Foll *International Business Machines Corporation v Smith* (1991) 105 ALR 388

Foll *Elconnex Pty Ltd v Gerard Industries Pty Ltd* (1991) 22 IPR 551

Appl *Aust Solar Mesh Sales Pty Ltd v Tomlin Industries Pty Ltd* (1991) 21 IPR 447

Cons *Elconnex Pty Ltd v Gerard Industries Pty Ltd* (1991) 32 FCR 491

Aff *Martin v Scribal Pty Ltd* (1956) 95 CLR 213

Appl *Kornelis' Kunsthars Producten Industrie BV v W R Grace & Co* (1994) 28 IPR 471

Appl *Stanway Oyster Cylinders Pty Ltd v Marks* (1996) 35 IPR 71

Appl *Leonardis v Santas No 1 Pty Ltd* (1996) 35 IPR 23

Appl *Raychem Ltd v Global Lightning Technologies Pty Ltd* (1996) 36 IPR 572

Appl *Stanway Oyster Cylinders Pty Ltd v Marks* (1996) 144 ALR 627

Appl *Genetics Institute Inc v Kirin-Amgen Inc (No3)* (1998) 41 IPR 325

Appl *Innovative Agricultural Products v Crawshaw* (1996) 35 IPR 643

Appl *Stanway Oyster Cylinders Pty Ltd v Marks* (1996) 66 FCR 577

[HIGH COURT OF AUSTRALIA.]

MARTIN . . . . . APPELLANT;
PLAINTIFF,

AND

SCRIBAL PROPRIETARY LIMITED . . RESPONDENT.
DEFENDANT,

SCRIBAL PROPRIETARY LIMITED . APPELLANT;
DEFENDANT,

AND

MARTIN . . . . . RESPONDENT.
PLAINTIFF,

ON APPEAL FROM THE SUPREME COURT OF VICTORIA.

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MELBOURNE
March 3, 4, 5, 9, 10, 11, 12; *Sept.* 14.

Dixon C.J. Fullagar and Taylor JJ.

Patents—Specification—Ambiguity—Construction—Amendment in Patents Office—Effect to claim different invention—Acceptance by commissioner—Conclusiveness—Evidence that patentee not in possession of invention patented at date of application—Patents Act 1903-1950 (*No.* 21 *of* 1903—*No.* 80 *of* 1950), *ss.* 45, 46.

Section 46 of the *Patents Act* 1903-1950 provided that " If the commissioner is satisfied that no objection exists to the specification on the ground that the invention is already patented in the Commonwealth or in any State or is already the subject of any prior application for a patent in the Commonwealth or in any State he shall in the absence of any other lawful ground of objection accept the application and specification without any condition, but if he is not so satisfied he may either . . . ".

A specification filed in December 1943 with an application for a patent for a ball-pointed pen was amended from time to time under s. 45 of the *Patents Act* 1903-1950 until finally accepted under s. 46 in June 1949. In its final form it claimed an invention different from that claimed in its original form. As accepted, the specification, after referring to a capillary tube proceeded " in which when charged with viscous ink, a continuous liquid vein is maintained extending from the ball and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir ". In an

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action for infringement it appeared that neither the pen the subject of the patent nor the pen which allegedly infringed would maintain a continuous liquid vein for longer than a short period if held upwards at a certain angle.

Held that while the acceptance of a specification by the commissioner under s. 46 was discretionary and beyond challenge as such, it did not preclude an attack on the patent on any ground on which a patent might be held invalid. Looking at the specification as it had existed from time to time, an inference arose, in the absence of countervailing evidence, that the invention as patented was not in the possession of the patentee at the time of the application.

Held, further, that the patent was not invalidated on the ground of ambiguity in the words in the specification " particularly that portion adjacent the ball ".

Held further, that the specification must be read as meaning that a continuous liquid vein of viscous ink was maintained under normal conditions of user of a pen. The conditions under which the pen alleged to infringe the patent did not maintain such a vein were not normal.

A specification described an invention for a ball-pointed pen " in which the ink reservoir is formed by one or more conduits starting at an air intake, and after following an ' extended path ', communicating with the recess for said ball . . . ".

Held, that a patent granted on the specification was not infringed by a ball-pointed pen having a straight conduit. *Martin* v. *Selsdon Fountain Pen Co. Ltd.* (1949) 66 R.P.C. 193 referred to.

Decision of the Supreme Court of Victoria (*Sholl* J.) affirmed, in part on different grounds.

APPEAL from the Supreme Court of Victoria.

On 8th December 1943 Henry George Martin applied to the Commissioner of Patents for a patent, which, when issued, was numbered 122073. The application and complete specification were accepted on 21st August 1946 and the acceptance advertised on 5th September 1946.

The complete specification was as follows :—

" Improvements in writing instruments."

I, Henry George Martin, British Subject, Public Accountant, resident of Avenida Roque Saenz Pena No. 547, Buenos Aires, Argentina, whose post office address is Avenida Roque Saenz Pena No. 547, Buenos Aires, Argentina, hereby declare this invention and the manner in which it is to be performed, to be fully described and ascertained in and by the following statement :—

This invention relates to improvements in fountain pens of the ball-tip type, and particularly to means for providing a regular ink

feed to the ball constituting the active or writing element of said instrument.

The most suitable ink for ball-tip fountain pens is so-called " dense " ink, which is very adhesive, and the ball, in rotating, will transfer to the exterior a regular and sufficient quantity to make neat and normal strokes.

Although dense, such ink is sufficiently fluid to pass through small orifices, and it is therefore difficult to prevent leakage while still providing a permanently open air intake and one object of this invention is to prevent leakage even when the pen is held with the air intake downwardly.

In the case of a barrel-shaped reservoir, the mass of ink will change its position as the instrument is moved about, so that when the tip of the pen is raised contact between the ink and the ball is lost, with the result that normal working of the instrument may be interrupted or impaired; another object of the invention is to overcome this difficulty.

Another object of this invention is to provide an ink reservoir wherein gravity does not alter the position of the ink and wherein the charge is kept in a satisfactory condition and forms a continuous vein of liquid to provide a continuous feed as and when required without delay or interruption.

A still further object is to provide an ink reservoir of simple structure which will at the same time be strong.

A still further object is to provide means for replacing the charge of ink by having detachable reservoirs.

A still further object is to provide a simple writing instrument of the fountain pen type which will not require auxiliary means for causing the ink to reach the writing ball.

According to the present invention an instrument of the ball-tip type is provided in which the ink reservoir is formed by one or more conduits starting at an air intake, and after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intakes under the effect of gravity.

According to one method of carrying the invention into effect the ink reservoir is constituted by one or more conduits arranged in the form of a helical coil.

The above and other objects and advantages of the present invention will become apparent from the following description, when read in conjunction with the accompanying drawings illustrating, by way of example some of the preferred embodiments of the

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invention, and wherein :—Figure 1 is a view of one form of the writing instrument, partially in section so as to disclose the interior thereof; Figure 2 is a cross-sectional view taken along the line N-N of fig. 1 ; Figure 3 is a schematic view of the helical conduit constituting the ink reservoir of another form of writing instrument ; Figure 4 and Figure 5 show further embodiments ; Figure 6 is a schematic view of another form of conduit ; Figure 7 shows a further embodiment, wherein the reservoir is constituted by a detachable member within the fountain pen casing ; and Figure 8 is a view showing the separation of the reservoir.

The same reference characters are used to indicate like or corresponding parts or elements throughout the drawings.

As may be seen from the drawings *a* is the casing of the writing instrument terminating in a tip *b* carrying the writing ball 1. This ball is suitably mounted so as to project sufficiently to engage the writing surface. The ball is held by its housing 2 sufficiently tightly to form a closure but the ball is free to rotate and hold a coating of ink which will pass out of the instrument when the ball is rotated in writing.

In order to constitute the housing for said ball 1, said tip *b* is provided with a recess 3 with which the ink feeding channel 4 receiving the liquid from the reservoir *c* communicates.

Said reservoir *c* is constituted by at least one conduit 5, which is preferably helical and, as shown in the drawings, starts at the air intake 6, extending to the feeder 4.

In the embodiment of fig. 1, the reservoir *c* is formed by combining a body 7 and a cylinder 8 constituted by the casing *a*. For this purpose, said body 7 is threaded so as to provide a helical channel 5′. The throat of said channel 5′ is relatively small, for example of a section of less than 5 mm.2. The body 7 will co-operate with the cylinder 8 so that when the body 7 is housed within said cylinder, the channels 5′ will be closed by the said cylinder 8. Under these conditions, said channels 5′ will form a coil-like conduit capable of containing a continuous vein of liquid ink.

In the schematic embodiment in fig. 3, the conduit is constituted by a tube having a small section made in the form of a helical coil.

The embodiment shown in fig. 4 comprises a helical conduit similar to that of fig. 1, but with the difference that channel 5′ is formed by a screw-thread provided on the inner wall of cylinder 8. In this case, the body 7 is smooth and upon being inserted into the threaded wall forming the channel 5′, said body 7 will close the channel and form a helical conduit 5, capable of containing a vein of liquid ink, extending from the air intake 6 to the feeding channel

4. In this embodiment the air intake 6 is protected by a cap 9 having an orifice 6′.

Figure 5 shows a further embodiment of the invention, similar to that of fig. 1 in that the reservoir consists of a conduit formed by a cylinder 8 and body 7, except that in this instance, the threaded body 7 has two adjacent channels following the same helical course, after the fashion of a screw with two threads. The starting point of each channel will constitute an air intake 6, and both the screw threads terminate at the feeding channel 4, as shown.

Figure 6 illustrates a further embodiment of the invention, wherein the conduit 5, instead of being helical, is formed by annular convolutions which are not circumferentially closed, but communicate in series so as to form a coil which, when charged with ink, will contain a vein of liquid extending from the air intake 6 to the feeding channel for said ball 1.

In the embodiment of figs. 7 and 8, the reservoir *c* is formed in a member which is independent of the casing *a* and detachably housed within the said casing. In this instance, the reservoir *c* is formed by a member *c* having a cylinder 10 terminating in a nozzle 10′, through which the tube 4′ of feeder 4 is screwed. Within said cylinder 10 is a body 7 which being threaded as in the embodiment of fig. 1 co-operates with the walls of said cylinder 10 so as to form a helical conduit 5 terminating at the tube 4′ so that when charged with ink, it will contain a vein of liquid which will reach the ball 1 in the same manner as in the previous embodiments.

Inasmuch as the casing *a* will serve as a casing for the member *c′* constituting the reservoir *c*, it will be sufficient to detach said casing as shown in fig. 8, in order to remove the member *c′*. In order to remove said member *c′* it should be unscrewed from tube 4′ when it will be free for removal and replacement. Thus, when the ink in the fountain pen has been exhausted, the charge may be replaced through the simple replacement of said member *c′* and body 7 together constituting the reservoir.

From the foregoing it may be seen that in any of the embodiments illustrated in the different figures, the reservoir *c′* is constituted by a conduit starting at the air intake 6 and ending at the feed channel 4.

In charging the writing instrument with dense ink, all the cavities of the system constituted by the channels should be filled, or, in other words, there should be a full charge, from the air intake 6 to the ball 1.

Inasmuch as the conduit 5 of said reservoir *c* is of small section, when charged with ink it will contain an uninterrupted vein of

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liquid, as if it constituted an extension of channel 4. Due to this and other relatively adjusted arrangement of said ball 1 in the setting 2, whereby the tip of the instrument remains closed, the ink cannot discharge by gravity.

Notwithstanding the adjustment of the setting 2, the ball 1 will act as an intermediary means between the ink charge and the writing surface, since due to the adhesive properties of the ink, upon rotating said ball it will be coated therewith, said coating passing out of the instrument so as to define perfectly regular strokes.

As the ink is used through use of the instrument, the charge in the form of a vein of liquid will be displaced so as to occupy the space of the portion carried out by the ball.

Said vein of liquid remains uninterrupted and is displaced as a whole the rear terminal thereof being in contact with the atmosphere by means of said air intake 6, and therefore the continuity thereof will subsist as the ink is used, and there will be no risk of interruptions.

The vein of ink reaches the ball through the feeding channel 4, and is always in contact therewith so that the feed will be permanent and the instrument will at all times be ready for use.

Inasmuch as the reservoir *c* is formed by a coil of small section the instrument may be placed in any position and used in any manner without the vein of liquid being affected by gravity.

It is obvious that in carrying the invention into practice, several changes in construction and detail will occur, to those skilled in the art, without departing from the scope of the invention as clearly set forth in the appended claims.

Having now fully described and ascertained my said invention and the manner in which it is to be performed, I declare that what I claim is :—

1. Improvements in writing instruments of the ball-tip type, wherein the ink reservoir of said instrument is formed by one or more conduits starting at an air intake and, after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intake under the effect of gravity.

2. Improvements in writing instruments as claimed in claim 1 wherein the conduit or conduits constituting the reservoir is or are in the shape of a helical coil.

3. Improvements in writing instruments as claimed in claim 1 or claim 2, wherein the conduit forming the ink reservoir is formed

by the combination of a threaded body snugly fitted within a cylinder formed by the casing of the instrument.

4. Improvements in writing instruments as claimed in claim 1 or 2 wherein the conduit forming the ink reservoir is formed by the combination of a body snugly fitted within an inwardly threaded cylinder constituting the casing of the instrument.

5. Improvements in writing instruments as claimed in claim 1 wherein said reservoir is constituted by a plurality of helical conduits terminating at the feed channels for said ball.

6. Improvements in writing instruments as claimed in claim 1, wherein said ink reservoir is formed within a member detachably fitted within the casing of said instrument.

7. Improvements in writing instruments as claimed in claim 1 and 6 wherein said member fitted within said casing is screwed to a tube constituting an extension of the ball feeding channel.

8. Improvements in writing instruments as claimed in claim 1, wherein the conduit of said reservoir is formed by unclosed annular convolutions successively communicating with each other.

9. Improvements in writing instruments as claimed in claim 1, wherein said conduit is smaller than 5 mm.2 in section.

On 31st December 1943 the above-named Henry George Martin applied to the Commissioner of Patents for a patent which when issued was numbered 133163.

The complete specification was as follows :—

"Improvements in writing instruments."

I, Henry George Martin, British Subject, Public Accountant, resident of Avenida Roque Sanez Pena No. 547, Buenos Aires, Argentina, whose post office address is Avenida Roque Sanez Pena No. 547, Buenos Aires, Argentina, hereby declare this invention, and the manner in which it is to be performed to be fully described and ascertained in and by the following statement :—

This invention relates to fountain pens and refers more particularly to fountain pens of the kind which comprise an ink reservoir formed by an extension of the channel for supplying the writing point with ink, a system which by itself has yielded convenient results, although under certain conditions of arrangement only, which should duly be taken into account when considering the further development of the industry.

