[HIGH COURT OF AUSTRALIA.]

In re DUCKHAM'S PATENT.

H. C. OF A. 1951.

MELBOURNE, *Oct.* 2, 22.

Dixon J.

Patent—Practice—Application for extension of term—Originating summons—Petition—Patents Act 1903-1950 (*No.* 21 *of* 1903—*No.* 80 *of* 1950), *s.* 84 (1), (6).

On an application by originating summons under s. 84 (6) of the *Patents Act* 1903-1950 for extension of the term of a patent the practice of the High Court will be as follows:—(1) The application should be advertised after the issue of the originating summons. (2) If it has been advertised by the patentee before its issue, the advertisements may be taken into consideration in deciding what further advertisement is necessary. (3) After the issue of the originating summons, a summons for directions should be issued seeking directions from a justice in chambers as to the advertisements, time of hearing, nature of evidence and such other matters, if any, on which directions may be desired. (4) Usually, two advertisements in the Official Journal will be ordered and one in a newspaper for each of the State capitals, but—according to the nature of the invention and the circumstances of the case—more limited or more extensive advertising may be directed. (5) The advertisement of the application will include a statement as to the time and place fixed for the hearing of the originating summons.

In the case of petitions under s. 84 (1) of the Act, the practice of issuing a summons for directions should be followed and—as part of the order for directions—an advertisement should generally be required in the Official Journal notifying the time of hearing.

ORIGINATING SUMMONS.

This was an application by originating summons for the extension of the term of a patent under s. 84 (6) of the *Patents Act* 1903-1950. A question arising as to the practice to be followed on such an application, the matter was determined as appears in the judgment hereunder.

G. A. Pape, for the applicant.

A representative of the Commonwealth Crown Solicitor, for the Commissioner of Patents.

Cur. adv. vult.

H. C. OF A. 1951.

IN RE DUCKHAM'S PATENT.

Oct. 22.

DIXON J. delivered the following written judgment :—

On 26th July 1951 I made an order in this matter enlarging the time for applying under s. 84 (6) of the *Patents Act* 1903-1950 by originating summons for the extension of the applicant's patent. The order enlarged the time for issuing the summons to 31st August 1951. Regulation 134 of the *Patent Regulations* provides that a patentee intending to apply by petition for the extension of the term of his patent under s. 84 shall give public notice by advertising three times in the Official Journal and once at least in a daily newspaper published in each capital city of the States. If this regulation applied to proceedings by originating summons, the time limited by my order was too short to allow of the advertisements it prescribes. The regulation does not apply, however, of its own force to applications by originating summons under sub-s. (6) of s. 84 ; of its own force it applies only to petitions under sub-s. (1). It was so decided by *Fullagar* J. in *Re Del-Mac Shoe Process Corporation's Patent* (1), and in a number of unreported cases *Williams* J. had acted previously upon the same view. But as appears from the reasons given by *Fullagar* J. a practice has arisen of requiring applicants by originating summons under sub-s. (6) to advertise their applications. That such applications should be advertised is obviously right but it does not follow that the same advertisements as are prescribed by reg. 134 should be required. Different justices, however, have adopted different views of what ought to be done. According to one practice advertisements have been directed after the originating summons has been issued ; according to another advertisements before the issue of the summons have been required. Under the latter practice there has been an insistence upon a compliance with reg. 134, which has perhaps been treated as applying by analogy.

In the present case the originating summons has already been issued and within the time limited by the order I made. After its issue an application was made to the Court for directions as to advertising. The application came before me and I intimated to counsel who appeared for the patentee that I would follow the decision of *Fullagar* J. in the interpretation of s. 84 (6) and reg. 134. I said also, that in pursuance of the practice which allowed of advertisements after the issue of the summons I would direct the applicant to advertise now in a manner which I thought sufficient in the circumstances of the case. Counsel however asked me if it would not be possible to make this application the occasion of settling a uniform practice which the justices would generally follow.

(1) (1950) 81 C.L.R. 327.

It appeared to me desirable to establish a uniform practice if that were possible and I therefore took time to consult the justices and that I have done. The justices are of opinion that a general practice should prevail as follows:—(1) The application should be advertised after the issue of the originating summons. (2) If however it has been advertised by the patentee before its issue, the advertisements may be taken into consideration by the justice in deciding what further advertisement is necessary. (3) After the issue of the originating summons a summons for directions should be issued seeking directions from a justice in chambers as to the advertisements, the time of hearing, the nature of the evidence (i.e. oral or *viva voce*), and such other matters, if any, upon which directions may be desired. (4) Usually two advertisements in the Official Journal will be ordered and one in a newspaper for each of the State capitals, but according to the nature of the invention and the circumstances of the case more limited or more extensive advertising may be directed. (5) The advertisement of the application will include a statement as to the time and place fixed for the hearing of the originating summons.

It may be added that the justices are of opinion that, in the case of petitions under sub-s. (1) of s. 84, the practice of issuing a summons for directions should be followed and that, as part of the order for directions, an advertisement should generally be required in the Official Journal notifying the time of hearing.

In the present case I shall place the application in the list of causes for hearing at the sittings of the Court in February 1952 and direct that the application be advertised twice in the Official Journal and once in a daily newspaper circulating in Melbourne and once in a daily newspaper circulating in Sydney. The advertisements must appear before 15th January 1952 and must state that the application will be heard at the February sittings of the Court in Melbourne and that a person desiring to oppose the application should lodge a caveat in the Principal Registry before 14th February 1952.

Order accordingly.

Solicitors for the applicant, *Lohrmann, Tindal & Guthrie*, Perth, by *Arthur Phillips & Just.*

Solicitor for the Commissioner of Patents, *D. D. Bell*, Crown Solicitor for the Commonwealth.

E. F. H.