[HIGH COURT OF AUSTRALIA.]

LONGWORTH . . . . . APPELLANT;
PLAINTIFF,

AND

EMERTON . . . . . RESPONDENT.
DEFENDANT,

ON APPEAL FROM THE SUPREME COURT OF NEW SOUTH WALES.

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SYDNEY, *July* 23-25; *Aug.* 3.

Dixon, McTiernan and Kitto JJ.

Patent—Application—Prior user—Prior publication—Experiments—Exhibition and tests of invention—Validity of patent—Patents Act 1903-1946 (*No.* 21 *of* 1903 —*No.* 38 *of* 1946), *s.* 124*.

A patent for an invention is void if the invention is practised openly or made known publicly before the making of the application for the patent. This principle is subject to the qualification that an experimental user consisting only of acts reasonably necessary to produce the result embodied in the specification will not be held to amount to a public user invalidating the patent.

In re Newall and Elliot and Glass, (1858) 4 C.B. (N.S.) 269 [140 E.R. 1087], explained.

Nature of the protection afforded by s. 124 of the *Patents Act* 1903-1946 discussed.

Decision of the Supreme Court of New South Wales (Roper C.J. in Eq.) affirmed.

APPEAL from the Supreme Court of New South Wales.

In a suit commenced in the equitable jurisdiction of the Supreme Court of New South Wales, the plaintiff, Francis Lachlan Longworth, sought, *inter alia*, an injunction restraining Harold Silverton

* Section 124 of the *Patents Act* 1903-1946 provides:—"The fact that an invention has been exhibited or tested either publicly or privately shall not in itself be deemed a ground for refusing a patent. Provided that any public exhibition or testing must have been within one year of the date of the inventor lodging his application for a patent."

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Emerton, from infringing certain letters patent during their continuance and any extension thereof.

The plaintiff alleged that at all material times he was the registered proprietor and legal owner of the letters patent for "a seed collecting machine with an attending contrivance for affixing to an operating vehicle particularly for paspalum dilatatum seed", dated 4th October 1935. The plaintiff further alleged that in March 1948 he instituted a suit in equity in the Supreme Court of New South Wales against one Allan Noel Mackay, of Moorland, near Taree, New South Wales, in respect of an infringement of the patent, and that on 28th July 1949 the Chief Judge in Equity made, *inter alia*, an order restraining Mackay, his servants, agents and workmen from infringing the letters patent, and certified, pursuant to s. 91 of the *Patents Act*, that claims 2, 3 and 4 of the letters patent were in issue. In his amended particulars of breaches the plaintiff alleged that the defendant had, in the district of Taree, made, in the season 1948-1949, and used in that season and on 9th February 1950, a machine embodying the invention claimed in the complete specification of the patent in issue.

The defendant denied the validity of the letters patent and said that they were not of any force or effect for reasons appearing in his particulars of objection. He admitted that he had used a machine, but said it had been so used by him to the knowledge of the plaintiff for a long time prior to the institution of the suit and with full knowledge thereof the plaintiff had stood by and acquiesced in that user, knowing full well that the defendant was thereby incurring expense. The defendant denied any infringement or intention to infringe the letters patent and did not admit that by reason of infringements the plaintiff had suffered loss and damage.

The particulars of objections upon which the defendant relied in support of his defence were: (1) that the plaintiff was not the first and true inventor of the alleged invention, such true inventor being one Andrew George Gill; and (2) that the alleged invention was not new at the date of the letters patent. In support of the second objection the plaintiff relied on public user prior to the date of application for the letters patent, and set out the following particulars of such user: (a) by the plaintiff, his servants and agents in the years 1931, 1932, 1933, 1934 and 1935, at various places including Newty Lee's farm, Alex. Perrett's farm, and Henry John Elliott's farm; (b) by Henry John Elliott of Ghinni, near Taree, his servants and agents, in the years 1933, 1934 and 1935, at various places; (c) by one Smith, at that

