

[HIGH COURT OF AUSTRALIA.]

THE QUEEN

AGAINST

COMMISSIONER OF PATENTS ;

EX PARTE MARTIN.

MARTIN APPLICANT ;

AND

COMMISSIONER OF PATENTS . . . RESPONDENT.

Patents—Application and letters patent—Amendment—Error—Misdescription of applicant as actual inventor—Power to amend certain documents fixed by statute—Extension of power by regulation—Validity—“ Clerical error ”—Patents Act 1903-1950 (No. 21 of 1903—No. 80 of 1950), ss. 108, 117—Patents Regulations 1912-1949 (S.R. 1912 No. 76—S.R. 1949 No. 89), reg. 147.

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MELBOURNE,
June 10, 11,

12, 15 ;
Oct. 12.

Williams
A.C.J.,
Webb,
Fullagar,
Kitto and
Taylor JJ.

An applicant for letters patent inadvertently declared in his application that he was the actual inventor of the invention concerned, whereas in fact he was the assignee. Letters patent were duly issued to the applicant on the basis of his application and were sealed as of 21st June 1945, the date of the application. The letters patent which were in the form in the First Schedule to the *Patents Act* 1903-1950, recited that the applicant had made a declaration that he was the actual inventor of the invention, and contained a proviso that the letters patent should be void if it were made to appear that, *inter alia*, the patentee was not the actual inventor of the said invention. On 23rd February 1951, the patentee applied to the Commissioner of Patents to amend the application and the letters patent so as to show that he claimed not as actual inventor but as assignee of certain persons.

Held by Webb, Fullagar, Kitto and Taylor JJ. (Williams A.C.J. dissenting), that, whether the letters patent were invalid or not, the amendment of documents was not appropriate to meet the situation which had arisen ; by Webb J.

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on the ground that the letters patent were void by reason of the proviso to the letters patent, and to hold that there was a power to amend so as to validate void letters patent was to disregard the intention of the legislature; by *Fullagar, Kitto and Taylor JJ.* on the ground that to correct the application was to create a state of falsity in the letters patent and the Register of Patents by making it appear that the patent was granted on a declaration on which it was not in fact granted.

Section 117 of the *Patents Act* 1903-1950 provided: "The Commissioner may on request in writing accompanied by the prescribed fee correct any clerical error in the Register of Patents or in any proceedings under this Act . . ."

Held by *Williams A.C.J., Fullagar, Kitto and Taylor JJ.*, that the error of the applicant in this case was not a clerical error within the meaning of s. 117.

Section 108 of the *Patents Act* 1903-1950 provided: "The Governor-General may make regulations, not inconsistent with this Act, prescribing all matters which by this Act are required or permitted to be prescribed or which are necessary or convenient to be prescribed for giving effect to this Act or for the conduct of any business relating to the Patent Office".

Regulation 147 of the *Patents Regulations* 1912-1949 provided: "Any document, for the amending of which no special provision is made by the Act, may be amended, and any irregularity in procedure, which in the opinion of the Commissioner may be obviated without detriment to the interests of any person, may be corrected, if, and on such terms as, the Commissioner thinks fit . . ."

Held, by *Fullagar, Kitto and Taylor JJ.* (*Williams A.C.J. contra*) that reg. 147 was ultra vires and invalid, on the ground that the Act must be taken to have provided for all such amendments as the legislature considered proper.

Morton v. Union Steamship Co. of New Zealand Ltd. (1951) 83 C.L.R. 402, applied.

The operation of the proviso in the letters patent "That these letters patent shall be void if it is made to appear . . . that the said patentee is not the actual inventor of the said invention" discussed.

ORDER NISI for mandamus.

On 21st June 1945, two applications for letters patent by Henry George Martin were lodged at the Patents Office. Application No. 21,477 was in respect of an invention for improvements in writing instruments and application No. 30,004 was in respect of an invention for improvements in inks. Each application was made on Form A in the Second Schedule to the *Patents Act* 1903-1950 which so far as is relevant is as follows:

“ Application for a Patent.
(By an Actual Inventor or two or more Actual Inventors, or his
or their Assignee, Agent, Attorney, or Nominee.)

I,.....of,..... hereby apply that a
Patent may be granted to me for an invention entitled.....
and I do hereby declare that I am (5)*..... the
actual inventor of the said invention, and I verily believe that
I am entitled to such Patent under the provisions of the *Patents
Act* 1903-1950. And I further declare that I am in possession of the
said invention, and that it is not in use within the Commonwealth
of Australia by any other person or persons to the best of my
knowledge and belief. And I make this declaration, conscientiously
believing it to be true. Dated thisday of.....
A.D. 19..... Signed etc.

To the Commissioner of Patents,
Commonwealth of Australia.

The space preceded on the forms by (5)* was not filled in on the
completed forms.

In respect of the application No. 21,477 letters patent No. 136,148
were granted on 15th June 1950, and in respect of the application
No. 30,004 letters patent No. 136,296 were granted on 16th June
1950. Each grant was duly entered in the Register of Patents as
a grant in the form of the letters patent themselves.

The letters patent were in similar form which in the case of No.
136,148 was as follows :

“ George the Sixth, by the Grace of God of Great Britain, Ireland
and the British Dominions Beyond the Seas, King, Defender of
the Faith : To All to whom these presents shall come Greeting :
Whereas Henry George Martin, of The Argentine Club, 1 Hamilton
Place, London, W., England, Accountant, has, pursuant to the
Patents Act 1903-1935, made application for Letters Patent of an
Invention for Improvements in writing instruments, and has made
a declaration in the prescribed form that he is the actual Inventor
of the said Invention : and has by a complete specification fully
described and ascertained the Invention. Now, Therefore, We
do by these Letters Patent give and grant to the said Henry George
Martin, (hereinafter called the Patentee) Our especial licence full
power sole privilege and authority that the said Patentee by himself,

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(5) The Actual Inventor or Actual Inventors ; or the Assignee, Agent, Attorney
or Nominee of the Actual Inventor or Inventors.

* Where the applicant is not the actual inventor, insert particulars set forth in
Section 32 of the Act. In every instance the name of the actual inventor must
be disclosed ”.

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his agents or licensees and no others may at all times hereafter during the term of years herein mentioned make use exercise and vend the said Invention within the Commonwealth of Australia in such manner as to him or them may seem meet and that the said Patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said Invention during the term of sixteen years from the date hereunder written of these presents: Provided always that these Letters Patent are subject to the following conditions:—(1) That these Letters Patent shall be void if it is made to appear that this grant is contrary to law or is prejudicial or inconvenient to Our subjects in general, or that the said Invention is not a new Invention, or that the said Patentee is not the actual Inventor of the said Invention. (2) That these Letters Patent shall cease and determine if the Patentee fails to pay any renewal fee set out in the Second Schedule to the *Patents Act* 1903-1946 on the date when it becomes due or within such further time as may be allowed. And We do grant unto the Patentee that these Letters Patent shall be construed in the most beneficial sense for the advantage of the Patentee. In Witness whereof We have caused these Our Letters to be made patent this Twenty-first day of June One thousand nine hundred and Forty-five and to be sealed as of the Twenty-first day of June One thousand nine hundred and Forty-five ”.

It appeared that the actual inventors of the invention described in the letters patent No. 136,148 were Laszlo Jozsef Biro and Martin and, in the case of that described in the letters patent No. 136,296, Laszlo Jozsef Biro alone, and that Martin was the assignee of both inventions.

