[HIGH COURT OF AUSTRALIA.]

IN RE DEL-MAC SHOE PROCESS CORPORATION'S PATENT.

H. C. OF A. 1950.

MELBOURNE, *Nov.* 1; SYDNEY, *Nov.* 16.

Fullagar J.

Patent—Power of Court to extend term—Application by petition—Condition precedent—Advertisement "in the prescribed manner"—Manner prescribed by regulations—Application by originating summons under s. 84 (6) *of Act—Practice of court to require compliance with regulations—Power of court to dispense with requirements of practice—Power of Commissioner of Patents to dispense with requirements of regulations—Patents Act* 1903-1946 (*No.* 21 *of* 1903—*No.* 38 *of* 1946), *ss.* 84 (1), (6), 108—*Patents Regulations, regs.* 134, 151—*High Court Rules, O. LIII., r.* 6.

It is a condition precedent to an application by petition under s. 84 (1) of the *Patents Act* 1903-1946 for extension of the term of a patent that the matter be advertised "in the prescribed manner," that is, as prescribed in respect of applications by petition by reg. 134 of the regulations under the Act, and the High Court has no power to dispense with compliance with the condition, but this is not so in the case of an application made by originating summons under s. 84 (6) of the Act; although it has been the practice of the High Court to require compliance with reg. 134 in such cases, it is—so far as applications by originating summons are concerned—a matter of practice only, and the Court has power to relax the exigencies of the rule of practice in individual cases where special circumstances exist.

Semble: Regulation 151 of the Regulations under the Act, which gives the Commissioner of Patents power to dispense with the requirements of the regulations, applies only to proceedings before the Commissioner and to matters which are under his control by virtue of the Act; if, as a matter of construction, it applies to proceedings under s. 84 of the Act, it is, to the extent to which it so applies, ultra vires: *Re Bradford's Patent* (1928) 2 A.L.J. 320, doubted on this point.

In re Cameron's Patent (1928) 42 C.L.R. 66, referred to.

ORIGINATING SUMMONS under the *Patents Act* 1903-1946, s. 84 (6).

This was an application by originating summons by Del-Mac Shoe Process Corporation for the extension of the term of letters patent under s. 84 (6) of the *Patents Act* 1903-1946. It appeared

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that the application had not been preceded by an advertisement at the time prescribed (in respect of applications by petition) by reg. 134 of the regulations under the Act; if that regulation applied, the application had been made too soon after the publication of the last advertisement. It was contended on behalf of the applicant that reg. 134 did not apply; that, although it had been the practice of the court to require compliance with reg. 134 on applications by originating summons under s. 84 (6), it was merely a rule of practice and the Court had power to dispense with compliance with it.

G. A. Pape, for the applicant.

W. H. Tredinnick, for the Commissioner of Patents.

Cur. adv. vult.

Nov. 16.

FULLAGAR J. delivered the following judgment:—

In this case a preliminary point arose with which I dealt at the hearing. The point is, however, of some importance, and I have reconsidered it and have looked at certain authorities which were cited to me by counsel. As a result I adhere to the view which I expressed, but I think it perhaps better to restate it.

Regulation 134 of the *Patents Regulations* provides that "A patentee (hereinafter called the petitioner) intending to apply by petition to the High Court . . . for an extension of the term of his patent under section 84 of the Act, shall give public notice", by means of certain advertisements which are specified. What follows clearly implies, I think, that one month must elapse between the publication of the last advertisement and the issue of the petition. Regulation 134 refers only to petitions, and does not in terms cover applications under sub-s. (6) of s. 84, which are commenced by originating summons. The practice, however, has been to require compliance with the provisions of reg. 134 whether the application is made by petition or originating summons. The practice is, I think, of long standing.

The position in the present case is that the last advertisement was published on 1st September 1949 and the originating summons was issued on 30th September 1949. It was thus probably two days too early. It was at least one day too early. This position was very properly brought to my attention by Mr. *Pape*. The defect appears to have been due, not, as so often happens, to dilatoriness, but to precipitancy, and I think that it was satis-

factorily explained by the affidavits. Advertisement in the prescribed manner is, I think, a condition precedent to the right of a patentee to apply for an extension of the term of letters patent, and *Starke* J. so held in *Re Cameron's Patent* (1). That was a case of an application by petition under s. 84 (1). Regulation 134 had not been strictly complied with. On objection being taken *Starke* J. dismissed the application.

Mr. *Pape* suggested first that I had power to enlarge or abridge the time under Order LIII, r. 6, of the Rules of the High Court. Regulation 134, however, is not a rule of court or an order of the court. It is a regulation made by the Governor-General under s. 108 of the Act, and I have no power to enlarge or abridge any time fixed by those regulations. Such an order was made in *In re J. & T. M. Greeves Ltd. and Eve's Letters Patent* (2), but the rules in question there were rules of court.

Mr. *Pape* then referred me to reg. 151, which provides that, where under the regulations any person is required to do any act or thing, and it is shown to the satisfaction of the Commissioner that from any reasonable cause that person is unable to comply with the requirement, the Commissioner may, subject to such terms as he thinks fit, dispense with the requirement. Mr. *Pape* said that there was reason for believing that the Commissioner would in this case dispense with the requirement in question, and he asked me, if necessary, for a short adjournment to enable him to obtain the dispensation.