time an employee of Elliott, in the years 1934 and 1935, at the farm then occupied by Elliott at Ghinni; (d) by Roy James Carle and Mervyn Eric Carle in the year 1935, at the farm then occupied by Elliott at Ghinni, and on the neighbouring farm then occupied by Thomas Campbell Roulstone; (e) by George Gill prior to 1932 at the farm then occupied by him at Coopernook adjoining the plaintiff's farm, and in Dave Hogg's paddock and elsewhere in the area; (f) by public use of machines for seed gathering constructed substantially in accordance with the invention prior to the date of the letters patent, it being claimed that a machine of this type was inspected by the plaintiff at Coopernook, in connection with the suit against Mackay mentioned above. The defendant also objected that there had been prior publication of the alleged invention by deposit in the Patents Office library, Canberra, of eight specifications published from 10th October 1905 onwards, and by publication in a trade catalogue prior to 1935. He further objected that the alleged invention was not the proper subject matter for valid letters patent by reason of the common and public knowledge existing at the date of the letters patent.

The evidence as to the prior user given at the hearing showed that in March 1934 the plaintiff made a seed collector which he used during that year for the purpose of collecting seed on three different farms, and on five or six days he used it successfully. The machine embodied all the features claimed in the letters patent and was made to specifications which subsequently became the specifications in the patent. In 1935 the plaintiff used it again on a number of farms for the purpose of collecting seed, and he also built another machine to the same size and pattern, and a third machine of the same pattern but of half the size. The plaintiff himself used one of the larger machines with an employee, and his brother, who was also in his employ, and another employee used the second of the larger machines. Sometimes these two machines were being worked simultaneously in different paddocks. The owners of the paddocks which were worked were approached by the plaintiff; in many cases they saw the machine and saw it in operation. They were paid a royalty on the seed collected, which was profitably sold by the plaintiff. This state of things continued substantially throughout the paspalum season, which lasts from late summer to the end of autumn. The small machine was placed by the plaintiff in the possession of Elliott, his brother-in-law, for Elliott to try out on his farm by attaching it to a horse-drawn sled. Elliott did so on one day. In addition, during Elliott's absence from his farm, an employee of his named Carle used the

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machine on a neighbouring farm and had the assistance of his cousin, whom he employed. This user was successful although troubles were encountered and breakages occurred. A Mr. McDonald on one occasion assisted Carle in effecting repairs to the machine. It appeared in the evidence that the plaintiff frequently altered components of the machine in an endeavour to improve it in operation.

Roper C.J. in Eq. held that it was impossible to regard the 1935 user as experimental or as a test and thus protected by s. 124 of the *Patents Act*. His Honour also held that the user proved was user of a machine the utility of which had already been established, at all events in 1934, and was a user which invalidated the patent. He accordingly dismissed the suit.

From that decision the plaintiff appealed to the High Court.

G. E. Barwick K.C. (with him *G. B. Thomas* and *N. C. L. Nelson*), for the appellant. The various users of the "seed collecting machine" by the appellant, the inventor, were not, in the circumstances, prior user. The reference by *Roper* C.J. in Eq. to *In re Newall and Elliot* (1) shows clearly that the judgment appealed from envisages "prior commercial user" as the ground of invalidity. That ground can only invalidate a patent when the use "for profit" is subsequent to the inventor having "already ascertained by previous experiment that the invention is useful" (*In re Newall and Elliot* (2)). That usefulness means usefulness in the commercial sense, or practical utility. The word employed is "useful", not "successful". The purpose for which it is useful can only be determined by considering the problem tackled by the new invention, the nature of the invention, and the result expected from that invention before it can be said to be useful. Prior to 1935 a harvester had to choose between quality and quantity. The object of the invention was to secure the advantages of both prior methods, namely, quality and quantity. The machine required by the inventor was one which would harvest high quality seed of such quantity that the return would more than offset the extra cost of machine, petrol and labour. In order to determine whether the machine was likely to be successful commercially it is obvious that a few tests would not be sufficient. That the various users of the machine mentioned in the evidence were merely experiments and tests is clearly shown by the shortness of the time taken, the smallness

(1) (1858) 4 C.B. (N.S.) 269 [140 E.R. 1087].