On 23rd February 1951 the patentee requested the Commissioner of Patents under reg. 147 of the *Patents Regulations* 1912-1949 that the application No. 21,477 might be amended by inserting the following words in the space preceded by (5)* “ the assignee of Laszlo Jozsef Biro, technician of 3,040 Oro Street, Buenos Aires, Argentine and the said Henry George Martin ” and that the application No. 30,004 might be amended by inserting in the same space the following words “ the assignee of Laszlo Jozsef Biro, technician of 3,040 Oro Street, Buenos Aires, Argentine ”. Requests were made at the same time for the consequential amendment of each of the letters patent. The ground stated in the requests was as follows: “ The words sought to be inserted were omitted from the application for a patent owing to accident, mistake or inadvertance ”. The requests were supported by statutory declarations by the patentee. The following declaration in support

of the application for the amendment of application No. 21,477 and letters patent No. 136,148 is representative.

“ I, Henry George Martin of The Argentine Club, 1 Hamilton Place, London, W., England, Accountant, do hereby solemnly and sincerely declare as follows :—

1. That I am the Patentee and Applicant in relation to a large number of patents and applications for patents granted and pending in Great Britain, the British Dominions and other countries throughout the world in respect of writing instruments and other writing materials. The said patents and applications for patent relate inter alia to various writing instruments of the kind generally known as ball-point pens and writing fluids for use in such instruments and such patents and applications were in many instances based upon inventions originally made by one Laszlo Jozsef Biro, Technician, of 3040 Oro Street, Buenos Aires, Argentine and assigned to myself and in other instances the relevant inventions were jointly made by the said Laszlo Jozsef Biro and myself in the course of collaboration between us.

2. That I am the Applicant in respect of Patent Application No. 10026/44 of Great Britain which has been accepted under number 629226. This patent relates to improvements in writing instruments.

3. That through my Patent Attorneys in Great Britain instructions were forwarded to Messrs. Phillips, Ormonde, Le Plastrier & Kelson, Patent Attorneys of Melbourne, Australia, to take the necessary steps to secure patent protection in Australia in respect of the subject matter of the said Patent No. 10026/44 of Great Britain and in particular to file an application under the provisions of Section 121 of the Patents Act of the Commonwealth of Australia relating to International Convention Applications.

4. That I signed the original application for the Australian Patent believing the same to be in the form required by the Commonwealth Patents Act. This document contained a statement that the actual inventor was Laszlo Jozsef Biro and giving his address. This application form already executed by me was forwarded to my Australian Patent Attorneys who subsequently reported to my Patent Attorneys in England that the statement of the identity of the actual inventor was not required since the application was to be a Convention Application based on the corresponding British Patent and that the form of application was amended by deleting these words and otherwise making it comply with the appropriate form of application required by the Patents Regulations. The application for the corresponding British Patent was not in fact made on behalf of Laszlo Jozsef Biro. My said Australian application

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as amended was filed in the Patents Office on the 21st day of June 1945 and was numbered 21477/45.

5. That in due course I was informed by my Patent Attorneys that owing to disconformity between the Australian specification and the basic specification in Great Britain upon which the claim to priority was based the said application could not proceed and subsequently two applications for patents were signed by me one relating to improvements in writing instruments and the other relating to improvements in inks. The former was duly filed in the Commonwealth of Australia Patents Office in substitution for the original application No. 21477 and received the same number and the latter was also duly filed as aforesaid under Application No. 30004. The said applications and the specifications subsequently filed in relation thereto covered the subject matter of the said basic specification and also the result of further work done in relation to writing instruments since the date of the British Patent Application No. 10026/44.

6. That in relation to the said Application No. 21477 dated the 8th day of September 1945 the subject matter of the said application was an invention made by the said Laszlo Jozsef Biro and myself jointly and for the purpose of enabling the said application to comply with the requirements of the Regulations under the Patents Act of the Commonwealth of Australia by disclosing the identity of the actual inventor I am desirous that leave be granted to me to amend my said application by adding the words 'the assignee of Laszlo Jozsef Biro, Technician, of 3040 Oro Street, Buenos Aires, Argentine and the said Henry George Martin', in the blank space on the printed form of application marked with the marginal reference number 5. Subject to such leave being granted my said Australian Patent Attorneys are authorised to insert the said words in my said application and I hereby declare my said application as so amended to be true and correct.

7. That when I signed the said now applications numbered 21477 and 30004 my attention was not drawn to the fact that this application differed from the form of an application originally filed as Application No. 21477 or that I was required on this occasion to state the identity of the actual inventor of the subject matter of the application or that the expression 'actual inventor' by reason of the special definition appearing in the Commonwealth Patents Act was an expression of special significance. These instructions were not actually brought to my notice at the time and when I signed each of the said applications it was my belief that the same was complete and ready for signature.

8. That I did not notice at the time of signing either of the said applications that a blank space had been left in the form nor did I understand that I was intended to have any further words inserted in the application form. It was my belief at the time that the direction that it was not necessary to disclose the identity of the actual inventor applied equally to the said new applications. I have no particular knowledge of the Australian Patents Act and by reason thereof did not address my mind to the relevant clause of the application at the time of signing except that I believed that the application was in the form required by the Australian Patents Office. If my attention had been called to the true effect of the application at the time I would not have signed it in that form. The omissions from the applications first came to my knowledge after my English Patent Attorneys had received the original deeds of letters patent. And I make this Solemn Declaration conscientiously believing the same to be true and by virtue of the Statutory Declarations Act, 1835."

On 6th March 1952, the Commissioner of Patents refused the applications.

On 26th February 1953, on the application of the patentee, as prosecutor, *Fullagar J.* granted an order nisi for a writ of mandamus directed to the Commissioner of Patents to hear and determine the applications upon the following ground: "That the Commissioner of Patents has power by virtue of s. 117 of the *Patents Act* 1903-1950 or reg. 147 of the *Patents Regulations* 1912-1949 or otherwise to entertain and grant the applications". On the return of the order nisi the prosecutor applied, pursuant to notice of motion dated 7th May 1953, for an order under s. 30 of the *Patents Act* 1903-1950 for rectification of the Register of Patents by making corresponding corrections to those sought in the applications made to the Commissioner of Patents.

