instruct persons wholly ignorant of the subject-matter to which his invention relates, in all that they must know before they can understand what he is talking about. The



Patentee is adding something to what was known before, and he does all that is necessary as regards the language he uses, if he makes the nature of his invention, and how to perform it, clear and intelligible to persons having a reasonably competent knowledge of what was known before on the subject to which his patent relates, and having reasonably competent skill in the practical mode of doing what was then known. In complying with the first condition, i.e., in describing the nature of his invention, the Patentee does all that is necessary, if he makes the nature of his invention plain to persons having a reasonably competent knowledge of the subject, although from want of skill they could not themselves practically carry out the invention. In complying with the second condition i.e., in describing in what manner the invention is to be performed, the Patentee does all that is necessary, if he makes it plain to persons having reasonable skill in doing such things as have to be done in order to work the patent, what they are to do in order to perform his invention. If, as may happen, they are to do something the like of which has never been done before, he must tell them how to do it, if a reasonably competent workman would not himself see how to do it on reading the Specification, or on having it read to him. The principle to be applied to the language used to comply with the two conditions is the same for both; but one class of persons may understand only one part of the Specification and another class only the other, and yet the patent may be valid. In a well drawn Specification, the two conditions that have to be complied with are kept distinct; but in many Specifications this course is not pursued. The nature of the invention and the manner of performing it are often described together”.

In regard to the present specification *Abbott J.* very correctly said: “It seems to me that the Specification of the defendant’s patent describes with crystal clarity the nature of the invention, but fails entirely to describe the manner of performing it.” There was no known practical method of doing the things that constituted the inventive step.

His Honour made this finding: “I am satisfied that the inventors discovered not only a broom, the nature of which they have disclosed, but also a manner of manufacturing it, which they not only have not disclosed, but which they have intentionally avoided disclosing, so as to keep it secret”.

The specification does not convey to persons of reasonable skill in the trade what they are to do in order to make a sweeping brush or broom with long bristles secured by setting their root ends in cement, rubber or other retaining agent in a recess in its stock.

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In my opinion the learned trial judge was right in upholding the objection that the specification was insufficient.

WEBB J. I agree with the judgment of the Chief Justice and have little to add.

The appellant company is the assignee of a patent granted in England and accepted and advertised in Australia. It claims that the assignor discovered that the root end of bristles would be held firmly by cement rubber or the like in a recess as shallow as three-sixteenths of an inch. This fact, it claims, was not known generally, or at all, although the flag ends of bristles were usually, if not invariably, made the sweeping surface of brooms and brushes, and bristles were sold in bundles with the root ends together. It is claimed that broom manufacturers, being ignorant that the root ends would be firmly retained in so shallow a depth of cement rubber or like material, used much more of the bristle than was necessary to attach it to the broom head, or paid penalty rates to operatives, who had to spend more time when less bristle was used in so doing; and, further, that much time was spent in making holes into which the root ends were pressed in tufts and there held by glue or like material and by transverse pressure. However, the mere discovery that root ends could be held in cement rubber or like material only three-sixteenths of an inch deep could not itself be the subject of a patent: it had to be applied in a way that would render such application an inventive step of some utility. It was applied to the making of the appellant company's "Dustmaster" broom. Labour and material were saved and cost of production reduced. The "Dustmaster" was a commercial success; although this appears to have been due largely to a secret process for positioning the bristles as desired. But assuming all these claims to be well-founded, the complete specification does not state, and the drawings that are part of it do not indicate, that the root ends are to be placed in cement rubber or like material of any particular depth. The specification states that the width of the wall or flange of the recess is narrow, but nothing is said about its depth. So the inventive step for which we are told the patent was secured is not revealed. Even a skilled worker kept in ignorance of the inventive step would be likely to continue to use as much of the bristles as before, and to spend as much time in affixing them to the broom head. Nothing new was revealed. Apart from the capacity of root ends to hold fast in three-sixteenths of an inch of cement rubber or like material there was nothing new to reveal, except the method of positioning the bristles. A stock



with recess containing cement rubber or the like for holding bristles was already in use in brushes, but the composition of the cement rubber or like material was a secret and templates and other mechanical contrivances were employed in positioning the bristles.

I would dismiss the appeal.

*Appeal dismissed with costs.*

Solicitors for the appellant: *Baker, McEwin, Millhouse and Wright.*

Solicitors for the respondent: *Stevens, Rymill, Boucaut and Jacobs.*

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