In *Re Bradford's Patent* (3) there was an application by petition under s. 84 (1). The Commissioner had purported to dispense under reg. 151 with one of the advertisements required by reg. 134, and *Isaacs* J. gave effect to the dispensation. The objection of non-compliance was taken as a preliminary objection by certain companies which appeared for the purpose of opposing the extension, but it does not appear whether argument was directed to the applicability or validity of reg. 151. There is also an unreported case—*Re Willmotts Ltd.'s Patent* in 1947—to which Mr. *Pape* referred me. This was a case of an originating summons under s. 84 (6). It came before *Starke* J., who appears to have acted upon the same view as *Isaacs* J., but again there is nothing to indicate whether or not any argument took place on the subject. It is unnecessary for me to decide whether I ought to follow *Isaacs* J. in *Re Bradford's Patent* (3), but I feel bound to say that I feel grave doubt as to the correctness of the view which his Honour

(1) (1928) 42 C.L.R. 66.
(2) (1943) 61 R.P.C. 19.
(3) (1928) 2 A.L.J. 320.

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appears to have taken. I am strongly disposed to think that reg. 151 applies, as a matter of construction, only to proceedings before the Commissioner and to matters which are under the control of the Commissioner by virtue of the Act. Where a statutory jurisdiction is given to a court, one would not expect any dispensing power to be given to anybody outside the court. I am also strongly disposed to think that, if the regulation is, as a matter of construction, to be construed as applying to proceedings for extension under sec. 84 of the Act, it is, to the extent to which it so applies, ultra vires. The power to grant an extension is given to the Court, and "advertising in the prescribed manner" is a statutory condition precedent to the Court's jurisdiction to grant an extension: see *Re Cameron's Patent* (1). The power to make regulations as to advertising is given by the combined operation of s. 108 and s. 84 (1), and I would not myself think that it extended beyond prescribing the mode and time and form of advertisement to be required. A power to dispense with performance of what is prescribed with respect to advertising must be in effect a power to dispense with the requirements of the Act itself, and clearly no regulation can do that unless specifically authorized by the Act itself.

I think, nevertheless, that I can overcome Mr. *Pape's* difficulty for him, as I am willing to do if I can. The application here is not by petition under s. 84 (1) but by originating summons under s. 84 (6). I think that the language of s. 84 (6), which enables an application to be made by originating summons in certain circumstances "instead of" by petition, is such as to import the condition of "advertising in the prescribed manner" which is imposed by s. 84 (1) on applications made by petition. But I do not think that that language has the effect of importing a condition which is expressly made applicable by reg. 134 only to cases where the application is made by petition. I feel some doubt about this. I feel that the view which I have expressed depends on an accident. If the words "by petition" had been omitted from reg. 134, I think the position would be different. But, on the whole, I think that the view which I have expressed is the correct view. The result is that an application by originating summons under s. 84 (6) must be made "after advertising in the prescribed manner", but there has been no relevant prescription of a manner of advertising. I think that this view has been taken by some at least of the justices of this Court, and that the true position is that a practice has grown up of requiring, when the

(1) (1928) 42 C.L.R. 66.

application is by originating summons under s. 84 (6), the same advertisements to be given and the same times to be observed as are peremptorily required by reg. 134 when the application is made by petition under s. 84 (1). The Court has, of course, clearly power to require notice of the application for extension to be given to the public or to interested persons by advertisement or in any other manner it thinks fit. It has chosen to require the same advertisements as are prescribed by reg. 134. But, so far as applications by originating summons are concerned, it is a matter of practice only, and there is power to relax the exigencies of the rule of practice in individual cases where special circumstances exist. In this case I think that I am justified in excusing strict compliance with the rule of practice, and I think that the proper form for my order to take is that which I intimated at the hearing, when I said that I would give leave to the applicant to proceed notwithstanding non-compliance with the requirements of reg. 134.

With regard to the merits of the case I have not felt any real difficulty. The two patents in question expired respectively on 17th February 1950 and 4th April 1950. I consider war loss to be proved. The figures show that substantial profits during the war were made in Great Britain, United States and Canada, but I do not think that they show a war gain in those countries. The applicant suggests that an extension for two years would be reasonable, and the commissioner does not suggest that such an extension would be unreasonable. I will grant an extension for two years of the term of each patent, the extended period to run in each case from the date of expiry of the earlier patent, 17th February 1950. The order which I make is, therefore, as follows :— Leave to applicant to proceed with application notwithstanding non-compliance with reg. 134. Order that the two applications be consolidated pursuant to Order XLV., rule 1, and heard together. Grant extension of term of each patent for two years from 17th February 1950. Order that applicant pay the Commissioner's costs. Since a re-grant will be necessary in each case, the order will be in what has come to be known as the Celotex form.

Order accordingly.

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

Solicitor for the Commissioner of Patents, *K. C. Waugh*, Crown Solicitor for the Commonwealth.

E. F. H.