In fact, the extension of the feed channel for constituting the reservoir by means of a duct of small section allows of establishing a fluid vein of constant position, after the manner of an automatically replaceable lead rod in a pencil, but, in the provision of a duct of a

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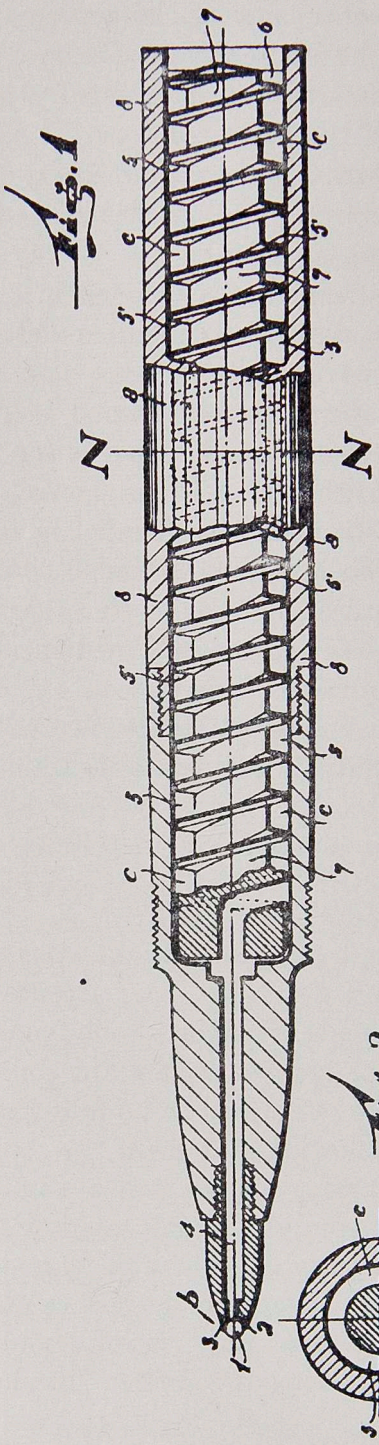

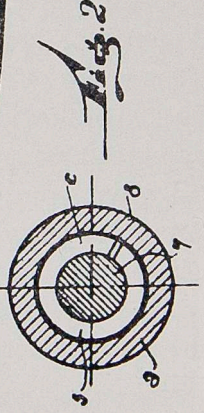

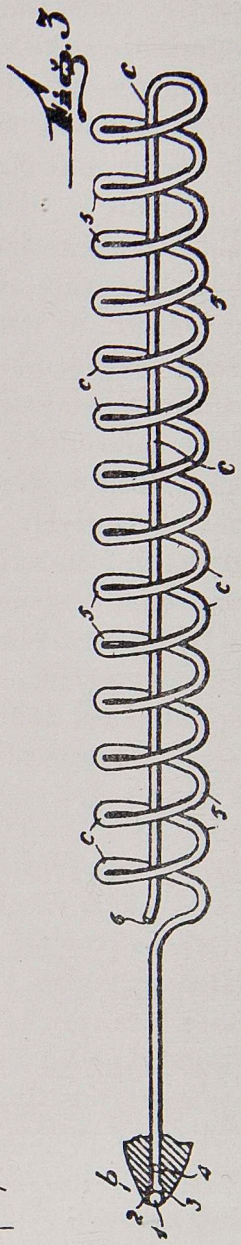

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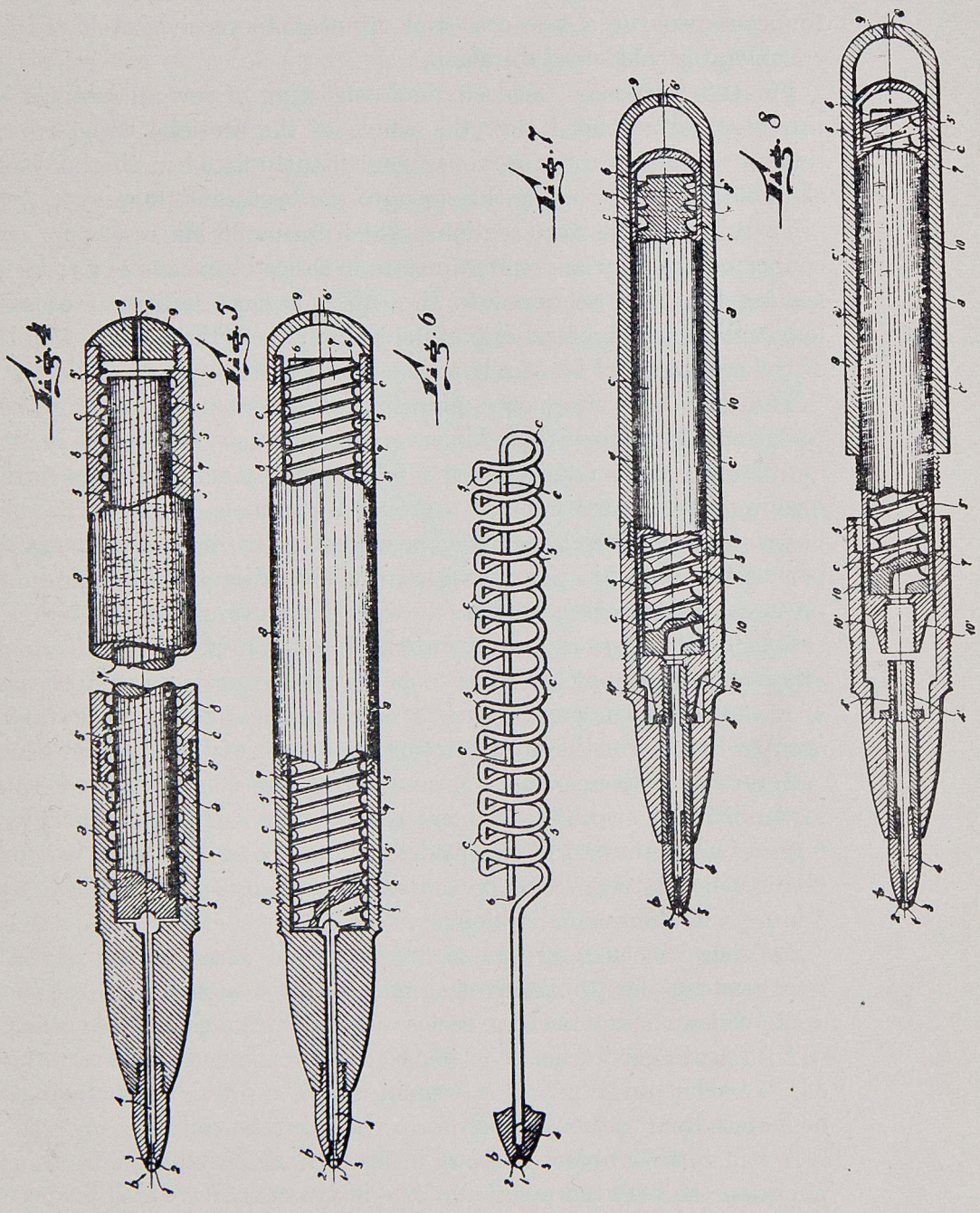

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certain length adapted to be fed with a relatively ample amount, several difficulties are encountered, owing to the necessity of arranging the duct in a winding or meandering form, or of otherwise arranging the same in such a way that it will occupy to the largest possible extent the capacity of the holder of the instrument.

In accordance with this invention, these difficulties are overcome in a rather simple way, thereby allowing of the manufacture of fountain pens at a low cost and adapted to receive a charge of considerable yield and duration.

For this purpose, a feed channel consisting of several sections is provided, so arranged that the whole of the sections will form a series or group of duct sections, conveniently fitted in the body of the holder, thereby using the space to the best advantage.

To this end, the duct sections, which form the ink reservoir, are connected together and communicate in series by means of passages leading from one section into the other, and as said sections are longitudinal and preferably parallel to the axis of the pen, the whole of the sections will be of a length several times that of the holder.

The duct consisting of a plurality of sections for forming the reservoir may be constructed in several manners, as use may be made indifferently of a capillary tube folded into several lengths until forming a series or whole, or a group of channels or ducts may be bored in a block which may then be connected to, or form an integral part of the fountain pen, provided the several sections of the duct be connected in series, so that one will be a continuation of another.

Besides the objects above stated, this invention also has other aims in view, among which is to be noted a reservoir in the shape of a vein of great length, with a minimum number of bends and occupying most of the body part of the holder of the fountain pen.

A further object consists in simplifying the construction of the instrument by arranging the ink reservoir as a channel which by forming an extension of the feed duct for the stylographic ball or point, will constitute the longitudinal sections by simply bending or folding the same into a block.

Another object tends to secure a simple arrangement of the reservoir, by the provision of simple boring designed to form the ducts which communicate in series, one a continuation of the other.

A further object of the invention consists in using the very material of the holder of the pen as a basis in which to provide the channels or longitudinal sections which form the ink reservoir.

A still further object consists in preventing gravitation from influencing the reserved position of the instrument, for which purpose

the end of the air intake of the duct is positioned to project toward the writing point of the pen.

Other objects of the invention will appear when considering the detailed description of the same, which for purposes of clearness and ready understanding has been illustrated in several figures showing, by way of example, some preferred embodiments of the improved fountain pen. In said drawings: Figure 1 illustrates a general view of the arrangement of the fountain pen, showing in particular the series or group of tubular sections which, by communicating in series, form the ink reservoir which occupies the greater part of the body of the holder: in this case, the ink reservoir consists of a tube bent into sections grouped to form a series. Figure 2 is a diagrammatic representation of the embodiment shown in fig. 1, illustrating the manner of establishing a communication in series between the several sections of the duct, one a continuation of the other. Figure 3 shows a longitudinal section of another design of fountain pen, wherein the group of duct sections is constituted by longitudinal borings provided in the very body of the holder, said duct sections being connected one to another in continuous communication, in order to obtain the series for forming the fluid vein when filling the same with ink. Figure 4 illustrates a cross-section on the line N-N of fig. 3, showing the manner of communicating the several sections by means of passages, for obtaining the series and forming the duct which is to constitute the ink reservoir. Figure 5 shows a cross-section on the line S-S fig. 3, illustrating the opposite part of the communications between the sections which forms the series or whole of the duct. Figure 6 is a diagrammatic representation of the embodiment of figs. 3, 4 and 5, giving a clear idea of the group of duct sections which by continuous communication of one with another form the series which constitute the duct serving as an ink reservoir. Figure 7 shows a perspective of another embodiment of the invention consisting of a group or series of duct sections formed by a striated body placed within a jacket or envelope which forms the body of the pen holder, said sections inter-communicating by means of passages by which to secure the arrangement in series for obtaining an ink reservoir in shape of the whole of the ducts: and finally, Figure 8 is a cross-section of the body of the pen, according to the construction shown in the foregoing fig. 7.

The same numbers and letters of reference have been used to indicate like or corresponding parts in all the several views.

As will be seen by referring to the drawings, *a* is the body part of the pen or holder, properly ending with a point 1, at which, by

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means of a suitable mounting 2, the small sphere or ball 3 is adapted, which forms the writing element, said sphere being in contact with the ink supplied by the feed channel 4 which, in turn, receives its supply from the reservoir *b*.

As already stated before, the reservoir *b* is formed by a duct forming an extension of the feed channel 4, but comprising several particular features which constitute the basis of this invention.

In fact, said reservoir *b* is formed by a linear duct, constituted by a plurality of lengths or duct sections 5, preferably arranged as a whole and parallel to the body of the holder *a*, thus forming a series or group of duct sections which together occupy the greater part of the body *a*; said sections 5 are connected together and communicate in series, one in continuation of the other, so as to form, as a whole, one single channel commencing at the inlet or air intake 6 and ending at the feed duct 4 of the sphere 3.

This invention is adapted for construction in many ways, among which are to be particularly noted the embodiments shown in the several figures of the accompanying drawings.

In the embodiment according to fig. 1, the reservoir *b* is formed by a duct or tube of the capillary type, which, being connected to the feed channel 4, extends parallel to the holder *a*, and as the tube is folded several times by a bend through 180°, the same will form a group of reduced length formed by several sections 5, with the bends 5′ establishing communication between the several sections, so that all of the same will be connected in series. The whole of sections 5 forms a series housed within the holder *a*, which in this case is hollow.

The duct which forms the reservoir *b* is filled with a dense or semi-fluid ink, thus establishing a fluid vein extending from a point near the inlet or air intake 6 to the sphere 3, which is thus maintained in contact with the ink, in order that when causing the same to roll over a suitable surface, the sphere held by its mounting 2, will mark the strokes with the ink supplied from the channel containing said liquid vein.

In the embodiment of figs. 3, 4 and 5 the reservoir *b* is also formed by lengths or sections 5, but in this case, said sections are established by borings provided in the body of the holder *a*.

Said borings extend longitudinally in a parallel arrangement, so that the whole of sections or ducts 5 will form a group. The borings or sections 5 are closed at both ends, viz: by means of the head piece *c*, corresponding with the point 1, and the head piece *d* which forms a sort of butt. The body part *c* is threaded at 7 into the

body *a*, while the body *d* is threaded at 8 into said body *a*, as may be seen when referring to fig. 3.

In spite of the closure established by the body parts *c* and *d*, the channel sections 5 are enabled to communicate with each other, although in a particular manner, that is to say, each section 5 communicates with another section by means of a passage 5′, so that all the sections will form a continuation in series, wherein the duct sections 5 will be connected, as shown in fig. 6, in continuation one with another by means of said passages 5′ and thus form one single linear duct.

One of the duct sections, indicated at 5″, ends with an inlet 6 which forms an air intake, directed towards the end of the point 1, but at a certain distance short of the same : this arrangement has for its object the prevention of the ink, when the pen is in a reversed position from being discharged by gravitation, whilst the section situated along the axial line of the instrument is that which is in direct communication with the feed duct 4.

In the embodiment in accordance with figs. 3, 4, 5 and 6, when filling the reservoir with ink, a liquid vein is established also in the corresponding duct, which must be maintained without interruption up to the sphere 3, in order to serve as a fountain for feeding the ink.

With reference, finally, to the embodiment shown in figs. 7 and 8, it will be seen that the reservoir *b* consists of a striated body *e*, arranged to fit snugly within the walls surrounding the cavity *a′* of the body *a*, which in this case is of tubular shape.

Said striated body *e* is formed with longitudinal grooves which together with the walls of the cavity *a′* constitute the duct sections 5, thus arranged to form a group or series.

In the case shown in figs. 7 and 8, the whole of the striated body *e* fitted in the envelope *a* is complemented by the body parts *c* and *d*, connected thereto by screwing at 7 and 8, in a manner similar to that shown in fig. 3 : and the same as in the former case, the duct sections 5 communicate one with another in series, so as to obtain a linear duct for forming the reservoir *b*. The body *a* is axially provided with a bore which, by communicating in series with the other sections, forms the last section 5, for connection to the feed duct 4 which ends at the sphere 3.

As in the foregoing cases, this embodiment is charged with a dense ink, so as to establish a continual liquid vein, ending at the mounting piece of the sphere 3, for feeding the latter as a fountain pen.

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From the foregoing description, it will be seen that the invention substantially consists in the provision of sectional ducts 5, arranged as a whole to form a series or group, by means of bends or passages 5′, said duct sections communicating in series, one in continuation of another, so that the whole of duct sections will form one single duct, commencing at an inlet hole 6 and ending at a feed duct 4, connected to the mounting of the sphere, said duct constituting the reservoir *b*, to be filled with a dense or semi-fluid ink and to form therewith an uninterrupted liquid vein, extending to the mounting 2 of the sphere 3. Said duct sections may be formed by lengths of tubes, borings or by a combination of such elements, as illustrated by the embodiments shown in the several figures of the accompanying drawings.

It should be understood that instead of a sphere, the stylographic point may comprise a pen or other common or known writing means.

It will also be evident that in carrying the invention into practice, modifications may be introduced with regard to certain details of construction and shape of the fountain pen, without departing from the basic principles of the invention, to be clearly set forth in the claims hereto annexed.

Having now fully described and ascertained my said invention and the manner in which it is to be performed, I declare that what I claim is :—

1. Fountain pen, of the type in which the ink reservoir is an extension duct of the feed channel for the stylographic point, characterized by the fact that the duct which forms the ink reservoir consists of a series or group of duct sections, provided with means for communicating in series one section with another, so as to form one single linear duct or channel, extending from an inlet open to the air, to the feed channel of said stylographic point.

2. Fountain pen, in which the duct, which constitutes the ink reservoir, is formed by a series or group of duct sections connected together and communicating in series by means of communication passages from one section to another, so as to form one single channel, from the inlet, open to the air, to the feed channel of the stylographic point, characterized by the duct sections being arranged parallel one to another and longitudinally within the body of the pen holder, said sections being, in turn, parallel to the axis of said body of the holder.

3. Fountain pen, in which the duct which constitutes the ink reservoir consists of a series or group of duct sections, connected together and communicating in series by communication passages extending from one section to another so as to form one single

channel from an inlet open to the air to feed channel of the stylographic point, characterized by the fact that the inlet or air intake of the duct which forms the reservoir, is directed towards the stylographic point at a certain distance from the same.

4. Fountain pen in which the duct which constitutes the ink reservoir consists of a group or series of duct sections connected together and communicating in series by communication passages from one section to another, so as to form one single channel from an inlet open to the air to the feed channel of the stylographic point, characterized by the fact that the series or group forming the whole of the duct sections of the ink reservoir occupies the greater part of the body of the holder proper of the fountain pen.

5. Fountain pen, in which the duct which constitutes the ink reservoir consists of a group or series of duct sections, connected together and communicating in series by means of communication passages from one section to another, so as to form one single channel extending from an inlet open to the air, to the feed channel of the stylographic point, characterized by the fact that the duct sections which form the general duct or reservoir proper consist of a tube folded several times with bends of 180° into sections of a length somewhat smaller than that of the holder of the pen said sections being arranged as a whole so as to form the series or group housed within the cavity of the holder of the fountain pen.

6. Fountain pen, in which the duct which constitutes the ink reservoir consists of a series or group of duct sections, connected together and communicating in series by means of communication passages, from one section to another, so as to form one single channel, extending from an inlet open to the air, to the feed channel of the stylographic point, characterized by the fact that the duct sections which form the general duct or reservoir proper consist of bores formed in the body of the pen holder, which, being arranged jointly, communicate with each other by their ends, so as to constitute a linear channel.

7. Fountain pen, in which the duct which constitutes the ink reservoir consists of a series or group of duct sections, connected together and communicating in series one with another by means of communication passages extending from one section to the other so as to form one single channel extending from an inlet open to the air, to the feed channel of the stylographic point, characterized by the fact that the communication passages of the duct sections are formed by recesses complemented by head pieces at both ends of the main body part of the holder of the fountain pen.

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8. Fountain pen, in which the duct which constitutes the ink reservoir consists of a series or group of duct sections, connected together and communicating in series by means of communication passages extending from one section to another, so as to form one single channel, extending from an inlet open to the air, to the feed channel of the stylographic point, characterized by the fact that the duct sections which form the general channel or reservoir proper, are constituted by longitudinal grooves formed in a body enclosed within the cavity of the holder, said grooves being provided at their ends with recesses which form the communication passages from one section to another.