K. E. Shelley Q.C. (with him *A. H. Mann*), for the prosecutor. Section 117 of the *Patents Act* 1903-1950 gives power to make the amendments. The words "in any proceedings under this Act" mean "in any document which formed part of proceedings under the Act". There are several sets of proceedings under the Act including proceedings leading up to the grant, opposition proceedings, amendment proceedings. There is no warrant for reading "proceedings" as "current or pending proceedings". If that were the meaning, then an error which appeared for the first time in the letters patent could not, after the moment of grant, be amended. The decision of *Luxmoore J.* in *In the Matter of an Application for a Patent by Imperial Chemical Industries Ltd.*,

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Fawcett and Walker (1) on which the respondent commissioner relied is not relevant to the meaning of the words "any proceedings". *In the Matter of Letters Patent No. 8789 of 1922 granted to Pressley Scott* (2) is not an authority against the granting of the amendments sought here. The explanation of that case is that the amendment, which was confined to correction of the Register of Patents was refused because it led to a useless result. The width of the power to amend a patent and of the term "clerical error" is shown by *In Re Sharp's Patent; Ex parte Wordsworth* (3); *In re Redmund* (4); and *Nickels v. Ross* (5). *Webster's Patent Cases* (1844), vol. 1, p. 647, Note 1; Cases 3, 5, 7, 9, 10, 13, 17. It is submitted that the amendments sought can be made under s. 117 of the *Patents Act* 1903-1950 because the error was a clerical one. A clerical error is the sort of error that a clerk might be guilty of e.g., omission of a word or paragraph. The omission by the prosecutor of the words showing that he was assignee was a clerical error because he never believed that he was the actual inventor. The test is whether the result represented the intention of the parties or whether it failed to do so by inadvertence. [He referred to *In re Sharp's Patent; Ex parte Wordsworth* (6).] If the prosecutor had wrongly believed that he was the actual inventor and had written that on the form, that would not be a clerical error. The crucial test is whether the writing agrees with the real intention of the writer. The modern tendency is to permit amendment freely. If the error in the application form was a clerical error and it was copied accurately to the letters patent it remains a clerical error in the letters patent. I have never heard it suggested that the court has not full power to revoke the patent but it may be that it is not within the power of the Court exclusively. The modern English form of grant is different. For that form see *Terrell & Shelley on Patents*, 9th ed. (1951), pp. 548-549. *Edmunds on Patents*, 2nd ed. (1897), pp. 677-678 is to the same effect as *Wallace & Williamson on Law of Letters Patent for Inventions* (1900), pp. 22-23.

[WILLIAMS A.C.J. referred to *Frost on Patent Law and Practice*, 4th ed. (1912), vol. 1, p. 297; *Webster on Law and Practice of Letters Patent for Inventions* (1841), p. 32; *Reg. v. Cutler, Slaney, Bower & Selby* (7); *R. v. Arkwright*; *Webster's Patent Cases* (1785), vol. 1, p. 64.]

(1) (1935) 53 R.P.C. 157.

(2) (Supreme Court of Victoria, *Schutt J.*, 20th November, 1924. Unreported).

(3) (1840) 3 Beav. 245, at pp. 252-254 [49 E.R. 96, at pp. 98-99].

(4) (1828) 5 Russ 44 [38 E.R. 943].

(5) (1849) 8 C.B. 679 [137 E.R. 674].

(6) (1840) 3 Beav. 245 [49 E.R. 96].

(7) (1847) 3 Car. & K. 215 [175 E.R. 526].

The proper construction of reg. 147 of the *Patent Regulations* 1912-1949 is that any document may be amended when there is no special provision for amending it in the circumstances in which the application for amendment arises. I do not assert that the words of the regulation "any irregularity in procedure" apply to this case. The regulation is applicable to both the letters patent and the application. It would not be against the application to amend if the letters patent were at present invalid because it could be made a term of any amendment that no proceedings be brought in respect of the letters patent for anything done prior to the amendment. Amendment has been recognized as available to make an invalid patent valid. [He referred to *Morgan v. Seaward* (1); *Perry v. Skinner*, per Lord Abinger C.B. (2), per Parke B. (3).] It has never been doubted that a notice of opposition can be amended. In *R. v. Commissioner of Patents; Ex parte Weiss* (4) the question turned on amendment of the notice of opposition. Section 108 of the Act is sufficiently wide to justify the regulation.

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M. V. McInerney, for the respondent. If the respondent commissioner has power to make the amendments, he is prepared to do so. If provision is made by the *Patents Act* 1903-1950 for the amendment of a particular document, then reg. 147 does not apply. Section 42 of the Act makes provision for the amendment of, *inter alia*, an application. Consequently, there is no power to amend an application under reg. 147. If reg. 147 applied in all cases in which there was no provision for the type of amendment sought to be effected, the question of conflict with the Act would arise. The words "in any proceedings under the Act" in s. 117 mean only proceedings up to the date of grant of the letters patent. After that time there may be proceedings in opposition to the letters patent, but such are proceedings in relation to the letters patent. The power to amend is exhausted when the letters patent are granted. Power to amend in court proceedings only became necessary because of the abolition of the power of rehearing. [He referred to *In re St. Nazaire Co.*, per Jessel M.R. (5); *In re Swire; Mellor v. Swire*, per Lindley L.J. (6); *In re Gist*, per Vaughan Williams L.J. *in arguendo* (7); *Charles Bright & Co. Ltd. v. Sellar* (8).] There is a distinction to be drawn between the various

(1) (1837) 2 M. & W. 544, at p. 561
[150 E.R. 874, at p. 881].

(2) (1837) 2 M. & W. 471, at p. 475
[150 E.R. 843, at p. 845].

(3) (1837) 2 M. & W., at p. 477 [150
E.R., at p. 845].

(4) (1939) 61 C.L.R. 240.

(5) (1879) 12 Ch. D. 88, at pp. 97-99.

(6) (1885) 30 Ch. D. 239, at p. 246.

(7) (1904) 1 Ch. 398, at p. 403.

(8) (1904) 1 K.B. 6.

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stages of proceedings under the *Patents Act* 1903-1950. [He referred to *In re Gare's Patent* (1).] In that case the Master of the Rolls held that he had power to correct the record after the date of grant of letters patent although, while the proceedings were pending in the Patents Office, the power of amendment belonged to the commissioner. The respondent commissioner does not possess the powers which, as a matter of history, the Master of the Rolls has. The only alternative to the view that there is no proceeding within the meaning of s. 117 after the date of grant of the letters patent is to regard the letters patent as a proceeding. A clerical error is one which is apparent without evidence being called to show that there is an error although evidence may be necessary to show what is the correct substance. It may, of course, only be revealed in some cases by a comparison with earlier documents filed in the same proceeding. In the phrase "clerical error" the relevant party is the clerk. Did he make a mistake? If he intended to do what he in fact did then it cannot be said that he has made a clerical error. The document may not reproduce the intention of the party who sets the proceedings in motion, but it does reproduce the intention of the clerk and so is not a clerical error. If the error was corrected in the manner sought by the prosecutor, the result would really be an entirely new patent. [He referred to *Hindmarch on Patent Privileges*, (1846), pp. 211-226.] It is inappropriate to speak of the correction as an amendment, so extensive is its nature. [He referred to *Oxley v. Link* (2).] So far as the letters patent are concerned there was no clerical error. The respondent commissioner intended to do what he did in fact do. If he had refused to grant the letters patent to the prosecutor as actual inventor, a writ of mandamus would have issued to compel him to do so. [He referred to *MacCarthy v. Agard* (3).] The question of jurisdiction in the case of clerical errors is dealt with in *In re Swire*; *Mellor v. Swire*, per *Lindley* L.J. (4), per *Bowen* L.J. (5); *Lawrie v. Lees* (6); *Preston Banking Co. v. William Allsup & Sons*, per Lord *Halsbury* (7), per *Lindley* L.J. (8), per *A. L. Smith* L.J. (9). A judgment as to invalidity of letters patent on proceedings for revocation is a judgment *in rem*. [He referred to *In re Deeley's Patent* (10); *Poulton v. Adjustable Cover & Boiler Block Co.*, per *Vaughan Williams* L.J. (11), per *Fletcher Moulton* L.J. (12).] The

(1) (1884) 26 Ch. D. 105.

(2) (1914) 2 K.B. 734.