(2) (1858) 4 C.B. (N.S.), at pp. 288, 289 [140 E.R., at p. 1095].

of the areas treated, and, in some cases, the unsatisfactory results, the cause or causes of which were remedied. The judge applied the wrong test to determine success. The mere fact that some seed was obtained on the occasion of every user of the machine does not establish that the invention was satisfactory. The evidence shows that the work done in 1934 would not have been on a profit basis. The users were legitimate experimental users: *Halsbury's Laws of England*, 2nd ed., vol. 24, p. 617, par. 1164. More scope is allowed to the inventor than to others (*Westley* v. *Tolley, Sons and Bostock* (1)). The objection of "public user" is not the same as "commercial user" (*Strachan and Henshaw* v. *Packet Ltd.* (2)). "Commercial user" is not the same issue as "prior user", nor is the objection of "public user" the same as "prior user". The objection of "commercial user", as meant by the judgment, raises a different issue from that raised by "public user" as pleaded by the respondent. "Commercial user" refers to user either in public or private, the issue being: Was such alleged "commercial user" necessary in all the circumstances of the case, that is to say, was it necessary experimentation? Only when all factors are considered is an inventor able to say whether or not the invention is a success. The use of the machine was not a commercial user but was a mere experiment although the product was sold (*Fellows* v. *Brookes* (3)). The sale of the goods made by the machine did not publish the machine: see *Re the Stahlwerk Becker Aktiengesellschaft* (4). There was not any unnecessary publication of the invention before the date of the application for letters patent.

G. Wallace K.C. (with him *N. H. Bowen*), for the respondent. There was nothing irregular in the course of the hearing before *Roper* C.J. in Eq. The respondent succeeded on an issue which was really one of fact, that is to say, whether the prior use and publication of the machine by the inventor went beyond the field of experiment. There was abundent evidence to justify the judge's finding on this issue. The inventor of a machine must take the greatest care to ensure that his invention is not disclosed by use in public prior to his application for a patent if he is to obtain a valid patent. Unavoidable disclosure to assistants or others under a bond of secrecy or in a relationship of confidence is permitted (*Humpherson* v. *Syer* (5); *Gramophone Co. Ltd.* v. *Ruhl* (6)).

(1) (1894) 11 R.P.C. 602, at p. 607.
(2) (1949) 66 R.P.C. 49, at pp. 55, 56.
(3) (1909) 27 R.P.C. 89, at p. 102.
(4) (1917) 35 R.P.C. 81, at p. 89.
(5) (1887) 4 R.P.C. 407.
(6) (1910) 27 R.P.C. 629, on appeal (1910) 28 R.P.C. 20.

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This permitted disclosure may extend to an experiment in public where this is unavoidably necessary (*In re Newall and Elliot and Glass* (1)). In the present case the use in public went far beyond what was unavoidably necessary. It amounted rather to public use on a commercial scale. In any case *In re Newall and Elliot and Glass* (1) was a special case on its facts and the decision goes further than any other case in cutting down the principle that public use invalidates. The Court will not extend the decision *In re Newall and Elliot and Glass* (1). The specifications and claims are void for ambiguity. Alternatively, the claims are covetous and reveal no inventive step. The " attendant contrivance " is not novel and yet is an integral part of the claim (*Natural Color Kinematograph Co. Ltd.* v. *Bioschemes Ltd.* (2); *Walker* v. *Alemite Corporation* (3); *Shave* v. *H. V. McKay Massey Harris Pty. Ltd.* (4); *In re Poulton's Patent* (5); *Halsbury's Laws of England*, 2nd ed., vol. 24, p. 616, note (b); *Terrell*, 8th ed., p. 88). Section 124 of the *Patents Act* 1903-1946 on its true construction is in the respondent's favour in that it qualifies the position at common law. Formerly any test or exhibition in public or in private invalidated unless the person to whom the invention was exhibited was under a bond of secrecy or confidence. The words " in itself " in s. 124 permit other factors to break down the exception given by the section. Here the invention was used on a commercial scale. Section 124 must be read in the light of s. 6 of the Statute of Monopolies. The section is only intended to be a guide when the question of a grant is being considered (*Paper Sacks Pty. Ltd.* v. *Cowper* (6), per *Starke* J.).

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

Cur. adv. vult.

Aug. 3.

The Court delivered the following written judgment.

This is an appeal from a decree made by *Roper* C.J. in Eq. in a suit for infringement of a patent. His Honour dismissed the suit on the ground that before the application for the patent the plaintiff, that is the patentee, had made his invention public by user. The validity of the patent was put in issue on other grounds also. But the same patent had come before his Honour in a previous suit against another defendant and on that occasion his Honour had upheld the validity of the patent and given a certificate of validity.