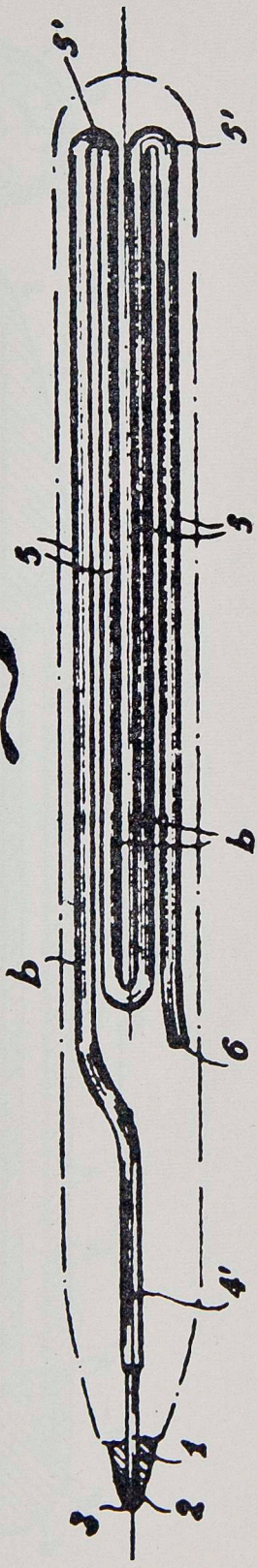
9. Fountain pen, in which the duct which constitutes the ink reservoir consists of a series or group of duct sections, connected together and communicating in series by means of communication passages extending from one section to another, so as to form one single channel, extending from an inlet open to the air, to the feed channel of the stylographic point, characterized by comprising a striated body housed within the holder, said strias or grooves forming the duct sections provided with communication passages extending from one to another, so as to constitute a general duct or channel, the whole of the grooves being headed by body parts adapted to both ends of the main body part of the holder of the fountain pen.

10. Fountain pen, in which the duct which constitutes the ink reservoir consists of a series or group of duct sections, connected together and communicating in series by means of communication passages extending from one section to another so as to form one single channel extending from an inlet open to the air to the feed channel of the stylographic point characterized by the fact that the channel or duct which forms the reservoir ends with a mounting provided with a small loose sphere which constitutes the writing point.

11. Fountain pen, in which the duct which constitutes the ink reservoir consists of a series or group of duct sections, connected together and communicating in series by means of communication passages extending from one section to another, so as to form one single duct or channel, extending from an inlet open to the air, to the feed channel of the stylographic point, with a charge of dense ink filling the entire extension of said general duct formed by said sections, said charge constituting an uninterrupted liquid vein extending to the stylographic point, all as above described, for the purpose set forth and with reference to the accompanying drawings.

Fig. 1

Fig. 2



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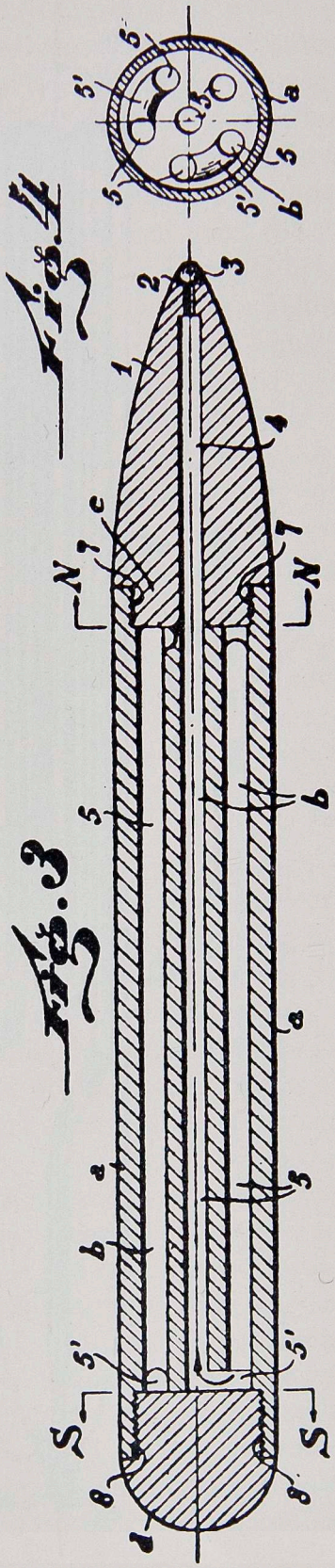

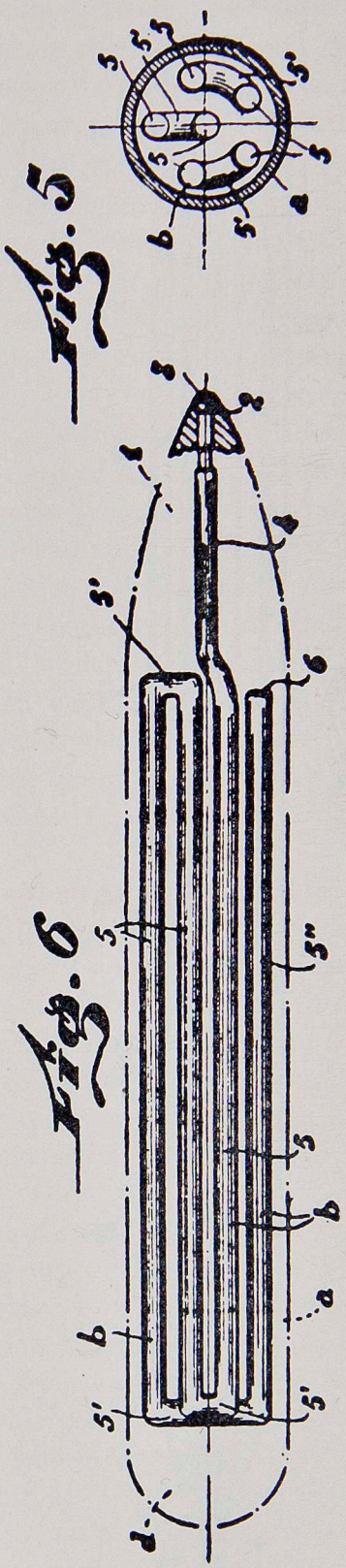

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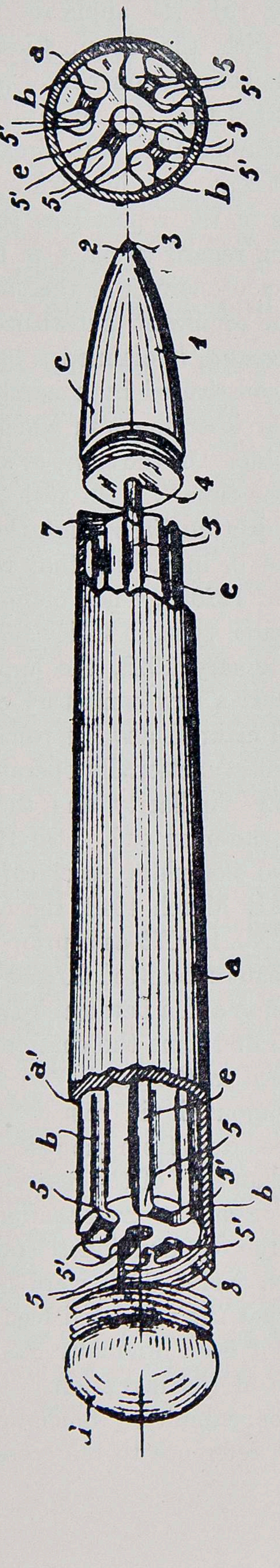
Fig. 8

Fig. 7



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On 10th October 1944 the applicant lodged amended drawings of his invention with the Commissioner of Patents. On 2nd December 1946, the commissioner informed the applicant that the examiner had reported that the invention the subject of the application of 31st December 1943 was already the subject of a prior application for a patent, viz., his own application for No. 122073, and that the basis of the report was that the earlier application " claimed "—having regard to fig. 6 in the complete specification thereof—the subject of claim 1 of the later application. On 18th December 1946, the applicant substituted a completely rewritten specification. *Inter alia*, it claimed a ball-point pen in which the ink reservoir was constituted by a capillary tube (claim 1); and separately, a similar instrument in which the tube communicated with the ball by a duct " of the same or smaller cross-sectional area or diameter than the tube ". On 26th August 1947, the commissioner stated the objection (*inter alia*), that the meaning of " capillary tube " was not defined, and that the invention was already patented under No. 122073, since claims 1-3 thereof claimed an instrument of the same type, in which the reservoir was a capillary tube. On 28th January 1948, the applicant submitted amendments which included a new consistory clause and a new claim 1, which however still claimed any instrument in which (irrespective of shape) the reservoir functionally operated by capillarity to maintain supply, and by capillarity and the viscosity of the ink to prevent leakage at the open end. On 19th February 1948, under s. 38A, the original complete specification lodged in 1943 was advertised. On 11th March 1948, the commissioner repeated his objection based on No. 122073 as a prior patent. On 16th November 1948, the applicant submitted further amendments, particularly a new consistory clause and a new claim 1, which now each expressly put forward for the first time the combination of a vented tube of capillary size (defined in the text), " in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball ", with a feed duct from the reservoir to the ball, of a cross-sectional area less than that of the reservoir. The former claim 3", to a duct of equal or smaller cross-section, was omitted. On 24th December 1948, the commissioner stated (in effect) that his objections based on No. 122073 were removed by the proposed amendments, but that the restricted feed duct was not sufficiently described, nor had it been originally claimed, ascertained, or described as a feature of the invention. On 10th and 11th March 1949, the applicant submitted amendments, which (*inter alia*) introduced into the reference to the cross-section of the feed duct

the words, " particularly that portion adjacent the ball ", described the feed duct in the body of the specification, and amended the definition of " capillary tube ". On 27th April 1949, the commissioner approved these amendments, but required a clearer indication, in the drawings and in the references to the drawings, of the restricted feed duct. On 16th May 1949 the applicant submitted amendments which satisfied this requirement. The matter then proceeded on 14th June 1949, to acceptance, and on the 30th June 1949, to advertisement of acceptance.

The complete specification as finally accepted was as follows :—

" Improvements in writing instruments."

I, Henry George Martin, British Subject, Public Accountant, resident of Avenida Roque Saenz Pena, No. 547, Buenos Aires, Argentina, whose post office address is Avenida Roque Saenz Pena No. 547, Buenos Aires, Argentina, hereby declare this invention and the manner in which it is to be performed to be fully described and ascertained in and by the following statement :

This invention relates to writing instruments of the type in which a ball is mounted for rotation in a housing with part of the ball exposed and is supplied with ink from a suitable reservoir, the arrangement being such that as the ball is rotated such as by being moved relatively to and in contact with a writing surface the ball carries a quantity of ink through the housing, which ink is deposited on said surface and a trace is made.

An object of the present invention is to improve the construction of instruments of the aforesaid type. According to this invention, I provide an instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball, and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir. The expression " a vented tube of capillary size " is employed herein in relation to the reservoir of a writing instrument of the type specified to mean a tube having an internal bore of between 1 and 4 mm. (subject to a manufacturing tolerance of the order of +, —, 5%) so that when charged with a viscous ink the meniscus formed at the end of the ink column remote from the ball (at the interface between the ink, the air and the interior surface of the tube) is stable and will not break under shocks to which the instrument is subjected in normal use.

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The tube is preferably in the form of a series of limbs, each substantially parallel to the longitudinal axis of the instrument so that a comparatively long length of continuous tube can be accommodated in a comparatively small compass such as the usual type of fountain pen casing. The term "tube" as used herein where the context so permits includes a tube-like duct formed in a body.

In order that the nature of the invention may be more readily understood reference will now be made to the accompanying drawings in which :—Figure 1 is a cross-sectional view illustrating by way of example one embodiment of the present invention. Figure 2 is a diagrammatic representation of the embodiment illustrated in fig. 1. Figure 3 is a cross-sectional view illustrating another embodiment. Figure 4 is a cross-section on line N-N fig. 3. Figure 5 is a cross-section on line S-S fig. 3. Figure 6 is a diagrammatic representation of the embodiment illustrated in figs. 3, 4 and 5.

The same numbers and letters of reference have been used to indicate like or corresponding parts in all the several views.

As will be seen by referring to the drawing *a* is the body part of the pen or holder, terminating in a point 1, whereat by means of a suitable housing 2, the small sphere or ball 3 which forms the writing element is rotatably mounted with part of the ball exposed ; said ball is in contact with the ink supplied by the feed duct 4 which, in turn receives its supply from the reservoir *b*. The feed duct 4, or at least that portion adjacent the ball, is of lesser sectional area than that of the reservoir, as indicated in figs. 2, 3 and 6, where reference 4*a* denotes the relatively smaller cross-sectional portion of the feed duct. Similarly that portion of the feed duct of fig. 1 extending from a position such, for example, as indicated by line A to the ball recess will be of smaller cross-section than that of the reservoir.

While the ball may be of any appropriate size, it is preferably of a diameter in the order of 1m.m.

The reservoir *a* is formed by a duct, forming an extension of the feed duct 4, constituted by a plurality of lengths or duct sections 5, preferably arranged in parallel relationship to the longitudinal axis of the body of the holder *a* ; the reservoir thus forms a series or group of duct sections occupying the greater part of the body *a* ; said sections 5 are connected together and communicate in series, one in continuation of the other, so as to form, as a whole, one single channel, commencing at the inlet or air intake 6 and ending at the feed duct 4 of the ball 3.

This invention is adapted for construction in many ways, among which are to be particularly noted the embodiments shown in the several figures of the accompanying drawings.

In the embodiment according to fig. 1, the reservoir *b* is formed by a tube of capillary size which, being connected to the feed channel 4, extends parallel to the holder *a*, and as the tube is folded several times by a bend through 180°, the same will form a group of several sections 5 of reduced length with the bends 5′ establishing communication between the several sections, so that all of the sections are connected in series. The ink reservoir *b* is removably housed within the holder *a*, which in this case is hollow.

The duct which forms the reservoir *b* is filled with a viscous or semi-fluid ink, thus establishing a fluid vein extending when the reservoir is full from a point near the inlet or air intake 6 to the ball 3, which is in contact with the ink; consequently when the ball is rotated such as by being rolled over a suitable surface, the ball will make a trace with the ink supplied from the said liquid vein.

In the embodiment of figs. 3, 4, 5 and 6 the reservoir *b* is also formed by lengths or sections 5, but in this case, said sections are constituted by ducts formed in the body of the holder *a*.

Said ducts extend longitudinally in a parallel arrangement, and are closed at both ends, such as by means of the head piece *c*, constituting the point 1, and the head piece *d*. The head piece *c* is threaded at 7 into the body *a*, while the part *d* is threaded at 8 into said body *a*, as may be seen by referring to fig. 3.

As shown, the channel sections 5 are enabled to communicate with each other, by means of passages 5′, so that all the sections together form a continuous single linear duct.

One of the duct sections, indicated at 5″, ends with an air intake 6 preferably directed towards the point 1, but at a certain distance short of the same.

In the embodiment illustrated in figs. 3, 4, 5 and 6, when the instrument is filled with ink, a liquid vein is established which extends without interruption up to the ball 3.

In all the embodiments the duct is charged with a viscous ink so that a continuous liquid vein is formed communicating with the ball 3.

It will be evident that in carrying the invention into practice, modifications may be introduced with regard to certain details of construction and shape of the instrument, without departing from the basic principles of the invention as set forth in the claims hereto annexed.

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Having now fully described and ascertained my said invention and the manner in which it is to be performed, I declare that what I claim is :

1. An instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball, and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir.

2. An instrument according to claim 1 in which the tube is open to atmosphere at one end and the other end communicates with the ball.

3. An instrument according to any of the foregoing claims in which the tube is formed into limbs, substantially parallel to the longitudinal axis of the instrument.

4. An instrument according to claim 3 in which the open end of the tube is directed towards but does not extend to the ball.

5. An instrument according to any of the foregoing claims in which the ink reservoir is adapted to be removably received within a casing.

6. An instrument according to any of the claims 1-5 in which the tube is constituted by a duct formed in a body.

7. An instrument according to claim 6 in which a series of parallel ducts is formed in a body positioned within an outer casing, said ducts being each connected by a passage, an end closure being provided (removably or otherwise) at each end of said body, one end of one duct being open to atmosphere and the arrangement and disposition of the parts being such that there is formed a single linear duct extending from the opening to atmosphere to the ball.

8. An instrument according to any of the foregoing claims when charged with a viscous or semi-fluid ink.

9. An instrument constructed and arranged substantially as described herein with reference to the accompanying drawings.

On 9th May 1947 the above-named Henry George Martin brought an action (No. 314 of 1947) in the Supreme Court of Victoria against Scribal Pty. Ltd., a company incorporated in the State of Victoria, claiming that the defendant had infringed the first claiming clause of letters patent No. 122073 by the manufacture etc. of writing instruments known as the Scribal Combination Writer. The defendant, by its particulars of objection to the validity of the said patent, delivered with the defence on 10th June 1947, claimed *inter alia*, that the said first claiming clause by reason of the words

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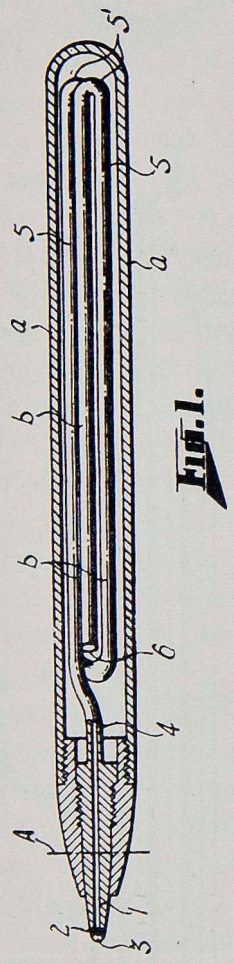

FIG. 1.