(3) (1933) 2 K.B. 417.

(4) (1885) 30 Ch. D., at p. 246.

(5) (1885) 30 Ch. D., at p. 247.

(6) (1881) 7 App. Cas. 19.

(7) (1895) 1 Ch. D. 141, at p. 143.

(8) (1895) 1 Ch. D., at pp. 143-144.

(9) (1895) 1 Ch. D., at p. 144.

(10) (1895) 1 Ch. D. 687.

(11) (1908) 2 Ch. D. 430, at p. 438.

(12) (1908) 2 Ch. D., at pp. 439-440.

latter case suggests that the letters patent are not avoided *ab initio* but only as from the date of judgment in the proceedings for revocation. Although the writ of *scire facias* has been abolished by s. 86 of the *Patents Act* 1903-1950, if the condition was fulfilled, it would form a ground for proceedings for revocation. The letters patent might, of course, also be declared invalid in proceedings for infringement but different findings might be made by different courts in such proceedings depending on different evidence, because a judgment in infringement proceedings is *in personam*. The cases of *Perry v. Skinner* (1) and *Morgan v. Seaward* (2) are based on a provision equivalent to s. 71 of the Act and are not authorities in respect of s. 117. The Register of Patents cannot be amended under s. 30 of the Act until the letters patent and the application have been amended. The register could not be corrected prior to the correction of the letters patent, because by definition, the register is only the mirror of the letters patent. [He referred to *In the matter of Letters Patent No. 8789 of 1922 granted to Pressley Scott* (3).]

K. E. Shelley Q.C., in reply. In *Oxley v. Link* (4) *Vaughan Williams* L.J. thought that the scope of the concept of "accidental slip or omission" was co-extensive with that of "clerical error". Regulation 147 is in similar terms to r. 16 of the *Patent Rules* 1890 (Imp.) which is discussed by *Edmunds on Patents*, 2nd ed. (1897), at p. 687.

Cur. adv. vult.

The following written judgments were delivered :—

Oct. 12.

WILLIAMS A.C.J. We have before us two proceedings by Henry George Martin relating to letters patent granted to him under the provisions of the *Patents Act* 1903-1950. These letters patent are 136/148 granted to him on 15th June 1950, pursuant to application No. 21477 lodged at the Patent Office on 21st June 1945, and letters patent 136/296 granted to him on 16th June 1950, pursuant to application 30004 also lodged at the Patent Office on 21st June 1945. Letters patent 136/148 were granted for an invention for improvements in writing instruments. Letters patent 136/296 were granted for improvements in inks. Each letters patent contains a statement that Martin "has made a declaration in the prescribed form that he is the actual inventor of the said

(1) (1837) 2 M. & W. 471 [150 E.R. 843].

(2) (1837) 2 M. & W. 544 [150 E.R. 874].

(3) (Supreme Court of Victoria, *Schutt J.*, 20th November 1924. Unreported).

(4) (1914) 2 K.B. 734.

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invention". Each letters patent also provides that it is subject to certain conditions, one of which is "that these letters patent shall be void if it is made to appear that the said patentee is not the actual inventor of the said invention". Each letters patent states that the letters are made patent this twenty-first day of June 1945, and to be sealed as of 21st June 1945. This date is of course in accordance with s. 69 of the *Patents Act* which provides that, subject to the provisions of the Act, every patent shall be dated and sealed as of the date of the application.

It now appears that Martin was not the actual inventor of the inventions referred to in the letters patent and that he should have applied for the patents, not as the actual inventor, but as the assignee of the actual inventor or inventors. He now claims that the actual inventors of the invention, the subject of application 21477, were Laszlo Jozsef Biro and himself and that the actual inventor of the invention, the subject of application 30004, was Laszlo Jozsef Biro, and he has made requests to the Commissioner of Patents under reg. 147 of the *Patents Regulations* 1912-1949 to amend these applications and the letters patent accordingly. He seeks to amend application No. 21477 by inserting the words "the assignee of Laszlo Jozsef Biro, technician of 3040 Oro Street, Buenos Aires, Argentine, and the said Henry George Martin" in the blank space on the printed form of application marked with the marginal reference No. 5 and to amend application No. 30004 by inserting the words "the assignee of Laszlo Jozsef Biro, technician of 3040 Oro Street, Buenos Aires, Argentine" in the blank space on the printed form of application marked with the marginal reference No. 5. He states that the reason for making the amendments is that the words sought to be inserted were omitted from the applications owing to accident, mistake or inadvertence.

It will be convenient at this stage to explain how the proceedings originated. On 24th May 1944, Martin applied in the United Kingdom for a patent for the inventions, the subject of the letters patent in question. He desired to apply for a "convention" patent for these inventions in the Commonwealth under s. 121 of the *Patents Act* so that the letters patent would also be sealed as of 24th May 1944. The *Patents Regulations* 1912-1949 made under the *Patents Act* contain prescribed forms for both ordinary applications for patents under s. 32 of the *Patents Act* and for applications for "convention" patents under s. 121 of the *Patents Act*.

Form A is the form of application for a patent under s. 32 by an actual inventor or two or more actual inventors, or his or their

assignee, agent, attorney, or nominee. Form A6 is the form of application for a patent under s. 121. Form A provides for the applicant declaring that "I am*.....the actual inventor of the said invention". The * calls attention to the footnote to the form which states that where the applicant is not the actual inventor the particulars set forth in s. 32 of the Act must be inserted and that in every instance the name of the actual inventor must be disclosed. Form A6 does not require the applicant to state the capacity in which he applies. It only provides that he must declare that he has made foreign application for protection of his invention entitled.....in England, and in the following British possessions and on the following official dates, viz :—.....and in the following foreign States, and on the following official dates, viz :—.....Martin should have made his application for a "convention" patent on Form A6 but by mistake he made it on Form A. This form contained a declaration that Biro was the actual inventor. His Australian patent attorney struck out this declaration and altered the application so as to make it an application under Form A6 which was lodged at the Patent Office on 21st June 1945, accompanied by a complete specification of the invention claimed.

Upon examination of the specification the examiner found that there was disconformity between it and the specification for the British patent due to additional work having been done on the invention between the dates of the two applications. Martin then decided to abandon his application for a convention patent and to apply for a patent under s. 32. It was also found that the specification related to more than one invention in breach of s. 65 of the *Patents Act* so that it became necessary to lodge two applications. Two printed forms of application in accordance with Form A were sent to Martin to sign. Unfortunately he signed the forms without noticing the * and stating, as he should have done, who were the actual inventors and that he was applying as the assignee of the actual inventor or inventors. Consequently all proceedings in the Patent Office subsequent to the filing of the applications culminating in the grant of the letters patent took place on the basis that Martin was the actual inventor.

The requests came before the Commissioner of Patents for determination in March 1952. In his written decision the commissioner stated that he felt that the facts of the case were such that if he had the power he would exercise his discretion as the applicant requested, but in his view the discretion did not rest with him once the letters patent had been issued and entry had

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been made in the Register of Patents. He considered whether he had the power to make the amendments asked for, not only under reg. 147 under which the requests were specifically made, but also under s. 117 of the Act.

Regulation 147 provides that "Any document, for the amending of which no special provision is made by the Act, may be amended, and any irregularity in procedure, which in the opinion of the Commissioner may be obviated without detriment to the interests of any person, may be corrected, if, and on such terms as, the Commissioner thinks fit. An application to amend shall be accompanied by the prescribed fee".