(1) (1858) 4 C.B. (N.S.) 269 [140 E.R. 1087].
(2) (1915) 32 R.P.C. 256.
(3) (1933) 49 C.L.R. 643.
(4) (1935) 52 C.L.R. 701.
(5) (1906) 23 R.P.C. 183, 506.
(6) (1935) 53 R.P.C. 31; 9 A.L.J. 244.

In that suit, however, publication of the invention by prior user had not been one of the objections to validity. His Honour, in accordance with his previous judgment, decided the objections to the validity of the patent other than the objection on the ground of prior user, in favour of the patentee. Upon the hearing of the appeal the question of prior user was fully argued before us and before entering upon the hearing of the argument concerning other objections to the validity of the patent, we took time to consider the correctness of his Honour's decision upon the question of prior user. We have reached the conclusion that his Honour's judgment was in this respect correct and that on that ground the appeal should be dismissed.

The invention is one for a machine for collecting seed, especially the seed of paspalum grass. The specification describes the purpose of the invention as being to provide a machine and an attendant contrivance for attachment to an operating vehicle for the rapid gathering of seed, especially of that of paspalum dilatatum grass, but also applicable to wheat or other similar crops. It is unnecessary for the purposes of our decision to describe the invention in detail. As the statement of its purpose shows, it is divided into two sections. One is what is called the "attendant contrivance" to be attached to an operating vehicle. That means nothing more than that the machine which collects the seed must in some way be suspended from the side of a lorry or truck or other vehicle by which the machine is propelled through the grass. One method which is fully described in the specification of so suspending the machine is by a hinged frame which can be lowered over the side of the vehicle by means of pulley blocks and windlass. Another is simply by means of horizontal beams extending over the side of the vehicle and affixed to the floor or deck of the vehicle. The other section consists of the machine itself, which is constructed so as to pass through the grass a contrivance which resembles a very large comb. Behind the points of the very broad horizontal teeth of the comb are troughs ending in a tray. The troughs and the tray catch the seed which the huge comb shakes out or otherwise detaches from the grass.

The date of the application for the patent was 4th October 1935. The patentee, who is the appellant, says that he first began to think of some such contrivance in the year 1912 and that he then dropped the idea and took it up again in 1933. He himself was not engaged in farming operations but lived in a district where there was a considerable quantity of paspalum grass and he had been born at Ghinni Ghinni on the Manning River. Early in

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1934 he constructed a machine upon the general lines of the invention. He made it on the verandah of his own home. Having made the machine he proceeded to put it into practical use in order to test it. He had a brother who possessed a farm at Coopernook on the north coast of New South Wales. The brother also possessed a lorry. The appellant decided to try his machine with the aid of his brother's lorry on his brother's property. The machine was attached to the lorry by horizontal bars projecting over the side of the lorry. In April 1934 they tested the machine in the paspalum grass at Coopernook. It worked with some degree of success and the modifications or improvements which were afterwards made were not very considerable. They consisted in alterations of the height of the sides of the troughs and in some other matters and an alteration of the attendant contrivance for fastening the machine to the lorry or propelling vehicle. There were some other minor details which were afterwards changed. The attendant contrivance for affixing to the operating vehicle was of course a matter of considerable importance. In the end it took the form of a frame to which the machine was suspended at the side of the motor lorry or propelling vehicle. The frame was hinged to the outer side of the lorry or propelling vehicle in such a way that it might be lowered by a windlass. At some point which is not clearly fixed a second machine on the same large scale was constructed by the appellant. It was at all events in existence in March or April 1935. But in the meantime a third machine was constructed, one upon a smaller scale. The purpose of the reduced size was to test the possibility of the machine being drawn by animal power, with the aid of a sledge or slide. It was thought that an ordinary horse-drawn slide or sledge might be used to operate it and that thus the machine might be used without mechanical power. Experiments with the slide did not prove satisfactory and the smaller machine was put aside. In December 1934 the appellant put one of the larger machines into use for one day upon the farm of a man named Gregory. Then again in February 1935 he used the machine on the farm of one Gill. In his cross-examination he was asked "Did you do any more in March and April, 1935?". He answered "Yes, we continued. I continued to harvest and trying to harvest and trying" (*scil.* the machine) "and the second form of contrivance was developed during that period." He said that during this period he harvested in other places as well as Gill's and gave the names of three other farms. He said that he had left the machine with his brother-in-law, Elliott. He said that possibly in March 1935 the two large