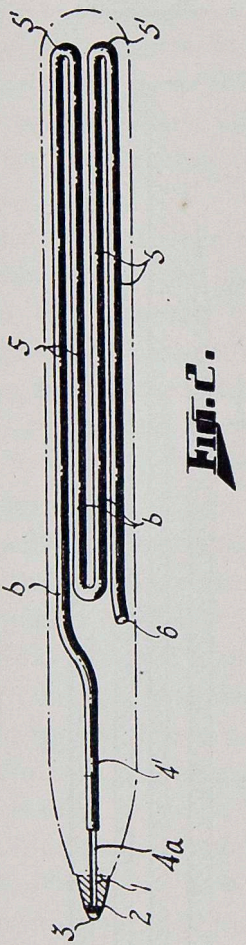

FIG. 2.

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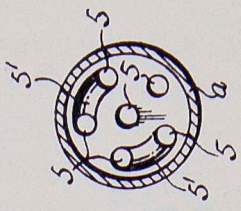

Fig. 4.

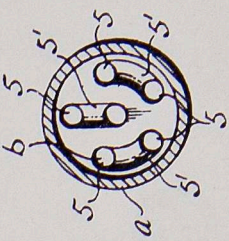

Fig. 5.

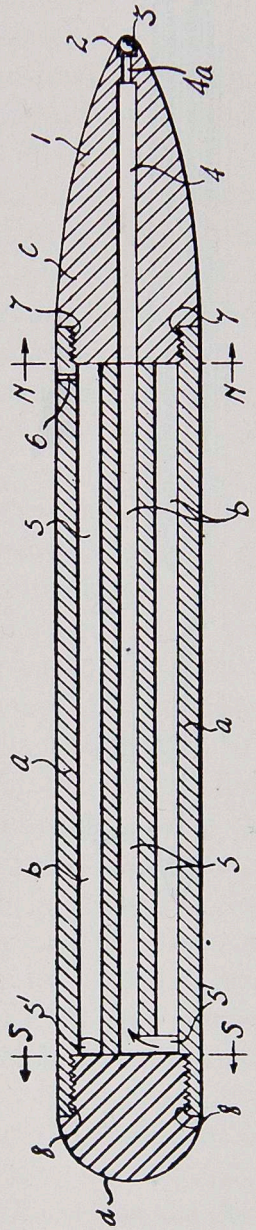

Fig. 3.

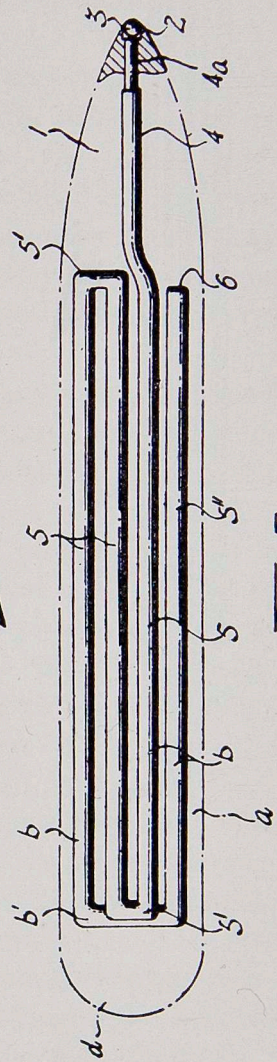

Fig. 6.

therein " an extended path " was vague, uncertain and ambiguous and did not sufficiently define the monopoly intended to be claimed thereby.

On 24th January 1951 the above-named plaintiff brought a further action (No. 58 of 1951) in the Supreme Court of Victoria against the above-named defendant claiming that it had infringed the first, second, fifth and eighth claiming clauses of letters patent No. 133163 by the manufacture etc. of writing instruments known as the Scribal Secretary Pen. By its defence delivered 19th July 1951 the defendant claimed that the said letters patent were, and had always been, invalid for the reasons set forth in the particulars of objections delivered with the defence.

The particulars of objection referred to in the defence were as follows :—1. The alleged invention was not proper subject matter for letters patent having regard to the common knowledge at the date thereof. 2. The alleged invention was obvious and did not involve any inventive step having regard to what was known or used prior to the date of the said letters patent with respect to fountain pens of the ball-tip type. 3. The claiming clauses relied on, namely the first, second, fifth and eighth claiming clauses of the plaintiff's letters patent, are each and every one of them, insufficient and vague uncertain and ambiguous and do not sufficiently or clearly define the monopoly intended to be thereby claimed. 4. (i) On 8th December 1943 the plaintiff made an application for a patent accompanied by a complete specification for an invention relating to improvements in fountain pens of the ball-tip type, and pursuant to the said application a grant of Australian letters patent numbered 122073 was made. (ii) On 31st December 1943 the plaintiff made an application for a patent accompanied by a complete specification for an invention relating to fountain pens and referring more particularly to fountain pens of the kind which comprise an ink reservoir formed by an extension of the channel for supplying the writing point with ink as further specified in the said complete specification, and after the happening of the events hereinafter set forth Australian letters patent numbered 133163 were purported to be granted on the said application. (iii) The complete specification of Australian letters patent numbered 122073 was published on 5th September 1946. (iiiA) The unamended complete specification of United Kingdom letters patent numbered 573747 dated 21st February 1944 became available for public inspection at the Patents Office Library, Canberra on 29th May 1946. (iv) On or about 18th December 1946 the plaintiff lodged in the Patents Office what purported to be but was not an amended

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complete specification as the complete specification accompanying the said application of 31st December 1943, but the said specification so lodged on or about 18th December 1946 described and claimed then as the invention something which was not the invention described and claimed in the complete specification previously lodged on 31st December 1943 as aforesaid but something substantially different therefrom which was the same as the invention described and claimed in the document referred to in sub-pars. (i) and (iii) hereof or was not new by reason of the matters alleged in sub-par. (iii) hereof. (ivA) The amended complete specification referred to in sub-par. (iv) hereof described and claimed the invention described and claimed in the document referred to in sub-par. (iiiA) hereof. (v) On 19th February 1948 the complete specification lodged on 31st December 1943 as aforesaid was notified as open for public inspection under and pursuant to s. 38A of the *Patents Act* 1903-1950. (vi) On some date at present unknown to the defendant the plaintiff lodged in the Patents Office what purported to be but were not further amendments to the said complete specification lodged on 31st December 1943 and such purported amendments described and claimed as the invention something which was not the invention described and claimed in the said complete specification so lodged on 31st December 1943 as aforesaid but something substantially different therefrom which was the same as the invention described and claimed in the document referred to in sub-pars. (i) and (iii) hereof or was not new by reason of the matters alleged in sub-par. (iii) hereof. (vii) On 14th June 1949 the Commissioner of Patents purported to allow the aforesaid amendments to the said complete specification lodged on 31st December 1943, and on 14th June 1949 the Deputy Commissioner of Patents purported to accept the complete specification in respect of the said Australian letters patent numbered 133163, which purported acceptance was advertised in the Australian Official Journal of Patents Trade Marks and Designs on 30th June 1949. (viiA) The complete specification referred to in sub-par. (vii) hereof described and claimed the invention described and claimed in the document referred to in sub-par. (iiiA) hereof. (viii) None of the matters set forth in sub-pars. (iv) to (vii) hereof inclusive was made known to the defendant or any other member of the public. (ix) The said amendments allowance and acceptance and each of them purported to be made as aforesaid are and were at all times ultra vires contrary to law invalid and of no effect, and no grant of Australian letters patent numbered 133163 should have been made and the said letters patent are of no legal effect. (x) The said purported amendments were made

by or at the instance of the plaintiff who is not entitled to rely thereon or on anything done pursuant thereto including the grant of the said letters patent. 5. The plaintiff as applicant for the grant of the said letters patent was not on 31st December 1943 in possession of the invention the subject matter of the letters patent ultimately granted as at that date and by reason thereof the grant thereof was made upon a false and improper and/or fraudulent suggestion and is and at all material times has been invalid void and of no effect. 6. On 31st December 1943 the invention (if any) the subject matter of the letters patent ultimately granted had not been made and by reason thereof neither the plaintiff nor any person by from or through whom or whose authority the plaintiff derived the right then to make application for letters patent was the actual inventor of the invention (if any) the subject matter of the latters patent ultimately granted.

Pursuant to a request by the plaintiff the defendant delivered the following further and better particulars of the allegations contained in par. 4 (ix) of the particulars of objection.

1. The facts matters and circumstances set out in the said par. 4 of the said particulars of objections herein. 2. Further the following facts matters and circumstances—(a) the said application and complete specification referred to in sub-par. (ii) of par. 4 of the said particulars of objections were pursuant to the provisions of the *Patents Act* 1903-1950 referred to an examiner in the Patents Office for report. (b) The examiner reported upon the said complete specification pursuant to the provisions of the said *Patents Act*. (c) The examiner reported adversely to the said complete specification upon the matters referred to in s. 41 of the said *Patents Act* and the plaintiff was informed thereof pursuant to s. 45 of the said *Patents Act*. (d) The plaintiff thereupon purported to amend the said complete specification pursuant to s. 45 of the said *Patents Act* and in so doing did what is alleged in sub-par. (iv) of par. 4 of the particulars of objection. (e) The amendments which the plaintiff purported as aforesaid to make to the said complete specification were not authorized by s. 45 of the said *Patents Act* in that there was substituted for the description of the alleged invention described in the said complete specification the description of a different invention as alleged in sub-par. (iv) of par. 4 of the particulars of objection and further the purported amendments went beyond the scope and ambit of the examiner's report and/or were not confined to the objections raised by the examiner and/or to complying with requisitions arising from the examiner's report but on the contrary had the effect alleged in the said sub-par. (iv)

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of par. 4 of the said particulars of objection. (f) The said specification was reported on again by the examiner pursuant to s. 45 of the said *Patents Act*. (g) The plaintiff thereupon purported to amend the said complete specification pursuant to s. 45 of the said *Patents Act* and in so doing did what is alleged in sub-par. (vi) of par. 4 of the particulars of objection. (h) The amendments which the plaintiff purported as aforesaid to make to the said complete specification were not authorized by s. 45 of the said *Patents Act* in that there was substituted for the description of the alleged invention described in the said complete specification the description of a different invention as alleged in sub-par. (vi) of par. 4 of the particulars of objection and further the purported amendments went beyond the scope and ambit of the examiner's report and/or were not confined to the objections raised by the examiner and/or to complying with requisitions arising from the examiner's report but on the contrary had the effect alleged in the said sub-par. (vi) of par. 4 of the said particulars of objection. (j) The said complete specification purporting to have been amended as aforesaid could not have been lawfully accepted nor could letters patent have been lawfully granted in respect of the alleged invention described therein.

The actions were heard together before *Sholl* J. On 15th June 1953 the trial judge made the following order :—" The allegations set out in par. 4 of the defendant's particulars of objections and in pars. 1 and 2 of the defendant's further particulars of objections so far as the same are allegations of fact, and par. 6 of the said particulars of objections so far as it depends exclusively upon the aforesaid allegations of fact, constitute a good defence in law to the plaintiff's claim herein to the following extent only and not otherwise, viz., so far as they allege that the effect of the amendments therein referred to or either of them was that the complete specification of the Letters Patent No. 133163 in its final form claimed an invention (a) substantially different from the invention described and disclosed by the complete specification originally lodged with the application dated 31st December 1943 or (b) identical with the invention described and claimed respectively in the complete specification of Letters Patent No. 122073. And that par. 5 of the said particulars of objections, so far as it depends exclusively upon the said allegations of fact, does not constitute such a good defence."

On 22nd June 1953 the trial judge ordered :—" That the allegations of the defendant the subject of judgment dated 15th June 1953 so far only as they are the subject of such judgment and allege a good defence in law to the plaintiff's claim herein are not established

and that accordingly par. 5 of the defendant's defence herein to that extent fails."

On 28th September 1953 the High Court granted to the defendant special leave to appeal from the orders dated 15th, 22nd June 1953.

On 28th July 1953, in a written judgment *Sholl* J. held (a) that the defendant had not infringed patent No. 122073 because the reservoir of the allegedly infringing pen, being in the form of a straight capillary tube, was not within any of the claims ; (b) that patent No. 133161 was invalid by reason of ambiguity in the words " the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir " ; (c) that, in any event patent No. 133161 was not infringed by the defendant's pen which was not one in which " when charged with viscous ink a continuous liquid vein is maintained extending from the ball " in all conditions of normal user.

On 28th September 1953 the High Court granted to the plaintiff special leave to appeal from the judgments delivered on 28th July 1953.

The plaintiff's and defendant's respective appeals were heard together by the High Court.

Sir *Garfield Barwick* Q.C. (with him *P. D. Phillips* Q.C., and *G. A. Pape*), for Martin on the plaintiff's appeal.

As to patent No. 122073. There is nothing in the description of the preferred methods that leads to the conclusion that the unstraight nature of the tube is of the essence of the invention. In *Martin* v. *Selsdon Fountain Pen Co. Ltd.* (1), *Harman* J. followed an inadmissible course in construing the specification, firstly by resorting to unpublished amendments and secondly by inquiring what the inventor thought he meant rather than ascertaining the meaning of what he had said. The meaning of extend is to lay out at full length. The natural meaning of " following an extended path " does not involve turning or bending. As to patent No. 133161. In relation to the expression " having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir " it is clear that the reservoir was regarded as continuous from the ball outwards to the air and that the feed duct is part of the duct which is regarded as having the function of feeding the ink, as distinct from storing it. It would be a mistake to approach the language as if the reservoir was devoted wholly to storage and

(1) (1949) 66 R.P.C. 193.

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the feed duct devoted wholly to feeding the ink; the correct approach is to regard the whole as a sort of pipe line which is performing both functions. The precise point at which the one function predominates over the other is indefinite and immaterial. The direction is to reduce the size of the one tube or duct at the point near the ball. The length of the reduced section is indicated to be itself immaterial. The trial judge found no infringement because there was a circumstance or situation in which the liquid vein would not be maintained continuously from the ball to the air inlet in the normal use of the instrument as a writing instrument. But it is not normal use of a pen to write with it held at a high angle or vertically upwards.

D. I. Menzies Q.C. (with him *R. L. Gilbert*), for Scribal Pty. Ltd. on the plaintiff's appeal. In relation to patent No. 122073 the question is whether the claim as it stands covers a straight tube. A straight line joining two points is not following an extended path between those points. All the descriptions and the drawings lead to the conclusion that the tube has to be coiled in some way. The plaintiff never appreciated at any material time that a straight capillary tube would be a satisfactory reservoir. [He referred to *Martin* v. *Selsdon Fountain Pen Co. Ltd.* (1).] It is permissible in construing a specification to have regard to amendments made in the Patents Office. [He referred to *Moser* v. *Marsden* (2).] As to patent No. 133161. This patent is invalid because the claim made is ambiguous. [He referred to *Terrell and Shelley on Patents*, 9th ed. (1951), p. 96; *Natural Colour Kinematograph Co. Ltd.* (*In Liquidation*) v. *Bioschemes Ltd.* (3).] The ambiguity is in the words "the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir." It is impossible to know what is meant by "particularly that portion adjacent to the ball" or to know what constitutes the feed duct as distinct from the reservoir. The specification further claims that a continuous liquid vein of ink is maintained extending from the ball. The defendant's pen does not possess this feature. [He referred to *Kraft* v. *McAnulty* (4); *Z Electric Lamp Co. Ltd.* v. *Marples Lead Co. Ltd.* (5).] It was open to the trial judge to find that writing with a pen above the horizontal constituted normal use.

(1) (1949) 66 R.P.C. 193.
(2) (1896) 13 R.P.C. 24, at p. 31.
(3) (1915) 32 R.P.C. 256, at pp. 266, 269.
(4) (1932) Q.S.R. 139.
(5) (1910) 27 R.P.C. 737.