Section 117 of the Act provides that "The Commissioner may on request in writing accompanied by the prescribed fee correct any clerical error in the Register of Patents or in any proceedings under this Act, but no fee shall be required in respect of any correction necessitated solely by error in the Patent Office".

The commissioner said, and I agree entirely, that "as far as the Register is concerned, no error, clerical or otherwise, has been shown to exist. The entries prescribed by s. 20 have been made in the Register, they accord with the particulars in the application and the letters patent granted thereon". He said that he could not correct the mistakes in the documents under s. 117, even if they were clerical errors, because the proceedings under the Act referred to in the section terminated when the letters patent were granted and he had no power to correct clerical errors in any proceedings under the Act after that date. I cannot agree with this view. To my mind the commissioner has power under the section to correct a clerical error in proceedings under the Act after the termination of the proceedings provided the clerical error occurs in a document which is part of the proceedings under the Act. The section does not say the commissioner can only correct clerical errors in the course of the proceedings. It is sufficient if the clerical error occurs in any proceedings under the Act. Clerical errors can only occur in documents so that the section must refer to documents which form part of the proceedings. The most important of these documents is the letters patent. If the commissioner's view is correct, he could not correct a clerical error in the letters patent, although the patentee could not detect the error until after they had been issued. Turning to reg. 147, the commissioner formed a similar view that he could only exercise his powers under the regulation prior to the date of the issue of the letters patent. The commissioner therefore declined to entertain the applications.

The proceedings at present before us are : (1) The return of an order nisi for the issue of a writ of mandamus calling upon the respondent commissioner to hear and determine the requests upon the ground that he has power by virtue of s. 117 or reg. 147 to entertain and grant the applications of the prosecutor and (2) A notice of motion for rectification of the Register of Patents under s. 30 of the *Patents Act* asking that the register should be rectified by making corresponding corrections to those sought in the requests. At present the Register of Patents is accurate and will only become inaccurate if we decide that the commissioner has power to entertain the requests either under s. 117 or reg. 147 and the commissioner in his discretion decides to make the amendments asked for. The Register of Patents will then become inaccurate and this Court could make an order for rectification under s. 30. The relief asked for in the notice of motion is therefore consequential upon the granting of the other relief and the motion should be stood over for the present.

Counsel for the commissioner pointed out that the present requests are requests for the commissioner to exercise his powers under reg. 147, and that if this Court decides that the commissioner has power to act under s. 117 it will be necessary for Martin to lodge requests in writing under that section and pay the prescribed fees, which Martin is willing to do. But it does not appear to me that there is any evidence that the difficulties which have arisen are due to clerical errors on Martin's part. In *In re Sharp's Patent ; Ex parte Wordsworth* (1), Lord Langdale M.R. said : " If it were alleged that the enrolled memorandum of alteration, by mistake of the writer, contained verbal or clerical errors by means of which something was enrolled contrary to the true intent of the party, and if sufficient evidence were given of the fact, I should think myself authorised, by precedent, to correct the error and make the enrolment accord with the proved intention of the party at the time of the enrolment " (2). A clerical error, I would think, occurs where a person either of his own volition or under the instructions of another intends to write something and by inadvertence either omits to write it or writes something different. In the present case there is no evidence that Martin intended to insert in the Forms A that he was the assignee of the actual inventor or inventors and by inadvertence failed to do so. The evidence at most tends to prove that Martin failed to appreciate that it was necessary for him to state that he was applying for the letters patent as the

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(1) (1840) 3 Beav. 245 [49 E.R. 96].

(2) (1840) 3 Beav., at p. 252 [49 E.R., at p. 98].

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assignee and who the actual inventors were. It does not tend to prove that he knew that he was required to state these things and intended to do so but failed to transcribe his intention in writing.

In these circumstances the only course open to Martin is to seek to amend the documents, not because they contain clerical errors, but so as to bring them into line with the true facts. In other words the only course open to him was the course he took, to request the commissioner to amend the applications and letters patent granted pursuant thereto under the powers conferred upon him by reg. 147. Some doubt was expressed as to whether this regulation might not be too wide and therefore beyond the regulation-making power. It was made under s. 108 of the Act which provides that "The Governor-General may make regulations, not inconsistent with this Act, prescribing all matters which by this Act are required or permitted to be prescribed or which are necessary or convenient to be prescribed for giving effect to this Act or for the conduct of any business relating to the Patent Office". The meaning of a similar section was recently considered by this Court in *Morton v. Union Steamship Co. of New Zealand Ltd.* (1). It was said that "A power expressed in such terms to make regulations enables the Governor-General in Council to make regulations incidental to the administration of the Act. Regulations may be adopted for the more effective administration of the provisions actually contained in the Act, but not regulations which vary or depart from the positive provisions made by the Act or regulations which go outside the field of operation which the Act marks out for itself" (2). A regulation in the same form as reg. 147 is contained in the English Patent Rules of 1890, 1903 and 1908. The regulation does not appear to me to be beyond power. The purpose of the *Patents Act* is to grant patents to those persons who are entitled to apply for letters patent for inventions and make the necessary applications. Section 10 of the Act provides that there shall be a Commissioner of Patents who shall be appointed by the Governor-General and who shall under the Minister have the chief control of the Department of Patents. The procedure for obtaining letters patent commencing with the application and culminating in the grant is intricate and involved and is such that errors may easily creep into documents and irregularities occur in procedure. It would be strange indeed if regulations made under a power to make regulations for giving effect to the Act or for the conduct of any business relating to the Patent Office could not provide that in cases not specially provided for in the Act the

(1) (1951) 83 C.L.R. 402.

(2) (1951) 83 C.L.R., at p. 410.

commissioner should have power to allow documents to be amended and irregularities in procedure to be corrected. Such powers would be incidental to the wide powers of administration conferred upon the commissioner by the Act. They would conduce to the more effective administration of the provisions actually contained in the Act.

Regulation 147 confers on the commissioner two powers:— (1) power to amend any document for the amending of which no special provision is made by the Act, if, and on such terms as, the commissioner thinks fit; and (2) power to correct any irregularity in procedure, which in the opinion of the commissioner may be obviated without detriment to the interests of any person, if, and on such terms as, the commissioner thinks fit. The powers are, I think, split into two because the Act makes special provision for amending some documents, and the regulation had to make the power of the commissioner to amend documents subject to these special provisions, otherwise the regulation would have been *pro tanto* inconsistent with the Act and to that extent at least invalid. But I do not think that the regulation means that if the Act makes special provision for the amending of a document in some respect the commissioner has no power to amend that document in respects which are outside the special provision. Section 39 provides that every application and specification shall forthwith be referred by the commissioner to an examiner who shall ascertain and report as to: (a) whether the title has been stated as prescribed; (b) whether the invention has been described as prescribed; and (c) whether the application and specification are as prescribed. Section 42 provides that, if the examiner reports adversely to the application or specification on any matter referred to in ss. 39 and 40, the commissioner may (a) require compliance by the applicant within a specified time with such directions for the amendment of the application or the specification as the commissioner sees fit to give; or (b) direct that the application instead of dating from the time when it was lodged shall date from such later specified date not being later than the date of compliance with the directions for amendment. These provisions of the Act relate to an examination of the application and specification by an examiner to ascertain whether they are in the prescribed form. The applicant is not concerned or notified unless the application or specification on its face fails to comply with the prescriptions of the Act or regulations. The Act does not make any special provision for an applicant, who discovers he has made a mistake in filling in the particulars required by Form A, applying to the commissioner to amend the application.