machines were working at the same time. They were both under his control. His brother worked the second large machine and it was in the same area as he himself was in, but there might have been two trucks in the area at the same time and the two machines might have been working in the same paddock but it was not constant, only occasional. In answer to a question whether at the beginning of 1935, in January or February, he went on using the machine, he said he went on trying it out. He offered the farmers a royalty upon the paspalum seed which he obtained. Some refused it, others took it. In his re-examination in reply to questions as to the object of the use he made of the machine in December and February, he said "Well, I had the machine and I wanted to see if the machine would be a commercial success. I knew it would harvest some seed, but the work I had done in 1934 would not have been on a profit basis. As I went along I tried improvements and alterations." He said that he tried putting a vertical rib on top of the ordinary rib in the troughs or boats at varying distances and that there was a fair amount of experimenting required round the toe of the machine to make it work satisfactorily because it tended to collect debris and force the stalks of the grass forward. The angle of the rib was found to be of importance. He tried the use of rubber bands along the line of the troughs or boats to bring the stalks together and shake them. He used chains and he used a flexible steel wire and made certain other adjustments. Finally, he said that in April 1935 he was satisfied. Whatever seed he won in the course of the use of the machine he sold. He said that when he took the machine to a farm for the most part he made arrangements beforehand. He might meet the farmer or write to him or go and see him. He had to drive into the farm with the machine on the lorry. There were various farms upon which he worked and he would estimate that about half the number of farmers concerned saw the machine.

With reference to these facts, *Roper* C.J. in Eq. said that on the face of the evidence he thought that it had established a prior user, but that the plaintiff, the appellant, contended that all he did was experimental. After discussing s. 124 of the *Patents Act* his Honour said "I find it impossible in this case to regard the 1935 user as experimental or as a test. It seems to me to go far beyond that and to be a user of a machine the utility of which had already been established, at all events in 1934, and in my opinion it is a user which invalidates the patent". His Honour said the plaintiff impressed him as a frank and reasonably reliable witness.

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We think that it is impossible to displace his Honour's conclusion of fact. In the first place, it is quite plain that the nature and character of the invention was disclosed to the farmers and others who saw the machine in operation in December 1934, and February, March and April 1935. The use made of the machine was open. No relation of confidence was established between the inventor and those who saw the machine and an inspection of the machine would make apparent the character of the invention. Subject to the effect of s. 124, which must be considered independently, the question upon which the appeal depends is whether such a disclosure of the invention can be treated as not amounting to a publication by prior user on the ground that it was of an experimental character and made as a necessary or proper incident of the development of the invention itself. Although if an invention is practised openly or made known publicly before an application for a patent is made, the patent if granted will be void, the law has long made a qualification in favour of user which is experimental or secret. In his direction to the jury in *Cornish* v. *Keene* (1) *Tindal* C.J. said that it must not be such a practice of the invention as is only referable to mere experiments for the purpose of making a discovery or something secret or confined to the party who was making it at the time, but that it must be, in order to set aside the patent, a case where it was in public use and operation among persons in the trade and likely to know it. In the side note to this statement it is said—" The user which will vitiate must not be such as can be classified as experiment or secret, but must be public ". An inventor is entitled to make experiments to test an invention and for that purpose to employ others, and if need be a large number, to assist in those experiments : per *Kekewich* J., *Gadd and Mason* v. *Mayor &c. of Manchester* (2); But the qualification in favour of experiment must be carefully applied and limited to acts which are reasonably necessary to produce the result embodied in the specification. In *Croysdale* v. *Fisher* (3) *Pollock* B. said that when it is said that a process has been disclosed or an invention has been disclosed by means of user, it is not necessary that the user should be a user by the public proper, provided only there is a user in public, that is to say, in such a way as is contra-distinguished from a mere experimental user with a view of patenting a thing which may or may not be existing.

(1) (1835) 1 Web. Pat. Cas. 501, at p. 512.