Sir *Garfield Barwick* Q.C., in reply on the plaintiff's appeal. As to patent No. 122073, *Moser* v. *Marsden* (1) was a case of a Div. 4 amendment. In the case of such an amendment there are two published documents, the initial publication and the amendment. Notwithstanding Lord *Watson's obiter dictum* (2) it was decided in *George Hattersley & Sons Ltd.* v. *George Hodgson Ltd.* (3) that regard might not be had to deleted matter for the purpose of construction. The method of publication of a specification amended under Div. 4 is dealt with in *Terrell and Shelley on Patents*, 9th ed. (1951), pp. 208-209. There have been statutory changes in England, but so far as Australia is concerned the matter stands on the decision in *George Hattersley & Sons Ltd.* v. *George Hodgson Ltd.* (4). The case of an amendment to a specification in the Patents Office is different from a Div. 4 amendment in that the latter is circumscribed by what is explained, disclaimed or corrected. The former is not so limited: see *In re Serex's Patent* (5); *In re Coutant* (6). As to patent No. 133161. There is no warrant for the use of the amendments as an aid in construing the specification. [He referred to *Bowden Brake Co. Ltd.* v. *Bowden Wire Ltd.* (7).] The specification as it was finally accepted and published is alone to be considered. The words "having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir" means "having a feed duct from the reservoir, the cross-section of which is reduced as it approaches the ball".

D. I. Menzies Q.C. (with him *R. L. Gilbert*), for Scribal Pty. Ltd. on the defendant's appeal. In the case of patent No. 133161 the specification in its final form does not claim protection for the same invention as that for which protection was sought by the specification as originally lodged. In these circumstances a valid patent cannot be granted. The patentee's idea of his invention originally was to have a reservoir which twisted back upon itself in one way or another. The *Patents Act* is always concerned with a patent for one invention, and nowhere does it contemplate the substitution of a different invention for that for which protection was originally claimed: see ss. 33, 35, 36, 39, 40, 41, 45, 54 and Div. 4. It follows from ss. 30A, 54 and 69 that the Act gives protection from the date of the original specification. It is therefore not to be supposed that protection is given to an invention other

(1) (1896) 13 R.P.C. 24.
(2) (1896) 13 R.P.C., at p. 31.
(3) (1904) 21 R.P.C. 517, at p. 524.
(4) (1904) 21 R.P.C. 517.
(5) (1912) 29 R.P.C. 284, at p. 287.
(6) (1931) 48 R.P.C. 1.
(7) (1913) 30 R.P.C. 561, at p. 571.

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than that for which protection has been sought by the specification published. Section 51 makes it clear that examiners' reports prior to acceptance may be relevant, and this could only be on the basis of determining whether or not an amendment made in response to such reports is permissible. Division 4 contains an elaborate scheme for obtaining leave to amend and it is not surprising that by s. 79 the amendment, when made, should be conclusive. Under Div. 1 a right to amend is given to an applicant in certain circumstances, and there is no question of leave involved. In order to determine whether a specification in its final form seeks protection for the same invention as the specification lodged, the proper course is to construe each specification as a whole to find out what is the invention for which protection is sought and then compare the two inventions. By analogy this is borne out by (a) cases of disconfirmity. [He referred to *Dunlop* v. *Cooper* (1).] (b) Cases where the question for determination is whether a Div. 4 amendment is such that it makes the specification substantially larger or different from its form unamended. [He referred to *May & Baker Ltd.* v. *Boots Pure Drug Co. Ltd.* (2).] (c) Cases where the question, on convention applications, is whether the English specification is in confirmity with the foreign application. [He referred to *In re British Celanese Ltd.* (3).] The invention for which protection was sought in the specification as lodged was not the invention for which protection was sought in its final form. Moreover, at the time when the specification was amended, what was then described as the invention was not inventive nor was it novel by reason of the publication of the specification of United Kingdom letters patent No. 573747 on 29th May 1946 and the specification of patent No. 122073 on 5th September 1946. It is submitted that the Court will review what has happened in the Patents Office to determine whether or not what was done was validly done under the Act. The authorities establish that it was a defence in infringement proceedings to show that there had been an amendment not authorized by law. [He referred to *Ralston* v. *Smith* (4).] In 1865 there was no provision corresponding with s. 79 in the English Act. Further, the scheme of the *Patents Act* requires an applicant to be in possession of his invention at the date of application. The only way in which this can be ascertained is by looking at what he has said in his specification.

(1) (1908) 7 C.L.R. 146, at pp. 158, 172.

(2) (1948) 65 R.P.C. 255, at pp. 294, 296, 297, 299; (1948) 66 R.P.C. 8, at pp. 13, 14, 21; (1950) 67 R.P.C. 23, at pp. 28, 31, 32, 35, 38, 39.

(3) (1940) 58 R.P.C. 81, at pp. 84, 85, 88, 89.

(4) (1865) 11 H.L.C. 223, at pp. 238, 239, 243, 252, 253, 254, 255 [11 E.R. 1318, at pp. 1324-1326, 1329, 1330].

Sir *Garfield Barwick* Q.C. (with him *P. D. Phillips* Q.C. and *G. A. Pape*), for Martin, on the defendant's appeal. The amendments were made with the concurrence of the Commissioner of Patents. As such, they are not, under s. 79 of the Act, open to attack. The grant of letters patent may nevertheless be attacked on the ground that the applicant was not in possession of the invention at the time of the original application. If the amendments were made under s. 45 of the Act, the position is the same, since in making the acceptance the commissioner was bound to be satisfied subjectively of the non-existence of any lawful ground of objection to the specification accepted. [He referred to *In re Serex's Patent* (1); *In re Coutant* (2); *In re Thomson's Patent* (3).] It is clear that the inventor need not know the explanation of what he has invented or why the invention is a new process of manufacture. The claim did not emphasize the bent nature of the coil in the specification as being related to the maintenance of the fluid vein but merely as affording ample volume for storage of ink. Assuming everything against the inventor if, in his specification, he has disclosed a new process of manufacture, he is entitled to his patent. An analysis of the specification as originally lodged shows that there was disclosure of an invention which comprised the use of a capillary tube in association with a ball-point so as to maintain a constant liquid vein without regard to the shape of the tube.

D. I. Menzies Q.C., in reply on the defendant's appeal. In *Goldman* v. *Bramley* (4) the court examined the facts to ascertain whether or not s. 42 of the Act had been complied with. This is inconsistent with the view that the Court cannot, after acceptance, decide whether or not the power has been properly exercised. There are many cases in which, without successful opposition, the Commissioner of Patents has, after acceptance, refused a grant because of something which has come to his notice. [He referred to *In re H. A. Metz Laboratories Inc.* (5).] The effect of the cases on s. 18 of the English Act of 1883 before leave to amend was made conclusive is discussed in *Patent Law and Practice* by *Robert Frost*, 4th ed. (1912), vol. 2, pp. 103 et seq. and in *Terrell and Shelley on Patents*, 9th ed. (1951), pp. 195 et seq.

M. V. McInerney, for the Commissioner of Patents.

Cur. adv. vult.

(1) (1912) 29 R.P.C. 284.
(2) (1931) 48 R.P.C. 1.
(3) (1934) 51 R.P.C. 241, at p. 253.
(4) (1936) 55 C.L.R. 714.
(5) (1933) 50 R.P.C. 355, at p. 358.

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The following written judgments were delivered:—

DIXON C.J. The proceeding before us consists of two appeals and a cross-appeal, all argued together. The appeals are by the plaintiff from judgments of the Supreme Court of Victoria (*Sholl* J.) pronounced for the defendant in two actions for infringement of patents. One action (No. 314 of 1947) was commenced on 9th May 1947. It was based on a patent granted to the plaintiff as of 8th December 1943 which it was alleged the defendant had infringed. The action failed because it was held that on the proper construction of the specification there was no infringement. The second action (No. 58 of 1951) was commenced on 24th April 1951. It was based on a patent granted to the plaintiff as of 31st December 1943 which again the defendant was alleged to have infringed. This action failed on the ground that the claims were void for ambiguity and in any case that they were so constructed or expressed that no infringement was committed. The cross-appeal by the defendant relates to action No. 58 of 1951. It is an appeal by leave from part of an interlocutory order determining certain questions of law before the trial of the action and from a further interlocutory order determining certain issues before such trial.

The subject of both patents is a ball-pointed fountain pen employing viscous ink fed from the reservoir to the ball-tip. Each patent is for an alleged invention for a pen of this type. Neither specification indicates the principles which, as is now ascertained, govern the operation of such a pen or precisely how they apply. Much of the attack on the two patents flows from this circumstance. It is therefore as well to begin with an abstract description of the working of an ordinary ball-point pen. The ball which transfers the ink to the paper revolves in a collar. The inner revolving face is in contact with a column of viscous ink and carries the ink out as it rolls round so as to become the outer face of the ball. The reservoir which contains the column of viscous ink is a capillary tube or duct the diameter of which should not exceed 4 mm. The capillary tube is open to the air at the end furthest from the ball, or at all events at that end there is an air vent. At that end a concave meniscus is formed at the interface of the viscous fluid and the air. It is formed because of the surface tension of the liquid and its adhesion to the walls of the tube. The ball is very small. At the place where the viscous fluid is in contact with the ball the diameter of the vein is smaller and accordingly the meniscus of the surface of the viscous ink is of less radius. When the pen is turned down to write the ball suffices to overcome the effect of gravity. But when it is inverted the greater strength of the smaller meniscus,

or to state it more accurately, the decreased pressure at that surface and the atmospheric pressure operating over a greater surface at the other end, suffice to overcome gravity. The viscosity of the ink absorbs ordinary shocks which would break the meniscus of a more liquid ink. The result is to give a pen which will write until the vein of ink is exhausted and in which ordinary use will not interrupt or break the continuity of the vein. However if the pen is used to write vertically upwards or at a high angle the ball may lose contact with the ink and as the ball rotates draw in air causing a distortion of the meniscus and a consequent failure to sustain the weight of the column of ink. To restore the pen to its function it will be enough to point the pen downward again and write so as to rotate the ball. The ink will flow back to contact with the inner face of the ball and the pen will write again.

The first of the two patents put in suit (No. 122073) rests upon a specification which describes the invention it covers as relating to improvements in fountain pens of the ball-tip type and particularly to means for providing a regular ink feed to the ball constituting the active or writing element of such instrument. The specification in fact discloses, in the drawings and the text explaining them, a construction which on the foregoing principles would result in a workable pen. But no one reading the specification can escape the impression that the inventor had missed the more essential points of the construction and was relying on certain features which he introduced unnecessarily as forming an integral part of his invention. One of these features is the taking of the tube forming the reservoir through an extended path between the air vent and the ball. He insists on a tube or conduit that is extremely small but describes its size by saying that it must be " of so small a cross-section that a suitable ink cannot escape from the air intakes under the effects of gravity ". To explain the drawings the specification says that the throat of the channel is relatively small for example of a section of less than 5 mm. It does not say that it must be of capillary size. The conduit is always described and depicted as in helical coils or in unclosed annular convolutions. Though these two forms are not given as essential, there is an insistence on the conduit following an extended path starting at the air intake and ending at the recess for the ball, and of course the two forms of construction shown do give it the required " extended path ". Dense ink seems to be the only form of ink in contemplation but it is not definitely specified. A distinction is drawn at all events in some forms of construction between the conduit and a channel leading from the conduit to the ball. The specification says that, inasmuch as the

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conduit is of small section, when charged with ink it will contain an uninterrupted vein of liquid as if it constituted an extension of the channel. It proceeds to state that, due to this and other relatively adjusted arrangement of the ball in the setting for it whereby the tip of the instrument remains closed, the ink cannot be discharged by gravity. Notwithstanding this denial of the effects of gravity there follows a statement that, as the ink is used through the use of the instrument, the charge in the form of a vein of liquid will be displaced so as to occupy the space of the portion carried out by the ball. This is then explained on the ground that the vein of liquid remains uninterrupted and is displaced as a whole the rear terminal thereof being in contact with the atmosphere by means of the air intake and therefore the continuity thereof will subsist as the ink is used and there will be no risk of interruptions. It is not easy to suppose that the inventor thought that gravity had no part at all in this phenomenon. And yet he says later that, as the reservoir shown is formed by a coil of small section the instrument may be placed in any position and used in any manner without the vein of liquid being affected by gravity. It all reads as if the extension of the path of the tube by convolution or the like coupled with the exceedingly small diameter of the tube and the closure of the ball were relied upon to keep the vein of dense liquid within the pen when inverted and held with the ball upward.

The specification contains nothing amounting to a definition of the invention. Indeed where it might be expected that this would be done, there is found only a succession of objects which the invention achieves. Summarized they are: (1) to prevent even a dense ink leaking and to do so though the pen is held with the air intake down; (2) to overcome the difficulty that when a ball pen is held with the point up contact between the ball and the ink is lost; (3) to provide a reservoir in which the ink forms a continuous vein feeding the ball and its position is not altered by gravity; (4) to provide an ink reservoir at once strong and simple; (5) to provide detachable reservoirs so that the charge of ink may be replaced; (6) to provide a fountain pen without the need of auxiliary means to cause the ink to reach the ball. What no doubt purports to be a definition of the invention follows the statement of these objects. It begins with the traditional words "According to the present invention" and goes on—"an instrument of the ball-tip type is provided in which the ink reservoir is formed by one or more conduits starting at an air intake, and after following an extended path, communicating with the recess for said ball, the said conduit

or conduits being of so small a cross-section that a suitable ink cannot escape from the air intakes under the effect of gravity." What is presented here as the essential features—those things which he has introduced into pens of the ball-tip type—are the " extended path " and the small cross-section of the tube. There is no definition or clear indication of what amounts to an extended path and the cross-section is defined only in terms of a result and, at that, a result which actually the smallness of cross-section cannot alone produce.

The first claim, upon which the other claims depend, makes these two features essential. It is in the following terms : " 1. Improvements in writing instruments of the ball-tip type, wherein the ink reservoir of said instrument is formed by one or more conduits starting at an air intake and, after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intake under the effect of gravity."

Now the defendant's pen which is said to infringe has a straight tube or conduit. A straight conduit has many advantages not the least being those in manufacturing. The greater the length of the tube or conduit the greater in fact is the weight of the contents and, when the pen is inverted, the greater is the balance of the force of gravity which the surface tension at the meniscus near the ball is called upon to equalize. Apart from admitting a greater charge of ink the " extended path " of the plaintiff's tube or conduit does anything but contribute functionally to the invention. The inventor, however, clearly thought otherwise and therefore introduced it as an element into his claim. He maintains nevertheless that his claim covers the defendant's pen. He does so on the ground that the path may be extended though straight.

I agree with *Sholl* J. in thinking that this is not a tenable view of the meaning of the claim. It is of course true enough that there is nothing in the word " extended " *simpliciter* that is inappropriate to a straight tube. But a word seldom occurs *simpliciter*. Words are not used without a context and the difficulty is that the word " extended " is here applied to a path between two points. They are not points antecedently fixed, but they must both be placed somewhere in the barrel of a pen and what is specified is a tube following a path from one to the other that is " extended ". Place them as far apart as may be, nevertheless the tube connecting them cannot truly be said to make the connection " after following an extended path " if it goes by the shortest distance. Every word of the description in the body of the specification, the drawings themselves, and every part of the explanation of the drawings is

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based upon the assumption that the course will be helical annular convoluted or will otherwise meander. It is difficult to see how, when the claim speaks of one or more conduits starting at an air intake and, after following an extended path communicating with the recess for the ball, it could be read as covering a straight tube. This view was adopted by *Harman* J. in *Martin* v. *Selsdon Fountain Pen Co. Ltd.* (1). It is a view which of course results in a finding of no infringement and makes a consideration of the validity of patent No. 122073 unnecessary. On the ground that on the proper construction of the claims there was no infringement of this patent I think that the appeal from the judgment in action No. 314 of 1947 should be dismissed.

The patent upon which the second action is based, No. 133163, was granted for an invention described and ascertained by a complete specification accepted on 14th June 1949, although the application was made on 31st December 1943. The latter of course is the date as of which the monopoly takes effect. The complete specification was in fact the result of many amendments made during the passage through the Patents Office. One defence which the defendant has set up to the action upon this patent depends upon the history of the specification as it developed in the office. But the defences upon which the defendant succeeded in the Supreme Court arise upon the specification including the claims in the form the specification finally took. In the first instance, therefore, it is desirable to put aside the history of the development of the complete specification and to deal with the case upon the footing that the validity and effect of the patent and the issue of infringement depend upon the specification in the form in which it was accepted and made the subject of the grant of letters patent. It is a specification which, unlike No. 122073, does describe the features it embodies which in reality govern the working of the pen to which it relates. The invention is described by the specification as one relating to writing instruments of a type which it proceeds to define by reference to the following characteristics : (1) A ball is mounted for rotation in a housing with part of the ball exposed. (2) It is supplied with ink from a suitable reservoir. (3) The ball is rotated by its contact with the writing surface, carries a quantity of ink through the housing and deposits the ink on the surface of the paper. This general description is followed by something like a definition of the invention. It makes the three points that the tube is of capillary size, that it is to be charged with viscous ink, and that the capillary tube is to be vented, that is to say the column of ink is to

(1) (1949) 66 R.P.C. 193.

be in contact with the air at its upper extremity. But making, as it does, these three points, the specification proceeds to introduce two more which reappear in the claims and they provide a foundation for the two defences upon which the defendant has succeeded in the action. It is desirable to give the words in which these two features are described. After referring to the vented tube of capillary size the specification proceeds " in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent to the ball, being less than that of the reservoir." The two points lie in (1) the assertion that the pen maintains a continuous liquid vein extending from the ball, and (2) the reference to a feed duct and its characterization. As to the first the defendant denies that in all conditions of use the pen does maintain a continuous liquid vein extending from the ball. With reference to this it is hardly necessary to say that, unless during the process of writing the column of viscous ink is held in contact with the ball and in this sense extends from it, the pen will not mark the paper. As to the second the defendant contends that the description of the cross-sectional area of the duct is ambiguous and in respect of this feature does not disclose with sufficient precision what is the area of monopoly. As to the feature in question it is perhaps convenient before proceeding with the statement of the effect of the specification to recall that the meniscus at or in the vicinity of the ball-point must be of less radius than the meniscus of the tube formed at its other end if the charge of ink is to be held by both menisci against gravity when the pen is inverted and the point is uppermost.