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It would be strange if there was no power in the Act or regulations to allow such an applicant to request the commissioner to amend the mistake and for the commissioner to grant the request. This would be one instance where a document was amended in a respect for the amendment of which no special provision was made by the Act. An instance where the Act makes special provision for amending a document, in this case the specification, is provided by s. 71. The amendments referred to in this section are matters of substance for the validity of the invention may depend upon the success of the request. They can be made before or after the grant of the letters patent. They relate to three specific forms of amendment. They do not relate to a mistake for instance in the form of request caused by the omission of the written consent of a joint holder or a mortgagor or mortgagee. Such a mistake could be corrected by the commissioner allowing the request to be amended under reg. 147. To my mind reg. 147 is directed to authorizing the commissioner to amend documents and correct irregularities in procedure where an application is made by a person entitled to apply for a patent for an invention and there is some mistake in the documents which relate to the application or some irregularity in the steps which are taken for the purpose of obtaining letters patent for the invention. The regulation does not in express terms limit the powers of the commissioner to the period between the lodging of the application and the grant of the letters patent and there does not appear to me to be any justification for making any such implication. The applications and letters patent of which Martin seeks an amendment are documents which came into being as part of the proceedings under the Act over which the commissioner has the general administrative control and they are therefore documents which can be amended pursuant to reg. 147.

During the argument the question arose whether the condition that the letters patent shall be void if it is made to appear that Martin is not the actual inventor of the inventions has any legal effect. The condition is an adaptation of an old condition inserted in letters patent granted to inventors by the Crown before the days of Patents Acts. The old condition said "if it is made to appear to us, our heirs or successors or any six or more of our Privy Council". The condition was imposed at a time when letters patent were only granted to actual inventors. If the person to whom the grant was made falsely represented to the Crown that he was the actual inventor whereas he was not, the grant was revoked by proceedings of *scire facias*. *Scire facias* was abolished by s. 86 (1) of the *Patents Act* which provides that no proceedings by way of *scire facias*

shall be taken to repeal a patent. Section 86 is the section of the *Patents Act* which provides for the revocation of patents. Subsection (3) provides that every ground on which a patent might at common law be repealed by *scire facias* shall be available as a ground of revocation. So it would seem that at least in proceedings for revocation the validity of the letters patent granted to Martin might be attacked for breach of the condition or in other words on the ground that the representation that he was the actual inventor was false. The proviso in which the condition is contained provides that the letters patent shall be void if it is made to appear that the patentee is not the actual inventor of the invention. The proviso does not state to whom it must be made to appear but it must refer to the Court in which the proceedings are taking place. The proviso also provides that the letters patent shall be, that is shall then become, void. Probably the letters patent could only be avoided for breach of the condition in proceedings for revocation and the ground could not be taken as a defence in proceedings for infringement. But this is by no means certain and it is not necessary or even wise to decide any of these questions in the present proceedings. The fact that Martin is at least in jeopardy gives him a sufficient interest to make the requests. It was also suggested during the argument that the effect of the condition may be to invalidate the letters patent *ab initio* so that they are already void and this invalidity cannot be cured by any subsequent amendment. But the condition is quite explicit that the letters patent shall be void if it is made to appear that the patentee is not the actual inventor of the invention and, if the mistake can be cured before it is made so to appear to the Court in proceedings for revocation or possibly for infringement, this ground of possible invalidity will disappear.

Regulation 147 only empowers the commissioner to allow documents to be amended. It does not empower him to allow the whole character of a document to be altered. The *Statute of Monopolies* (1623) (Imp.) (21 Jac. I. c. 3), which forms the basis of patent law, only excepts the first and true inventors of new manufactures from the prohibition of monopolies. But s. 32 of the *Patents Act* allows other persons than the actual inventors of new manufactures to apply for letters patent. Such persons include the assignee of the inventor. Martin has misdescribed himself in the present applications and the amendments asked for would merely cure that misdescription. The essence of the matter is that he is the person entitled to apply for the letters patent and to authorize the amendments asked for would merely give effect to the purpose of the

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Patents Act. An amendment of Martin's applications, and consequential amendments of the subsequent documents including the letters patent, would do nothing more than allow the person who is really entitled to apply for the letters patent to place his applications and the subsequent documents in order.

For these reasons I would make the rule nisi for the writ of mandamus absolute and stand over generally the motion for rectification of the register with liberty to either party to apply to restore the motion to the list on seven days' notice to the other party. Martin who is *in petitorio* should be ordered to pay the costs of the commissioner in the proceedings before us.

WEBB J. As the respondent commissioner is satisfied, no doubt after sufficient investigation, that the prosecutor Martin acted in good faith in signing the applications for letters patent without filling in the black spaces to indicate that he was in each case the assignee and not the actual inventor, the possibilities of valid amendments should be explored thoroughly to ascertain whether the applications to this Court for a writ of mandamus to the commissioner and for rectification of the Register of Patents can properly be acceded to. However, I regret that, after giving the matter full consideration, I am unable to overcome the difficulty which is presented at the outset by the fact that in the first proviso in the letters patent, the form of which appears in the First Schedule to the *Patents Act* 1903-1950, Parliament has revealed its intention that, in the events that have happened here, as sworn to by the patentee himself, i.e., the prosecutor, the letters patent should be void, and has done so without adding the qualification that the letters patent should be void subject to any provision in the Act or the regulations to the contrary. This intention is just as effectively revealed in the form of the letters patent in the schedule to the Act as if it appeared in the Act itself. To hold then that there is a power to amend so as to make valid these void letters patent would be to disregard that intention.

It appears to me that it is immaterial that the amendments are sought to be made in the letters patent only after and in consequence of the amendment of the applications. It is conceded by counsel for the applicant that the letters patent must be amended before any rectification of the Register of Patents is ordered under s. 30; and he submits that the applications should be amended before or concurrently with the letters patent. But Parliament's intention is, I think, a bar, whatever the course taken.

In the face of this initial and insuperable difficulty it is unnecessary to determine the nature of the prosecutor's error, i.e., whether it was a clerical error or otherwise, or the scope of the powers of amendment in the Act and regulations, and more particularly in s. 117 and reg. 147. Those powers, however broad, do not include authority to disregard Parliament's intention.

It may be that, pending revocation under s. 86, letters patent void under the first proviso must be treated merely as voidable, even when the vitiating and unalterable fact is disclosed by the patentee and prosecutor. But, although the purpose of amendments is to render documents efficacious, still I do not see how the fact, if it be the fact, that until revoked the document is voidable only warrants the conclusion that it can be rendered valid contrary to the intention of Parliament as revealed without qualification. To hold that the document is voidable is not to affirm that it is amendable.

I would discharge the order nisi for mandamus and dismiss the application under s. 30 for rectification of the register.