(2) (1892) 9 R.P.C. 249, at p. 258; affirmed (1892) 9 R.P.C. 516, at p. 528.

(3) (1884) 1 R.P.C. 17, at p. 2 .

The character of the invention itself may be important in considering what degree of disclosure is inevitable in the course of developing the invention. An example is provided by the case of *Honiball* v. *Bloomer* (1), where the invention in question related to an anchor, a thing not easily made the subject of secret experiment or testing. *Martin* B. there said that he thought that if the inventor had put the anchor on board a steam boat for the purpose of trying whether it would answer and it did not answer and then it was returned, so that the user was really an experiment, that would not interfere with the patent.

There is perhaps no stronger decision that a disclosure in the course of testing an invention or employing it experimentally does not amount to prior public user than *In re Newall and Elliot* (2), and upon that authority the appellant greatly relied. The invention in that case related to a device for use in laying submarine telegraph cables. As the cable was uncoiled it was passed round a cone or several cones for the purpose of preventing it kinking. Thence it passed through a pulley and so to the break wheel before going over the stern of the ship. Experiments made on land to test the invention were not found satisfactory. The plaintiff who became the patentee had a contract to lay a cable in the Black Sea. He determined to employ the invention in carrying out the work and so to test it. This involved fitting the device upon the cable-laying vessel. The first ship to sail with it met with an accident owing to bad weather and was forced to put into the Thames where the cable was transferred to another ship. Precautions were taken to prevent what was going on being known, but persons neither employed by the plaintiff nor by the Government visited the ships and had an opportunity of becoming acquainted with the apparatus, and when the second ship reached the Black Sea and the apparatus was set up for use its nature was necessarily seen by those aboard or connected with the work. An arbitrator decided that the patent was not invalid by reason of the publication of the invention during the operations of the ships or of the use by the plaintiff prior to the date of the letters patent of the apparatus in executing a contract for profit. But the arbitrator stated a case. Upon the case stated the Court of Common Pleas upheld the award. *Byles* J., who delivered the judgment, said: " . . . a necessary and unavoidable disclosure to others, such as here appears, if it be only made in the course of mere experiments, is no publication; although the same disclosure, if made in the course of a profitable

(1) (1854) 2 Web. Pat. Cas. 199; 10 Exch. 538.

(2) (1858) 4 C.B. (N.S.) 269 [140 E.R. 1087].

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use of an invention previously ascertained to be useful, would be a publication ". And later in the reasons the learned judge said :— " The true question, therefore—looking at the decision of the arbitrator—seems to be this : is an experiment performed in the presence of others, which not only turns out to be successful, but actually beneficial in the particular instance, necessarily a gift of the invention to the world ? We think it is not. In the case under consideration, experiments on dry land are found to be indecisive. The decisive experiment still remains to be made on a large scale, and in deep water. An opportunity presents itself, in the course of a government contract,—not a contract for the use of this particular apparatus, but a contract for laying down the cable by any means the contractor may select. The experimentor is obliged either to experiment in a way that may turn out to be useful in the particular instance, or else not to make any efficient and decisive experiment at all. The coincidence of an experiment with actual immediate profit or advantage from it, if successful, is unavoidable " (1).

It will be seen that the essential conditions of fact upon which this decision is based are (1) that an experiment at sea was necessary to determine the sufficiency or utility of the invention ; (2) that to perform it the disclosure was unavoidable ; (3) that the profit or advantage was an accidental though necessary concomitant ; and (4) the use was in fact experimental. The decision cannot be pressed further and it is not in our opinion applicable to the facts of the present case.

On the facts of the present case it appears to be reasonably plain that the appellant used his invention freely in the district in which he and his brother and brother-in-law lived, taking no precautions to keep its character secret or to confine its use to those who were in confidential relations with him, and that he did so without any view to definite improvements or experiment of a specific character and not for the purpose of developing the actual invention applied for. The use was not experimental except in the possible but vague sense that the appellant might not have been quite satisfied that the qualities of the machine had been fully tested and might have remained uncertain whether some further improvements might not be effected to make it more efficient. This, in our opinion, was not enough to protect the disclosure which he made in the course of the use of the machine. The use seems to have been wide and unguarded and it could not be considered as reasonably necessary in order to bring the invention to such a