The specification goes on to define the expression " vented tube of capillary size ". It means " a tube having an internal bore between 1 and 4 mm., subject to a manufacturing tolerance of the order of +, —, 5%, so that when charged with a viscous ink the meniscus formed at the end of the ink column remote from the ball (at the interface between the ink, the air and the interior surface of the tube) is stable and will not break under shocks to which the instrument is subject in normal use." No point that is material arises on this definition although it may be said perhaps that it does not make it clear that it is the viscosity of the ink which prevents the shocks from breaking down the menisci.

The drawings which, according to the specification, embody the invention disclose various constructions in which a tube is either housed in or made part of the barrel of a fountain pen which has a ball-tip housed as described. Close to the ball at distances varying

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in the different drawings there is a lessening of the diameter of the tube so as to make the duct of which the specification speaks. As has already been seen, for a pen to be effective in operation, the meniscus at the ball must be of less diameter than the meniscus at the other end of the column or vein of viscous ink, and this means a surface of less diameter than at the vented end of the tube or conduit. Physically the interpolation in the invention of a definite duct of less diameter than the tube is not necessary. At the same time it is one way of achieving an end which in any case the smallness of the ball inevitably would accomplish. The drawings in fact show the tube or conduit and its duct as taking a course up and down the barrel of the pen and not as a single straight tube; but in no place is there anything to indicate that a lengthening of the conduit or tube by the parallel arrangement up and down the tube is part of the invention. It is therefore not material in this action that the defendant's pen which the plaintiff says is an infringement comprises a single straight tube or conduit to form the reservoir for the viscous ink. But the specification does emphasize, and at more than one point, that there must be a continuity of the liquid vein from the ball. For example the description of the drawings ends with the statement that in all the embodiments the duct is charged with a viscous ink so that a continuous liquid vein is formed communicating with the ball.

Of the claims it is unnecessary to consider more than the first. The remaining claims of which the defendant's pen could possibly be considered an infringement are made to depend upon it. The first claim is as follows:—"1. An instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball, and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir." This claim has been held void by *Sholl* J. on the ground that it is ambiguous. His Honour considered that the words describing the cross-sectional area of the duct, especially the words "particluarly that portion adjacent to the ball", gave no sufficiently precise or certain understanding of the element of the claim manifested in or represented by the duct. The considerations regarded as causing the ambiguity may be briefly summarized as follows. The claim does not indicate how the duct is differentiated from the tube or conduit, except that the portion adjacent to the ball must be of less diameter. It does not indicate how much of the duct must be of less diameter. It does

not indicate whether the rest of the duct may be of the same diameter as the conduit or may be of greater diameter than the conduit or may be of less diameter than the conduit, although of greater diameter than the portion of the duct adjacent to the ball.

These doubts or difficulties as to the intention of the patentee are said to make his claim ambiguous. If we were concerned only with a written instrument operating *inter partes* and not generally these difficulties would easily be overcome by construction. But the principles governing the definition of a monopoly operating over the public at large require a description which is not reasonably capable of misunderstanding. If an ambiguity is purposely introduced in order to produce a vagueness in the boundaries of a monopoly this purposeful introduction of an ambiguity destroys the patent, whether the ambiguity be great or small. Here there is no reason to suppose that there was any such design. The following passage, however, in the judgment of Lord *Parker* (*Natural Colour Kinematograph Co. Ltd.* (*In liquidation*) v. *Bioschemes Ltd.* (1)) describes what is the duty of the court and provides the test of ambiguity :—" Further, though it may be true that in construing an instrument *inter partes* the Court is bound to make up its mind as to the true meaning, this is far from being the case with a Specification. It is open to the Court to conclude that the terms of a Specification are so ambiguous that its proper construction must always remain a matter of doubt, and in such a case, even if the Specification had been prepared in perfect good faith, the duty of the Court would be to declare the Patent void. Once again, though the Court may consider that the meaning of the Specification is reasonably clear, yet if the Specification contain statements calculated to mislead the persons to whom it is addressed, and render it difficult for them without trial and experiment to comprehend in what manner the patentee intends his invention to be performed, these statements may avoid the Patent. The above principles may be thought to bear somewhat hardly on patentees and their agents. A person may arrive at a valuable invention without adequately comprehending the particular point in which the invention is new or valuable, and a patent agent may be insufficiently instructed by his principal, and, however carefully he may consider the terms of the Specification he is employed to draw, he may quite easily fail to anticipate the points which may be raised, if and when the validity of the Patent comes in issue " (2).

Notwithstanding the strictness and rigour with which these principles have repeatedly been applied, I find myself unable to

(1) (1915) 32 R.P.C. 256.

(2) (1915) 32 R.P.C., at p. 269.

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concur with *Sholl* J. in the conclusion that they destroy the patentee's first claim for ambiguity. To begin with I do not think on a fair reading of the specification as a whole a man at all familiar with the subject of ball-point fountain pens could suppose that any part of the duct might consistently with the claim be of greater diameter than the main conduit forming the reservoir. The whole invention is clearly described as requiring a tube of a capillary size with a reduction towards the ball. The complaint that there is no precise way of differentiating between the conduit forming the main reservoir and the duct appears to me to overlook the fact that the duct is only the terminal of the reservoir and strictness of definition is incompatible alike with its purpose and character. The specification conveys two ideas with respect to the duct, and they appear to me to suffice. One is that as the reservoir approaches the ball, it gives place to a different formation of tube, designated the duct. The other is that the formation must include a lessened diameter at and near the ball, though the lessened diameter may begin earlier. Each of these ideas involves a matter of degree and for that reason any distinction that is precise must be but an arbitrary restriction on the inherent variability of the feature which the specification describes as the duct. The difference in formation may lie simply in the lessening of the diameter or it may lie in the commencement of a new member of the construction. The drawings make it clear that in some embodiments there is a physical distinction in the members forming the tube or conduit and the duct. Doubtless a manufacturing advantage may be obtained by having a detachable portion which embraces the ball and the duct. But this advantage is no part of the claim. In the operation of the pen the length of the duct is not material. It is a matter which would be determined by convenience in manufacture. The words " particularly that portion adjacent to the ball " appear to me to express sufficiently an intention to emphasize the necessity of the reduction of the diameter in proximity to the ball. In limiting the monopoly the claim seems fairly clearly to say that at the portion of the tube or conduit and duct which hold the column of ink there must be a reduced diameter in that part of the combined conduit and duct which feeds the ink to the ball. If this reduction of diameter occurs in a pen not manufactured in the exercise of the patent and if otherwise the pen exhibits the features enumerated in the first claim, it is difficult to see why it should not be an infringement. If the feature is absent the pen would not be an infringement except upon some doctrine of equivalence. The indefiniteness is more

apparent than real. I am unable to agree that it is sufficient to invalidate the claim for ambiguity.

The defendant, however, denies that the claim has been, or indeed could be, infringed, a defence which depends on the manner in which the claim is constructed and expressed. *Sholl* J. adopted this view which forms the second ground for his decision in favour of the defendant in the second action, that putting in suit the patent No. 133163. The question depends upon the words in the claim which say that in the tube " when charged with viscous ink a continuous liquid vein is maintained extending from the ball." As was explained early in this judgment, the physical principles upon which ball-point pens of the type under consideration depend for their operation will not keep the column of ink in contact with the ball if the pen is used to write vertically upward or at a high angle. The defendant's pen which is alleged to infringe the claim is no exception. If the pen is so used contact between the ink and the ball is lost, the rotation of the clean ball draws in air and a distortion of the meniscus ensues and the weight of the column of ink is not sustained. It appears that by chance it may happen that this may not occur. The column of ink may be very short and by some accident of manufacture there may be a very small gap between the housing and the ball. The slightness of the weight of the column of ink combined with the minute gap may result in the ink being sustained while the pen writes at a high angle or vertically upwards. No one could ensure that these conditions were produced. Normally to invert the pen or hold it at a high angle and so to write must lead to the distortion of the meniscus round the ball with the result that the meniscus will be formed at a sufficient interval from the ball to deprive it of contact. Generally it may be said that this will take place if the writer holds the pen upwards at an angle of more than thirty-five degrees with the horizontal and in that position writes with it on a more or less vertical surface for a short time. Because, in common with the plaintiff's pen, the defendant's pen possessed this characteristic it was held not to fall within the claim. For its tube was not one " in which when charged with a viscous ink a continuous liquid vein is maintained extending from the ball " according to the true meaning and operation of those words. Consequently the pen produced by the defendant was no infringement. If the words quoted do cover the maintenance of a vein of ink extending from the ball although the writer holds the pen at an angle of more than thirty-five degrees with the horizontal point upward and writes in that position, it might perhaps be thought that the true defence is that the words amount

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to a false promise or representation on the part of the patentee invalidating the grant. The defendant, however, took the position that it was enough that if a claim made a particular result or operation of the invention an essential characteristic and that characteristic was not exhibited by the alleged infringement, it could be no infringement and it did not matter that the claim to the result or operation amounted to a false promise or representation. Perhaps this is logical, but it still remains necessary to ascertain what it is that the claim makes essential. Clearly enough the unqualified words do not mean that in all conditions which the pen may encounter a continuous vein will be maintained extending from the ball. It is not, for example, referring to ill-usage. What the specification and the claim are talking about is the way the pen writes. *Sholl* J. put out of account writing upwards on an inverted horizontal surface. But his Honour took the view that the normal use of a pen includes writing with the point of the pen substantially above the other end. He said :—"Almost everyone, I suppose, has seen on the vertical notice-boards of social or other clubs, or of sporting bodies, documents on which persons are invited or expected to write names or other particulars, and on which it is usual or preferable to write in ink,—e.g., entries for tournaments, results of matches, subscriptions for donations, and the like. Many persons have seen in the headquarters or other establishments of the armed forces, or in the laboratories or control rooms of many kinds of technical establishments, charts, lists, maps, or other documents on vertical walls or boards, on which it is the practice manually to write in ink entries from time to time of all kinds of particulars. Tradesmen and carriers are frequently seen to write in such a position against a wall." Perhaps it does not matter, but it is unlikely that the pen would cease to write before the purposes were accomplished that his Honour mentions. The process of severing the connection of the column of ink from the ball when the pen is used in such a position is by no means instantaneous. A number of words may be written before the pen fails. It is only necessary then to point the pen downwards and make a few strokes so as to revolve the ball and the pen will write again as before. In all this it behaves much as would an ordinary fountain pen having a nib and employing aqueous ink, if it were used to write on a paper against a wall. If the usages of those who employ fountain pens give the standard which governs the statement in the specification it can hardly be said to be anybody's usage to write extensively either on a vertical surface or an inverted horizontal surface. But in the end the question is really one of the scope and meaning of the material part

of the claim. Is it speaking of exceptional uses occasionally made of some writing instruments? For it is exceptional to write against a vertical or almost vertical surface. Would the words be naturally understood as going beyond the ordinary commonplace way of writing? It is a general unqualified statement but it is evident that what logicians call a "universe of discourse" is presupposed. It is to be read *secundum subjectam materiam*. I think that it would be read simply as describing what occurs in the pen when it is used in an ordinary way. The claim and the specification should be construed as it would be ordinarily understood. So construed I do not think that it should be taken to intend to state that even when the pen is used to write on vertical or highly inclined surfaces the contact with the ball will be maintained any more than it should be construed as intending to cover cases of violence, accident or other ill-usage. I think this defence fails.

The plea of the defendant that patent No. 133163 is invalid was supported by particulars of objection containing certain grounds, really three in number, which now call for consideration. Briefly they are these. (1) That the complete specification in respect of which the patent was granted was the outcome of purported amendments of the complete specification lodged with the application which although made as under s. 45 were not authorized by that or any other provision, with the consequence that the grant is void. (2) That at the date of the application the plaintiff was not in possession of the invention the subject matter of the letters patent and therefore the patent was void for false suggestion. (3) That at that date such invention had not been made and therefore neither the inventor nor his assignor was the actual inventor thereof.

The circumstances which the defendant set up in order to establish these objections may be reduced to a compendious statement. Substantially what the defendant alleged was this. The plaintiff filed with his application on 31st December 1943 a complete specification which did not disclose or claim the invention that has already been discussed as that embodied in the specification in respect of which the patent was granted but related to a supposed invention depending upon the manner in which the tube or duct was constructed or arranged within the barrel of the pen. After some delays the examiner reported adversely to the specification and the plaintiff took advantage of his doing so to substitute, as a purported amendment under s. 45, another specification which in fact represented the complete specification for the United Kingdom patent No. 573747. It is the second of the two patents with which *Harman* J.

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dealt in *Martin* v. *Selsdon Fountain Pen Co. Ltd.* (1) and the material parts of it are set out in the report (2). This purported amendment was tendered on 18th December 1946 and the United Kingdom specification had been published in Australia in the previous September. The examiner made another adverse report on the new or "amended" specification, leading to the tendering of amendments therein, and the final result is the complete specification already discussed in this judgment, which the defendant says is for a quite different invention from that to which the specification first filed related. The plaintiff denies that the difference is so great and finds in the specification as originally filed indications of the invention as finally ascertained and claimed which the plaintiff says are sufficient for any limitation that may be implied in s. 45. It is hardly necessary to say that the defendant, in the circumstances it alleges, puts forward additional aspects of what I have summarily stated under the foregoing first heading. But these aspects are rather *alia enormia* than independent legal reasons for avoiding the patent. For the reason invalidating the patent must be that the grant was made in respect of a purported specification which lacked legal authority because it was not warranted by s. 45 or any other provision. However the defendant says (a) that the invention the subject of the grant was not new when it was first placed before the Crown on 18th December 1946 because it had already been made public by the availability of the United Kingdom specification; (b) that pursuant to s. 38A, which came into force on 11th September 1946, the specification as first filed, viz. on 31st December 1943, was made open for public inspection on 19th February 1948 and thereby published and that under s. 54 as amended in 1946 the patentee gets protection retrospectively as from publication of a complete specification or a grant: as *Sholl* J. has held, it is in this case protection not for the invention then published but for that ascertained and claimed in the final specification in respect of which the patent was granted; (c) that from September 1946 and onwards the defendant was manufacturing ball-point pens with a straight capillary tube or reservoir for viscous ink and in doing so infringed no exclusive right of the plaintiff unless and until the plaintiff secured protection as from 19th February 1948 for the invention the subject of the purported amendments tendered to the Patents Office on 18th December 1946; (d) that the purported amendment of 18th December 1946 was not really to meet or respond to the examiner's report as s. 45 supposedly contemplates.

(1) (1949) 66 R.P.C. 193.

(2) (1949) 66 R.P.C., at pp. 199-202.

Sholl J., after a close and extensive examination of the provisions of the Act, reached the conclusion that it is a condition precedent to the validity of a grant that an amended complete specification in its final form shall at least not claim an invention not disclosed in the complete specification in its original form except in the case of an amendment under Div. 4 and if purported amendments under Div. 1 result in the invention ultimately claimed and embodied in the grant being substantially different from that described and disclosed in the initial complete specification the grant will be void.

The first answer made by the plaintiff appellant to this view is that the amendment was allowed by the Commissioner of Patents upon a written request by the applicant. It is therefore within the terms of s. 71, and must be taken to have been made under Div. 4, with the result that s. 79 applies, making the leave to amend conclusive and the propriety of the amendment unexaminable. Of this contention it is enough to say that it does not appear to be satisfactorily made out that the amendment was sought or made under Div. 4.

A suggestion was thrown out but not pursued that perhaps s. 79 making leave to amend conclusive might directly apply to amendments under s. 45. But that would be a strained interpretation, though no doubt s. 71 may be taken into account as exhibiting the general policy of the legislature.

Section 45 gives an applicant a power of amending his complete specification after he has been informed that the examiner has reported adversely to the specification. The report may be under s. 39 and if so it will deal with the questions whether the title has been stated as prescribed, whether the invention has been described as prescribed and whether the application and specification are as prescribed. If the complete specification has been preceded by a provisional specification the report may be under s. 40 and deal with the question whether the invention fully described in the complete specification is substantially the same as the invention the nature of which is described in the provisional specification. Lastly the report may be under s. 41 which requires the examiner to ascertain and report whether to the best of his knowledge the invention is already patented in the Commonwealth or in any State (that is before the grant of patents passed to the Commonwealth) or is already the subject of prior application for a patent in the Commonwealth or the State. Section 41 also requires the examiner to report whether to the best of his knowledge the invention is or is not novel. If the report is under s. 39 or s. 40 the commissioner may under s. 42 give directions for amendment, but, even if he

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does not, the applicant may himself elect to amend under s. 45. The purpose of s. 45 is to enable the applicant to make what changes he thinks proper in his specification in view of the examiner's report. To say that its purpose is to enable him to obviate the examiner's objections is probably too narrow a statement. For the examiner's report about prior grants and applications may conceivably open up all sorts of difficulties or dangers which go beyond and outside his specific objections. Perhaps it is better to say that the purpose of s. 45 is to enable the applicant to make such changes in his complete specification by amendment as appear to him to arise out of the examiner's report.