FULLAGAR J. Two proceedings are before the Court. The first is an application for a writ of mandamus directing the commissioner to hear and determine applications for the making of certain amendments in certain documents. The second is a motion under s. 30 of the *Patents Act* 1903-1950 for an order for rectification of the Register of Patents. Both applications arise out of the same set of circumstances, and have for their object the remedying of an unfortunate mistake which occurred in and about the applications for letters patent Nos. 136,148 and 136,296. So far as the application for mandamus is concerned, the commissioner, on application made to him, indicated that, if it had been a matter of discretion, he would have been disposed to make the amendments sought, but he was of opinion that he had no power under the Act or the regulations so to do.

The material formally before the Court was to some extent elaborated by certain information put before the Court by counsel for the applicant and accepted by counsel for the commissioner. Before briefly summarizing the position, it is necessary to refer to certain forms which have been prescribed by the regulations made under the Act. Regulation 4 (2) provides that the forms contained in the Second Schedule may, so far as they are applicable, be used in any proceeding to which they are appropriate. The Second Schedule contains a number of forms which are appropriate, in various circumstances, to applications for letters patent. Two of

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these are material. The first is Form A. This form is appropriate to an application originating in Australia by an actual inventor or his assignee, agent, attorney or nominee. After the formal words of application, the form proceeds:—"And I do hereby declare that I am.....the actual inventor of the said invention". A marginal note indicates that there should be inserted in the blank space "The Actual Inventor . . .; the Assignee, Agent, Attorney or Nominee of the Actual Inventor". If, of course, the applicant is any person other than the actual inventor, the words, "the actual inventor of the said invention", ought to be deleted, but this obvious fact is not expressly indicated. Actually it is clear, in view of the marginal direction, that those words ought not to appear printed in the form at all. The second material form is Form A6, which is appropriate to an application under international or intercolonial arrangements—what is commonly called a "convention application" (s. 121). This form does not provide for any statement as to the capacity in which the applicant applies—whether as actual inventor, assignee, or otherwise. It merely provides for the applicant to declare that he has made a "foreign" application and to give the date thereof. This is so although, since 1921, the legal representative or assignee of a foreign applicant is entitled to the benefit of s. 121. Both Form A and Form A6 conclude with the words: "And I make this declaration conscientiously believing it to be true".

In the present case the original application by Martin for letters patent was a "convention application" for a patent bearing the same date as an application in the United Kingdom. The form of application was prepared in England, and it stated that the actual inventor was Laszlo Jozsef Biro and that the applicant, Martin, was Biro's assignee. However, because the appropriate Form A6 did not require a statement of the capacity in which the applicant sought a patent for his invention, the form of application was subsequently altered by excluding these particulars, and was lodged in its altered form. The invention for which protection was sought was described as an invention relating to "improvements in writing instruments and inks". So far a correct course had been followed. It would appear, however, that the examiners reported adversely to the convention application as such, on the ground that it was not for the same invention as the English application. It was then decided to abandon the claim to convention priority, and to make the application as one originating in Australia. But another objection appeared in that the specification was regarded by the Patents Office as relating not to one invention but to two. In the end two

applications were made by Martin as applications originating in Australia—one for an invention relating to “improvements in writing instruments”, and the other for an invention relating to “improvements in inks”. For each of these Form A in the Second Schedule to the regulations was used. But, instead of inserting after the words “I am” the words “the assignee of Laszlo Jozsef Biro” the blank space was left blank, and the words “the actual inventor of the said invention” were left standing. This statement was not true. The truth appears to be that Biro was the actual inventor of the one invention, that Biro and Martin were joint inventors of the other invention, and that Martin was the assignee of both inventions.

In due course two patents were granted and issued on the two applications. The one was for an invention “for improvements in writing instruments”, and the other for an invention “for improvements in inks”. Section 65 of the *Patents Act* 1903-1950 provides that “a patent *may* be in the form in the First Schedule”. Each of the two patents in fact followed the form in the First Schedule to the Act. Accordingly the letters patent in each case recite that the patentee “has made a declaration in the prescribed form that he is the actual inventor of the said invention”. This recital is, of course, perfectly true and correct. The application for the patent in each case did follow the prescribed form, it did declare that the applicant was the actual inventor of the invention, and it ended with the words: “I make this declaration conscientiously believing it to be true”. Following further the form in the First Schedule to the Act, the letters patent in each case contain, immediately after the words of grant, what purports to be a proviso. It is in the following terms:—“Provided always that these letters patent . . . shall be void if it is made to appear that this grant is contrary to law or is prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention, or that the said patentee is not (the actual inventor of the said invention)”. Each grant was duly entered in the Register of Patents as a grant in the form of the letters patent themselves.

It is thus seen that a mis-statement which was made in each application is recited in the resultant grant, which purports by a proviso to make the truth of that statement a condition of validity, and the recital and the proviso are reproduced in the record of the grant in the register. It is matter for comment that no evidence was given by the person actually and directly responsible for the mistake as to how it came to be made. The course of events does not explain itself with any high degree of clarity. It appears that

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Mr. Martin has caused to be made many applications for patents in respect of what are known as ball-point pens and writing fluids for use therewith, and that in some cases he has been the actual inventor and in other cases the assignee either of an invention made by Biro or of an invention made jointly by himself and Biro. These facts may have been a potential source of confusion. Both Form A and Form A6 are badly constructed, if not positively misleading, but no high degree of skill is required of the user of them. In any case, there is no suggestion of any intention to deceive or mislead, and, however the mistake came to be made, it is accepted by the commissioner that it was simply a matter of inadvertence or carelessness. It may be added that—since in Australia an assignee of an invention may be an original grantee of a patent—the matter might not appear to be intrinsically of any great practical importance.

The desire of the patentee, however, to rectify the position, if it can by any means be rectified, is readily understandable. For the letters patent themselves are expressed to be subject to a proviso that they shall be void if it is made to appear that the patentee is not the actual inventor. In the old form the words used were “made to appear to Us, Our heirs or successors or any six or more of Our Privy Council”. As to these words see *Wallace & Williamson, Law of Letters Patent for Inventions* (1900), pp. 22-23. It would seem clear that the words of the proviso in the present case have no independent effect. Section 65 merely provides that a patent *may* be in the form in the First Schedule. And a patent can only be revoked by petition under s. 86 of the Act, which provides that no proceeding by way of *scire facias* shall be taken to repeal a patent. On the other hand, that same section provides that every ground on which a patent might at common law be repealed by *scire facias* shall be available as a ground for a petition to the High Court or the Supreme Court of a State for revocation, and those grounds include the ground that the patent was obtained on a false suggestion or representation: cf. s. 100 of the *Patents Act* 1952 (which has been enacted by Parliament, but has not yet been proclaimed), and see the Report of the Attorney-General’s Committee (1952), p. 33. It would appear to be at least a tenable view (though there seems to be no definite authority on the subject, and this is certainly not the place to form or express any opinion on the point) that, where the suggestion or representation did not relate to the subject matter of the invention, and not only was innocent but was immaterial in the sense that it did not affect the applicant’s right to the grant, it would not

provide a ground for revocation or afford a defence in an action for infringement. H. C. OF A.
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It is in the light of this general survey that the present applications of the patentee must be approached. In the case of each of his patents, he asked for "leave to amend" his application so as to describe himself as an assignee instead of the actual inventor. In the second place, he asked for "an amendment of the original letters patent" by the insertion of words describing him as an assignee, or—the "or" should be "and"—such other amendment as would make the letters patent accord with the application when amended as sought. What was really sought was presumably an amendment of the letters patent so as to make them recite that he had made a declaration that he was an assignee of the invention—not that he was the actual inventor—and a further amendment so as to make the proviso purport to avoid the grant if it be made to appear that he is not an assignee of the invention—not if it be made to appear that he is not the actual inventor. It was argued that the necessary powers were conferred on the commissioner either by s. 117 of the Act or by reg. 147 of the regulations. The commissioner was not asked to amend the Register of Patents, but it was said that, after the application and the letters patent had been amended by the commissioner, this Court could and should exercise its jurisdiction under s. 30 of the Act, and make an order for such rectification of the register as would make it accord with the amended letters patent.