(1) (1858) 4 C.B. (N.S.), at pp. 294, 295 [140 E.R., at p. 1097].

condition that he might apply for a patent and describe his invention in a specification, whether complete or provisional. We cannot agree in the contention that it is for an inventor to judge what experimentation is required or how far it should be carried. The criticism made of the conclusion of *Roper* C.J. in Eq. that he substituted his view of what was necessary for that of the patentee has therefore no basis. Nor do we agree with the contention that his Honour concerned himself rather with commercial than with public user. Apart from the possible effect of s. 124 of the *Patents Act* 1903-1946, we think that there was public user which would invalidate the patent.

Section 124 is a provision peculiar to the patents legislation of the Commonwealth (see per *Starke* J., *Paper Sacks Pty. Ltd.* v. *Cowper* (1)), although there is now a provision dealing with the same subject in s. 51 (3) of the English *Patents Act* 1949 (12, 13 & 14 Geo. VI. c. 87). Section 124 provides that the fact that an invention has been exhibited or tested either publicly or privately shall not in itself be deemed a ground for refusing a patent; provided that any public exhibition or testing must have been within one year of the date of the inventor lodging his application for a patent. This provision received much consideration from this Court in *Paper Sacks Pty. Ltd.* v. *Cowper* (2), where, however, the basic question was whether the section applied at all to protect the validity of a patent granted or was confined in its operation to the application for a patent. In this Court the view was taken that if the section enabled an applicant to obtain a patent notwithstanding that he had publicly or privately exhibited or tested the invention it must follow that the patent when granted remained valid. But in the Privy Council doubts were thrown upon this view: see (3).

In the present case it is not necessary for us to reconsider this question. It is enough to say that in our opinion what the appellant did on the facts went far beyond any exhibition or testing to which s. 124 relates. The word "exhibited" is of course of ambiguous import. But it is not synonymous with "disclosed" or "publicly disclosed". It means displayed in some more limited sense. Testing may not be co-extensive with experimenting. Some tests may be made which are not experiments and some experiments which are not tests. In the case of *Paper Sacks Pty. Ltd.* v. *Cowper* (4), *Starke* J. said:—"The words 'shall not in itself' mean, I think, 'shall not alone' be deemed a ground for

(1) (1934) A.L.R., at pp. 104, 105; 7 A.L.J. 463.
(2) (1934) A.L.R. 102; 7 A.L.J. 463.
(3) (1935) 53 R.P.C. 31; 9 A.L.J. 244.
(4) (1934) A.L.R., at p. 105.

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refusing a patent. The proviso then requires, in the case of a public exhibition, or testing, that it must have been within one year before the date of the lodging of the application. But I cannot think that private exhibitions or tests, fully disclosing the methods of manufacture or the nature of the process invented, without any confidence or injunction to secrecy, remain protected no matter how long an inventor delays an application for a patent; the words 'shall not in itself' negative any such view. Consequently, in my opinion, if the exhibition or the test, whether public or private, fully and completely discloses the method of manufacture or the process of manufacture without any confidence or injunction to secrecy, then there is something more than the mere fact that the invention has been exhibited or tested, and the case falls outside the protection given by the section."

In the Privy Council Lord *Russell*, who delivered the judgment of their Lordships, said:—"Their Lordships, however, are of opinion, upon an examination of the facts of the present case, that what in fact took place went far beyond the events contemplated by s. 124, and that accordingly no protection can on any view be afforded to the patent by the section. This was in substance the view taken by Mr. Justice *Starke* on the hearing of the appeal" (1). In the present case the use which the appellant made of the machine in harvesting paspalum seed on the various farms to which reference has been made went far beyond testing the machine in any reasonable sense of the word "test".

For these reasons we are of opinion that the decision of the learned judge was right on the ground upon which he placed it and that it is unnecessary to go into the other ground upon which the respondent would propose to support the judgment. The appeal must be dismissed with costs.

Appeal dismissed with costs.

Solicitor for the appellant, *J. R. Thomas.*

Solicitors for the respondent, *Stewart & Stewart*, Kempsey, by *Fisher & Macansh with J. T. Ralston & Son.*

J. B.

(1) (1935) 53 R.P.C., at p. 51.