Section 49 (1) of the *Patents Act* 1952 introduces the words "so as to remove the grounds of objection", but these words do not occur in s. 45 of the Act of 1903-1950 and in any case the new Act does not give rise to the same difficulties. There is no express limitation on the power to amend conferred by s. 45 and since it forms part of the statutory regulation of what shall be done in the Patents Office and, as the Act stood before the amendments made by Act No. 38 of 1946, done in that office before the specification was accepted or published and so before the applicant obtained any protection, it is not an unreasonable inference that the extent and propriety of the amendments was left as a matter with which the office would be competent to deal. If the amendments tendered by the applicant would if made lay the specification open to any lawful objection under the Act, the specification would not be accepted. The making of an amendment sets going again the machinery of s. 41. For s. 45 ends with a direction that the amended specification shall again be reported upon by the examiner under s. 41. In a general way it may be assumed that the draftsman of s. 45 would not expect that an amendment of a specification would be made thereunder which would substitute another invention for that disclosed by the original document accompanying the application. At the same time it must not be overlooked that if an examiner objected under s. 41 that the invention was already patented, the objection if well founded could only be overcome under s. 45 by amendments changing one or more essential elements of the invention. However, to say that the draftsman would not expect such an amendment is one thing and to imply a positive restriction resulting in the invalidity of the grant on that ground is another. Section 46 makes it necessary before the commissioner accepts an application and specification that he should be satisfied that no objection exists to it on the ground that the invention is already patented or is already the subject of a prior application and there

must be no other lawful ground of objection. It would be a lawful ground of objection if the specification as amended did not conform with the provisions of the Act and it would be a lawful objection if a ground existed upon which a grant if made would be revoked or invalidated. That the applicant was not at the time of his application in possession of the invention would be such a ground. It may be said that conceivably he might be in possession of an invention at the time of his application which the original specification accompanying the application did not disclose but which was afterwards disclosed by amendment under s. 45. As the Act stood before 1946 the consequences would not be so dreadful. For the protection under s. 54 would begin as from publication of the acceptance and the amendments cannot alter the construction of s. 45 and s. 46. It is after all only a logical possibility and the antecedent likelihood of its occurrence is small and it might well escape notice. It is to be noticed that the impropriety of an amendment is not a matter that could be raised in opposition to a grant under Div. 2.

There is in my opinion no sufficient justification for introducing into s. 45 an implication restricting the scope of amendments that can be made thereunder so as to make an amendment in excess of the restriction a nullity and to invalidate a grant made thereon, independently of any other consideration. It is a matter of procedure in the office and as such does not go to the validity of the grant. Once there has been an acceptance followed by a grant the course of amendment ceases to be of any importance, unless and except in so far as it may supply evidence of one of the known grounds for revoking or invalidating a patent.

Section 46 speaks of the satisfaction of the commissioner and submits the matter to his judgment. Sir *Garfield Barwick* for the plaintiff said that the fifth particular of objection, which alleges that at the time of the application the plaintiff was not in possession of the invention the subject of the grant is the real defence in the case, if there be any defence. In this I agree. It is therefore necessary to turn to that defence. It is, of course, a recognized ground for avoiding a patent, although one that can rarely arise.

In speaking of the recitals in a grant as made at that time Mr. *Terrell* in the sixth edition of his work (1921), p. 6, said : " The first recites the patentee's name and address, that he has made a declaration, that he is in possession of the invention . . . These are the so-called ' suggestions ' which are supposed to have been made to the Sovereign prior to the patent being granted and are the

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representations upon which it has been granted. If either of these suggestions be untrue the patent is void."

The recital in Australian letters patent is in a different form but the result is the same. The recital is that the patentee has made a declaration in the prescribed form. The prescribed form of declaration is part of the application and includes a declaration that the applicant is in possession of the invention. In the present case the plaintiff, who applied as assignee of the " actual inventor " declared that he, the plaintiff, was in possession of the " said invention ". The " said invention " was identified by the general description as " an invention entitled ' improvements in writing instruments ' ". A point may perhaps be made that a plea of false suggestion based on this declaration cannot be made out except by showing that the patentee was not in possession of the invention described in the complete specification which accompanied the application; as, on the defendant's case, the grant related to another and different invention the plea would not be established by proof that the patentee was not at the time of the application in possession of the latter invention. No such point was made on behalf of the plaintiff and if it were a good one it would indeed be a strange result of the change in the form of the letters patent. The substantial answer to it is that, however much the specification may change its shape by amendment the representation of the applicant that he was, at the date of applying, in possession of the invention therein described is continuing and operates upon it. Otherwise a grant would not be made as of the date of the application.

For proof of the issue raised by the plea contained in the fifth particular of objection, namely the issue whether the plaintiff was on 31st December 1943 in possession of the invention the subject matter of the letters patent ultimately granted, the plaintiff relied upon the contents of the specification that accompanied the application. The defendant maintained that from these contents the inference arose that the plaintiff was not at that date in possession of the invention actually patented because it clearly appeared that the inventor had then directed his attention to another object, and was not aware of the thing which he had in the end succeeded in patenting. Possibly the inference might be aided by a consideration of the specification in patent No. 122073 lodged on 8th December 1943, that is twenty-three days before the application in No. 133163. There were also the examiner's reports and the amendments tendered to the office. These could only advance the matter as explaining the steps by which the final specification developed and thus perhaps showing the true source of the conceptions embodied therein. But

no other evidence was adduced by the defendant in proof of the issue.

It is therefore necessary to ascertain from the document which accompanied the application what invention at that time the plaintiff conceived he possessed and presented to the Crown as fit subject for a patent. To understand the document it is perhaps necessary to know how far the development of ball-point pens had gone at that time. In the evidence given with reference to the ultimate specification for patent No. 133163 we are told that five features contribute to maintain the liquid vein in the ball-point pen as there described and we are informed which then were old. There is the ball and its housing, which were old. There is the feed duct narrower than the reservoir and that was old. So too was the reduction of the cross-section of the feed duct itself from its cross-section where it entered the reservoir. Then there is the venting of the tube, the providing it with an air intake ; that too was old. The element, the fifth in number, described as the significant element in the invention ultimately claimed and made the subject of that patent is the capillary tube. The use of dense or viscous ink was of course old. Much of this appears inferentially from the complete specification No. 122073 where, it will be recalled, the convolutions, helical formations or other extensions of the path of a tube of small cross-section were relied upon to achieve the objects, one of which was to prevent leakage even when the pen is held with the air intake downwards.

The original specification of No. 133163 refers, at the outset, to fountain pens more particularly to pens of the kind comprising an ink reservoir formed by an extension of the channel for supplying ink to the writing point, and says that the extension by a duct of small section allows of the establishing of a fluid vein of constant position, but that several difficulties are encountered owing to the necessity of arranging the duct in a winding or meandering form or otherwise arranging the same in such a way that it will occupy, to the largest possible extent, the capacity of the holder of the instrument. It will be seen that the tube reservoir and the small duct to the writing point are assumed, but the problem is stated to be in arranging the necessarily winding tube in the holder or barrel. In this conception of the problem it resembles No. 122073. The document then claims that in accordance with the invention these difficulties are overcome. It proceeds to describe how for the purpose a series or group of duct sections are arranged to form a feed channel fitted into the body of the holder. Ways of doing this are described and are illustrated by the drawings. At one point

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the words " capillary tube " are used, but not to state an element in what the applicant has invented : " The duct consisting of a plurality of sections for forming the reservoir may be constructed in several manners, as use may be made indifferently of a capillary tube folded into several lengths until forming a series or whole, or a group of channels or ducts may be bored in a block which may then be connected to, or form an integral part of the fountain pen, provided the several sections of the duct be connected in series, so that one will be a continuation of another." But additional object after object is enumerated, e.g. the length of the reservoir and the minimizing of the bends therein ; the simplification of the construction of the reservoir ; the possibility of boring the holder to form the reservoir ; the use of the very material composing the holder to form the reservoir ; the prevention of gravitation influencing the reversed position of the pen by placing the air intake to the writing point of the pen. In the statement of these various objects the words " stylographic ball or point " occur, and later it is expressly said that instead of a sphere the stylographic point may comprise a pen or other common or known writing means. This makes it even clearer that it is in the formation of the tube reservoir that the alleged invention lies : for a ball-point is an essential part of any pen in which a meniscus is to be maintained. At one place the reservoir is described as formed by a duct forming an extension of the feed channel but comprising several particular features which constitute the basis of the invention. These particular features are never precisely enumerated but it is clear enough that they relate to the folding convolution connection and construction within the barrel or holder. One figure in the drawings is described as having a reservoir formed by a duct or tube of the capillary type, but this is treated as accidental or incidental and the passage proceeds to deal with the folding of the tube and the communication of the parallel sections thereof one with another. The specification then mentions the use of dense ink to fill the reservoir which it says thus establishes a fluid vein extending from a point near the air inlet or air intake to the sphere which is thus maintained in contact with the ink in order that when causing the same to roll over the suitable surface the sphere held by the mounting will mark the strokes with ink supplied from the channel containing the liquid vein. This may sound as if the applicant was drawing close to the invention embodied in the ultimate specification. But in truth it is only a statement of what will happen in consequence, as he supposes, of his arrangements of the tube in the holder which forms the invention. He has no conception of the essentiality of the

capillary dimension of the tube, of the ball and of the lessened diameter of the duct at the orifice to the ball, and so on. It is all in the arrangement of the tube and the construction within the holder, as applied to old elements variously assembled. This is again seen in the embodiment in which the air intake is directed towards the point but at a certain distance short of the point; " this arrangement " he says " has for its object the prevention of the ink when the pen is in reversed position from being discharged by gravitation ". This of course it would not entirely do, if the reservoir were full. It is unnecessary to go through the claims of which there are eleven. It is enough to say that they take in turn various combinations which the body of the specification indicates. All of them make a particular construction folding or grouping of the tube and its sections a feature and one only makes a ball-point essential. It is the tenth. It adds to a series or group of duct sections connected together the feature that the stylographic point, to which the single channel thus formed extends, is " characterized by the fact that the channel or duct which forms the reservoir ends with a mounting provided with a small loose sphere which constitutes the writing point ". It is obviously added as an additional feature to form a combination. But in that combination all the other elements essential to the invention ultimately specified are left out and the elements included are irrelevant to function and misconceived.

The conclusion which I think flows from the foregoing is that the initial specification was directed to a supposed invention depending upon the arrangement of the tube or tubes within a pen of a known type and that though some of the essential elements of the invention ultimately patented are referred to, it is as features already known to be used, and not as elements to be brought together under a new conception. I think that the initial specification accompanying the application is for an invention exhibiting none of the essential elements of the invention ascertained and claimed by the specification in respect of which patent No. 133163 was granted but directed to other objects or points in the construction of the pen. The fact that this is so appears to me to raise a prima facie inference that at the time of the application the plaintiff was not in possession of the invention patented by No. 133163. But it is evidentiary only and not necessarily conclusive of the issue. Suppose for example that the plaintiff as assignee of the invention were able to produce an assignment from him made before 31st December 1943 which clearly described the invention embodied in the ultimate specification. That surely would rebut the inference that the invention

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had not been then in the plaintiff's possession. However I should be prepared, in the absence of any countervailing evidence, to draw the inference if the matter stopped there. The sixth particular of objection depends upon the invention not having been made and that inference too I think is a proper one in the state of the evidence if no other consideration entered into the question of what this Court should do. But the matter does not stop there and other considerations do enter into the question of what order this Court should make. They are considerations arising out of the course the case followed in the Supreme Court.

That course raises some procedural and evidentiary difficulties which may stand in the way of our pronouncing a judgment upon the issue raised by pars. 5 or 6 of the particulars of objection. Both these particulars are pleaded as completely independent grounds of invalidity. They are not expressed so as to be in any way dependent either on one another or on any of the facts stated in particulars 1 to 4. There can, however, be little doubt that to establish the facts stated in these particulars the defendant, from the beginning, intended to rely on the inference to be drawn from the initial specification filed on 31st December 1943, aided possibly by the specification filed on 8th December in support of what became patent No. 122073. The gist of the objection relied upon under the fourth of the particulars of objection is contained in sub-pars. (iv) and (vi) of that particular. What is alleged in sub-par. (iv) is that the specification lodged on or about 18th December 1946 described and claimed as the invention something which was not the invention described and claimed in the complete specification previously lodged on 31st December 1943 but something substantially different therefrom. It goes on to allege that it was the same as the invention No. 122073. Sub-paragraph (vi) uses the same terms in relation to the further amendments and says that they described and claimed as the invention something which was not the invention described and claimed in the complete specification lodged on 31st December 1943 but something substantially different therefrom. The sub-paragraph goes on to say too that it was the same as No. 122073. In point of law that again is a ground independent of particulars 5 and 6 involving distinct issues of fact and law even if it was the defendant's intention to prove the issues of fact by the same evidence.

By an order made on 25th November 1952 a question of law was framed and set down for argument before the trial. It dealt not only with the fourth particular of objection but also in part with the fifth and sixth. The question begins by requiring that the

truth be assumed of all the allegations set out in the fourth particular, and in certain further particulars thereunder, so far as the same are allegations of fact and having regard to the various documents referred to in the fourth particular and the further particulars or so much of them as are relevant. On that assumption the question propounded was whether (a) those allegations or any of them; or (b) pars. 5 and 6 of the particulars of objection so far as the last-mentioned paragraphs depend exclusively upon the allegations set out in par. 4 of the particulars and in the further particulars so far as the said allegations are allegations of fact constitute a good defence in law to the particulars claimed. The difficulty about this order is that in a logical and in a legal point of view pars. 5 and 6 of the particulars of objection do not at all depend, and certainly do not exclusively depend, upon the allegations set out in par. 4 of the particulars. The only common ground between them is in the evidence which the defendant intended to adduce in order to prove them. That evidence, one may be sure, would have been supported by any further evidence which the defendant was able to obtain, and any such further evidence would not likely be common to the proof of the three particulars. However this might not have appeared at the time to matter, because on 17th March 1953 an order for directions was made which provided for the various events which might arise according to the answer given to the question of law propounded in the previous order. In one event, that of the question being answered that the matters referred to or any of them did constitute a good defence of law, the court, according to the order for directions, was to proceed to determine whether the allegations of such matters were established to the satisfaction of the court or not so established. If, to put it shortly, the particular defence dealt with in this manner failed either in fact or in law, then, said the order for directions, " in either of such events this honourable Court will proceed to hear and determine such issues and matters arising upon the pleadings as are required to be determined in order that the action be disposed of and judgment given herein ". This should have covered all residual matters pleaded by way of defence not entirely covered by the order setting down a preliminary point of law and of fact for determination.

On 15th June 1953 a decision was given on the question of law. It was decided that par. 5 of the particulars of objection, so far as it depends exclusively upon the allegations of fact in par. 4, did not constitute a good defence, and it was so ordered. The reason for this decision was that the fourth and fifth sub-paragraphs of the fourth particular stated that the invention was the same invention

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as No. 122073. *Sholl* J. said: "That presumably amounts to an allegation admitted for the purpose of the present question that the plaintiff was then in possession of the invention the subject of the earlier patent and if that is so the facts alleged and taken to be admitted are inconsistent with the contention that the plaintiff was not on 31st December 1943 in possession of the invention for which No. 133163 was ultimately granted". As the question before him as propounded was whether par. 5, so far as it exclusively depended on the allegations in par. 4 of the particulars, was good in law, the rejection was inevitable of particular 5 as bad so far as it depended exclusively upon those allegations. But, as I have already said, except for the evidence by which it was to be supported, it does not depend in point of law or logic on par. 4 of the objections at all. It therefore remained a plea to validity which should have been dealt with as a matter of fact in pursuance of the order for directions remitting for trial all other issues, if the particular defence raised for prior determination failed. As to pars. 4 and 6 of the particulars of objection, an order was made determining that the allegations made in par. 4, so far as allegations of fact, and par. 6 so far as it depended exclusively upon such allegations of fact, constituted a good defence in law to the plaintiff's claim to the following extent only and not otherwise, viz. so far as they alleged that the effect of the amendments therein referred to or either of them was that the complete specification in its final form claimed an invention (a) substantially different from the invention described and disclosed by the complete specification originally lodged with the application of 31st December 1943; or (and this is no longer material) (b) identical with the invention described and claimed respectively in the complete specification of letters patent No. 122073. It is no longer material because the allegation that it is so identical has been abandoned. This decision departs in what might have been a material respect from the allegation. The allegation in the first place was that the specification of 18th December 1946 described and claimed (not disclosed) an invention which was not the invention described and claimed (not disclosed) in the specification lodged on 31st December 1943 but something substantially different therefrom, that is from the invention described and claimed by the last-mentioned specification.