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Section 117 of the Act provides that the commissioner may on request in writing accompanied by the prescribed fee correct any clerical error in the Register of Patents or in any proceedings under the Act, but no fee shall be required in respect of any correction necessitated solely by error in the Patent Office. Regulation 147 provides that any document, for the amending of which no special provision is made by the Act, may be amended, and any irregularity in procedure, which in the opinion of the commissioner may be obviated without detriment to the interests of any person, may be corrected, if, and on such terms as, the commissioner thinks fit. Section 30 of the Act provides that if it is made to appear to the High Court or the Supreme Court that any entry is wrongly omitted from or made in the Register of Patents, then on complaint of any party aggrieved an order may be made for such rectification as is just, and on service of the order on the commissioner he shall rectify the Register of Patents accordingly.

There are, in my opinion, decisive considerations in this case, which do not depend on an examination of the precise scope and

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effect of any of these provisions. It is desirable, however, to consider for a moment s. 117 of the Act and reg. 147.

So far as s. 117 of the Act is concerned, I can see nothing wrong with the view which the commissioner took. He said:—"So far as the Register is concerned, no error, clerical or otherwise has been shown to exist. The entries prescribed by s. 20 have been made in the Register, and they accord with the particulars in the application and the letters patent granted thereon . . . So far as 'any proceedings' are concerned, I do not consider that I can regard the application for a patent as a proceeding at this stage: it ceased to be a proceeding when that for which it applied was granted". And he quoted a passage from the judgment of *Luxmoore J.* (as he then was), in *In the Matter of an Application for a Patent by Imperial Chemical Industries Ltd., Fawcett and Walker* (1). There was in truth no relevant proceeding in the Patents Office at the relevant time. But, even if this be too narrow a view, the error in the application cannot, in my opinion, be described as a "clerical error". That expression is, no doubt, one of a somewhat elastic character, but it seems to me impossible to say that it covers such a mistake of substance as was here made. In the New Oxford Dictionary one meaning attributed to the word "clerical" is "Of or pertaining to a clerk or penman: esp. in 'clerical error', an error made in writing anything out". According to Webster, one meaning of the word "clerical" is "Of or relating to a clerk or copyist", and an example given is "clerical error, an error made in copying or writing". Probably no one would deny that a clerical error may produce a significant, and even profound, effect as for example, in a case in which a writer or typist inadvertently omits the small word "not". But the characteristic of a clerical error is not that it is in itself trivial or unimportant, but that it arises in the mechanical process of writing or transcribing. There is no evidence that the mistake so arose in the present case, and it is very difficult to see how it could have so arisen. The mistake, however innocently made, consists in a simple mis-statement of fact, and that is the whole of the matter.

With regard to reg. 147, I do not myself think that it is a valid regulation. It seems to me to be in exactly the same case as the regulation which was held invalid in *Morton v. Union Steamship Co. of New Zealand Ltd.* (2). When the Act contains a number of specific provisions for the amendment of documents, a regulation cannot, under the general power conferred by s. 108,

(1) (1935) 53 R.P.C. 157, at p. 159.

(2) (1951) 83 C.L.R. 402.

authorize the amendment of any document for which no provision is made. The Act must be taken to have provided for all such amendments as the legislature considered proper. It may be noted that by s. 177 of the *Patents Act* 1952 (which, as has been said, is not yet law) a specific power is given to make such a regulation. In the absence of such a specific power, I do not see how such a regulation can be supported. The two most important documents which come into existence under the Act are the letters patent themselves and the complete specification. For amendment of the latter the Act makes exhaustive provisions. It contains no provision whatever for the amendment of the letters patent themselves. I would not think it possible to hold that, in these circumstances, a regulation under the general power given by s. 108 could give to the commissioner an unlimited power, or any power, to amend so important a document. To adapt what was said in *Morton's Case* (1) the conferring of such a power involves a new step in policy.

But, apart altogether from any question of the effect of s. 117 or the validity of reg. 147, it appears to me that the commissioner was entirely right when he said that it would surely be improper for him, by altering the application, in effect to *create* an error in the register, which he could not alter. The considerations which lie behind what the commissioner said serve indeed to reveal the reality of the position and the true nature of what the patentee seeks. The truth is that the amendment of documents is a course entirely inappropriate to the situation which has arisen, and a course which, so far as I can see, could not affect that situation in any way. It is a fact that letters patent have been granted, and they bear a certain date. It is a fact that those letters patent were granted on an application in which the patentee declared that he was the actual inventor of the invention to which they relate. It is quite impossible to undo or annihilate those facts. The application has completely performed its function, and done its work for better or worse. I should (though, of course, I express no opinion on the point) be reluctant, on the material before us, to think that what has happened provides a ground for saying that the patent is invalid. But either it is valid or it is invalid. If it is valid, no steps of any kind are necessary. If it is invalid, no steps of any kind can be effective. For it was in fact granted on the declaration in fact made, and nothing can alter those facts. What is really sought by the patentee here is to have something done which will create a state of falsity in the letters patent and

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in the register, by making it appear that the patent was granted on a declaration on which it was not in fact granted. The application contains an error of fact. But the letters patent and the register contain, as the commissioner said, no error of any kind. The effect of what is sought would be to correct the application, but to falsify the patent and the register. I cannot think that this can be done. If the power existed, it could not properly be exercised.

One may look at the matter from another angle, starting with the same inescapable dilemma. Either the patent is valid or it is invalid. Let it be supposed that it is invalid, but that (contrary to what I regard as the plainly correct view) alterations can be made in the documents which will have the effect of validating it. In the meantime, i.e., since 21st June 1945, any person in Australia has (on the assumption made) been at liberty to make, use, exercise and vend the invention. For aught we know, some one or more persons may have been doing so. How could the commissioner be satisfied, as he must be satisfied under reg. 147, that the patent may be validated "without detriment to the interests of any person"? The more one examines the implications of the patentee's application the clearer it seems to become that it is out of the question that it should be granted.

I have not examined the effect of s. 30 of the Act, because it was (rightly, I think) only in order to give relief ancillary to action by the commissioner that the jurisdiction of this Court under that section was invoked.

In my opinion, the order nisi for mandamus should be discharged, and the motion should be dismissed.

KITTO J. I have had the advantage of reading the judgment of my brother *Fullagar*. I agree with it and have nothing to add.

TAYLOR J. I am in agreement with the reasons prepared by *Fullagar* J. which I have had a full opportunity of considering. Accordingly I agree that the order nisi should be discharged and the motion dismissed.

*Order nisi for mandamus discharged with costs and
the motion dismissed with costs.*

Solicitors for the prosecutor, *Moule Hamilton & Derham*.

Solicitor for the respondent, *D. D. Bell*, Crown Solicitor for the Commonwealth.

R. D. B.