By an order of 22nd June 1953 it was adjudged and declared that the allegations of the defendant the subject of the judgment dated 15th June 1953 so far as they are the subject of such judgment and alleged a good defence in law to the plaintiff's claim are not established and that accordingly the paragraph of the defendant's

defence denying validity to that extent failed. A trial of the action then took place and on 28th July 1953 judgment was entered for the defendant. From that judgment the plaintiff appealed to this Court by a notice of appeal dated 14th October 1953. The plaintiff's notice of appeal did not seek to appeal from any of the prior orders but only from the judgment of 28th July 1953. Order 70, r. 26, of the Rules of this Court provides that an interlocutory order or rule in which there has been no appeal does not operate so as to bar or prejudice the Court in its appellate jurisdiction from giving such decision upon an appeal as is just. The orders of 25th November 1952 formulating the question of law and of 15th June 1953 answering it are interlocutory orders. In so far as they might otherwise stand in the way of the plaintiff appellant they cannot so operate because of r. 26. It seems to me that in so far as they might stand in the way of the defendant respondent they could not operate to prevent his success upon the appeal.

The defendant respondent, however, obtained special leave to appeal from the orders given on 15th and 22nd June 1953. The notice of appeal given in pursuance of that special leave included, among the parts of the order of 15th June 1953 appealed from, so much of the order as decided that the fifth of the particulars of objection, so far as it depends exclusively upon the said allegations of fact, does not constitute a good defence. The same notice of appeal also included an appeal from so much of the judgment of 22nd June 1953 as adjudged and declared that the allegations of the defendant the subject of the judgment dated 15th June so far as they are the subject of such judgment and allege a good defence in law to the plaintiff's claim are not established and that accordingly par. 5 of the defendant's defence herein to that extent fails. Paragraph 5 of the defence is that pleading invalidity and it is under that paragraph that the particulars of objection were delivered. It may be doubted whether, in view of O. 70, r. 26, this appeal or, if two appeals are included in the notice, either of them, was necessary. It is a substantive appeal, not a cross-appeal pursuant to O. 70 r. 13, although it is convenient to speak of it as a cross-appeal to distinguish it from the plaintiff's appeal.

As an independent issue the allegation made by the fifth particular of objection that the invention was not in the possession of the plaintiff at the time of the application does not appear to have been separately investigated. On the argument of this appeal the plaintiff appellant by his counsel took up the position that that was the true issue on which the defendant should have relied and that his contention that the amendments fell outside s. 45 of the *Patents Act* was ill-founded.

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On the hearing of the appeals before this Court the argument took a strange turn. In supporting the defendant's " cross-appeal " against the orders of 15th June 1953 and 26th June 1953 counsel for the defendant, in the course of explaining what *Sholl* J. had done, remarked that his Honour had decided that particulars 5 and 6 were not good defences and that he, counsel, was not attacking that part of the judgment. On being questioned as to whether the issue propounded by the order under particular 4 was the same as the issue tendered by particular 4, having regard to the substitution in the order of the words " described and disclosed " for " described and claimed " in the particular, counsel said that if what *Sholl* J. found was really something more limited than the defence pleaded he was entitled to assert before this Court that the defence as pleaded was the correct defence. So far as the order of 15th June 1953 limited the legal area of his defence he complained of it under his notice of " cross-appeal ". In dealing with the power of amendment, however, he observed that the whole system of patent law depends on this, namely that the person should have his invention at the time that he makes his application. In the course of his argument for the plaintiff as respondent to the " cross-appeal " by the defendant from the orders of 15th June and 26th June 1953, counsel for the plaintiff was asked by *Taylor* J. whether pars. 5 and 6 were not independent objections, to which counsel answered in the affirmative and added that he would say that they were the real defences. He acquiesced in the view that *Sholl* J. must really have meant that the objection alleged in particular 5 was not made out by the facts specified elsewhere and added that there were no other facts. Particular 5, he submitted, was the real defence in the case if there were any defence. At one stage the defendant's counsel made an interjection to the effect that he had no further facts to support particulars 5 and 6 than appeared under par. 4. In response to a question from me to learned counsel for the plaintiff as to the course he took about particulars 5 and 6 he said that he understood that particular 5 was out of the case. I remarked that the difficulty was that much of his argument had driven the case back on to particular 5 and that a question for our consideration was whether the defendant could go back to particulars 5 and 6. Counsel for the plaintiff urged in addition that the fact, if it were a fact, that the plaintiff had not set the invention out in the initial specification of 31st December 1943 did not show that he did not possess the invention for which the letters patent were granted at the date of the application and that some extrinsic evidence would be necessary beyond the matters set out under the fourth particular

in order to establish the fifth particular. The amendments were irrelevant. In his reply the defendant's counsel put the view first that if s. 45 was limited in the manner for which he contended, that was enough; but if s. 45 was not so limited then he turned to the defence raised by particulars 5 and 6 and said that on the facts it appeared that the applicant was not in possession of the invention described in the specification in its final form at the date when he made his application, namely 31st December 1943, and that it was common ground that it was a good defence if made out on the facts.

The foregoing account of the proceedings in the Supreme Court and here suggests that not a little confusion arose almost from the outset as to the place the issues raised by the fifth and the sixth particulars took. Having regard to what has occurred it is not altogether easy to say what is the right course for this Court now to take. Left without other evidence I think that it might be difficult to resist the prima facie inference of fact which arises from the manner in which the initial specification is compiled, considered, as it should be, with the specification filed twenty-three days earlier in No. 122073. It is enough to justify the conclusion that at the time of the application of 31st December 1943 the plaintiff was not in possession of the invention described and claimed in the specification No. 133163. But it is but a prima facie inference and the ultimate fact is that the applicant had not possession of the invention in its final form. Owing to the peculiar course which the action took this issue seems never squarely to have been faced and determined, and yet it is the issue on which the defendant's case in the end depends. At one stage of this appeal as an independent defence it was for the moment disavowed for the defendant but for the plaintiff it was insisted that it was the only true defence in law if the facts would support it. On the whole the course which justice seems to demand is that the issues raised by the fifth and sixth particulars be sent down for trial, unless the plaintiff does not desire that course. It would not be satisfactory to determine the issue on the present material if the plaintiff is in a position to offer any material evidence. A proper order to make in the appeal relating to action No. 58 of 1951 would be that if within two months the plaintiff notifies the defendant and the Principal Registrar that he desires these issues to be tried there be a further trial of the action limited to those issues, and that otherwise the plaintiff's appeal be dismissed. In any case it seems unsatisfactory to leave the two orders of 15th June 1953 and 26th June 1953 standing. They should be discharged. The order in the appeal relating to action No. 314 of 1947 should be appeal dismissed.

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FULLAGAR J. These are appeals from judgments of the Supreme Court of Victoria (*Sholl* J.) in two actions, No. 314 of 1947 and No. 58 of 1951, which were heard together. In each case the plaintiff claimed relief in respect of alleged infringements of letters patent, and in each case *Sholl* J. gave judgment for the defendant. In the second case there is also a cross-appeal by the defendant against two interlocutory orders made by *Sholl* J. in the action. The patent put in suit in the first case is No. 122073, and has been conveniently referred to as " No. 122 ". The patent put in suit in the second case is No. 133163, and has been conveniently referred to as " No. 133 ". In each case *Sholl* J. held that there had been no infringement. In the second action he also held that the patent (No. 133) was void for ambiguity in the complete specification. Each patent was granted in respect of improvements in writing instruments of the " ball-point " or " ball-tip " type, which have become well known and widely used in recent years.

In *Martin* v. *Selsdon Fountain Pen Co. Ltd.* (1) the same plaintiff sued in respect of alleged infringement of two English patents, which were shortly referred to respectively as Nos. 571 and 573. The pen which was said to be an infringement was in all material respects the same as the pen which was alleged to infringe in the two Victorian actions. The specification of No. 571 was identical with that of Australian patent No. 122, but the specification of No. 573 (though it figures indirectly in the second Victorian action) differed widely from that of Australian patent No. 133. The action in England was heard by *Harman* J., who held (1) that No. 571 was valid, but had not been infringed, and (2) that No. 573 was valid, and had been infringed.

In holding that Australian patent No. 122 had not been infringed *Sholl* J. agreed with the reasoning of *Harman* J. in the English case. It is true that there was one factor which assisted *Harman* J. to his conclusion and which perhaps could not legitimately be used in the Victorian case, but it is clear to my mind that *Harman* J. would have reached the same conclusion in the absence of that factor. In the English case, as in the Victorian case, the question of infringement turned entirely on the construction of claim 1 of the specification.

So far as Australian patent No. 122 (English No. 571) is concerned, I find it sufficient to say that I am in agreement with the reasoning of *Harman* J. and *Sholl* J., and that, in my opinion, the appeal in action No. 314 of 1947 should be dismissed with costs.

(1) (1949) 66 R.P.C. 193.

The appeal in the other action, however, which is concerned with patent No. 133, raises questions of considerable difficulty, which require an examination of the relevant " art " and involve some consideration of the specification of No. 122 as well as those of English No. 573 and of No. 133 itself. It will also be necessary to consider the chequered passage through the Patents Office of the application for No. 133 from its lodgment in December 1943 to the sealing of the patent some time after June 1949. Because of the differences between the specifications of No. 573 and No. 133 the judgment of *Harman* J. in the English action is of no direct relevance, but on certain matters it is of assistance, and it will be convenient to quote a number of passages from it.

The essence of a ball-point pen is that the actual writing element consists of a ball of very small size which protrudes a minute distance from a spherical housing, within which it is rotatable. The ink used is of a " viscous " type, as distinct from the " aqueous " type used with an ordinary pen. The act of writing causes the ball to revolve in its housing, and the ultimate object to be attained is that, as the ink is transferred from the ball to the paper in the process of writing, the ball shall be continuously re-coated with a thin surface of ink from a reservoir within the barrel of the pen. The problem which was found troublesome for a long time is explained by *Harman* J. (1) as follows :—" The merits of a ball point instead of a nib of the conventional type for fountain pens have long been canvassed, and many attempts have been made to produce a workable instrument of this kind. I was told that ball-pointed pens were proposed as far back as 1890. A ball point, it has been found, will not work with the ordinary type of ink, called in this case aqueous ink. In order that a continuous trace may be made a dense or sticky ink, called in the present case viscous ink, is required. The use of viscous ink, of course, makes a ball point of no use except with a reservoir behind it, but, if a satisfactory reservoir of viscous ink can be provided, such a pen will write for a very long time, because the amount of ink used by the ball is very small. A further advantage is that the trace when made is absorbed immediately by the writing material and no blotting paper is required. These advantages had long been recognised, but before the Plaintiffs' pen appeared on the market no practical ball-pointed instrument had ever been sold, at least in England, and the reason was that no one had solved the problem of the reservoir and the manner in which the ink should be fed to the ball. The essential problem is one of ventilation. Air must be allowed to enter the

(1) (1949) 66 R.P.C., 193.

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pen as ink is used up, because otherwise a vacuum is caused and the ink ceases to flow to the nib. This difficulty was not present in fountain pens of the ordinary type, owing to the fact that with an aqueous ink air is able to penetrate into the pen past the nib and so up into the air cavity at the base. With viscous ink, however, it was found that the air could not, or at any rate did not, at sufficient speed pass by the nib through the viscous ink behind it, and some other method of ventilation had to be discovered. Attempts were made to provide a piston or other device which would force the ink down as it was used and thus keep it in contact with the ball, but these were too elaborate and never successful. The alternative was to have an air vent at the base of the reservoir, but the trouble always was that the ink, though viscous and therefore slow flowing, would, when the pen was inverted, sooner or later flow back through the air vent and the pen would leak. Moreover, if the ink did not remain in contact with the ball, air would enter and thus form a bubble which produced an air lock between the ball and the ink " (1).

The actual inventor of No. 122 (571) was one Laszlo Josef Biro of Argentina, the plaintiff, Martin, being his assignee. Biro provided a tiny air inlet in the ink reservoir at the end remote from the ball, his reservoir being constructed in a manner designed to prevent the ink from leaking through this air inlet when the pen was inverted. In the body of his specification he said :—"According to the present invention an instrument of the ball-tip type is provided in which the ink reservoir is formed by one or more conduits starting at an air intake, and, after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intakes under the effect of gravity." Claim 1 in the specification was in the following terms :—" Improvements in writing instruments of the ball-tip type, wherein the ink reservoir of said instrument is formed by one or more conduits starting at an air intake and, after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intake under the effect of gravity." Claim 9 is for instruments according to claim 1 wherein the conduit is smaller than five square milimetres in section. It may be noted that there are several references in the body of the specification to a " feed channel " connecting the reservoir with the ball housing, and that this feed channel is shown in all the relevant drawings except fig. 3. In every case it is shown

(1) (1949) 66 R.P.C., at pp. 205, 206.

as being of smaller diameter than the conduit or conduits which form the reservoir. This element, however, is not mentioned in any of the claims.

Now, the pen which was alleged to infringe both in the English action and in the Victorian actions has a reservoir of " capillary size "—a term which *Harman* J. found to bear a " functional sense " and to " mean no more than a tube of small bore, which for ordinary purposes does not go above 3.5 mm." It is formed by a single conduit starting at an air intake and communicating with the recess for the ball. There is no curve or bend in the conduit, which is cylindrical in shape throughout, and communicates with the ball housing by means of three extremely short cylindrical tubes—or " feed channels " or " ducts "—of which the first is of smaller diameter than the " conduit " or reservoir, the second is of smaller diameter than the first, and the third is of smaller diameter than the second. The axis of the conduit and of the succeeding tubes is (practically speaking) a continuous straight line.

This allegedly infringing instrument is an effective and successful writing instrument. Its effectiveness results from the operation of an elementary scientific principle, which was described by *Harman* J. in these words:—" In fact the principle involved is now well recognised, and there was no dispute about it. This is that, if a tube with a narrow top and a wider bottom be filled with liquid up to the top and then held with its wider end downward, the liquid (within certain limits) will not fall out of the tube, by reason of the fact that the free surface or meniscus at the top, being narrower and having therefore a steeper curve, is stronger than the meniscus in the wider end at the bottom and that in effect the former will hold up the latter " (1). Coming to the particular pen under consideration, his Lordship said:—" The clearance between the ball and its housing, which acts as the upper meniscus, being very much smaller than the diameter at the base of the reservoir, will hold the ink up against the ball " (i.e. even when the pen is inverted) " and prevent it from falling out at the base. It is common ground that this principle will operate effectively with a clearance at the ball of not more than 0.06 mm. (or 60 microns) and a reservoir of any bore that does not exceed 3.5 mm., though preferably it should be somewhat smaller " (2).

The specification, however, of patent No. 122 (571) did not describe or claim an application of this principle. *Harman* J. held, and *Sholl* J. held, and I think it reasonably clear myself, that it was of the essence of the invention covered by No. 122 that the reservoir

(1) (1949) 66 R.P.C., at p. 208.

(2) (1949) 66 R.P.C., at pp. 208-209.

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should " follow an extended path ", i.e. that it should be of a helical or otherwise winding or convoluted shape. The inventor had not grasped, or set out to apply, the principle stated by *Harman* J. in the passage which I have quoted. The article alleged to infringe No. 122 did apply that principle, and the reservoir did not " follow a winding path ". It was not, therefore, an infringement.

Before leaving No. 122 I would observe that there seems to be something to be said for the view that claim 1 is bad for insufficiency, on the ground that neither therein nor in the body of the specification is there to be found any adequate description of the nature of the ink which it is necessary to use, or any statement as to the maximum cross-section of conduit which will be effective to prevent the ink from escaping. Both the ink and the cross-section are described merely by reference to the result which they are to attain in combination. A maximum cross-sectional area of five square millimetres is mentioned in claim 9, but claim 9 was not alleged to have been infringed. It is unnecessary to pursue this matter further. I mention it only because it seems to indicate that the inventor is concentrating on his " extended path ". The conduit must be of small cross-sectional area, and the ink must be " dense " or " viscous ". The ideal combination can be found by experiment, but the essential thing is that the conduit should follow a path which is not direct but winding.

It is now necessary to turn for a moment to English No. 573. We do not know what form the original English specification took, but we do know (1) that it was amended several times, and that the last amendment was made a few days after the issue of the writ in the English infringement action. At this stage it is only necessary to say that, in the form in which it came before *Harman* J., it stated that the invention was concerned with writing instruments of the ball-point type, and that claim 1 was in the following terms :— "An instrument of the said type in which the ink reservoir for the ball is constituted by a capillary tube." The meaning of the term " capillary tube " was the subject of much conflicting evidence given before *Harman* J. His Lordship stated his finding thus :— " On the evidence I hold that to the man of science a capillary tube is properly a hairlike tube of a very small bore, not above 1.5 mm., but that these words are sometimes used in a functional sense and have in the realms of commerce come to have a somewhat extended significance and mean no more than a tube of small bore, which for ordinary purposes does not go above 3.5 mm " (2). So interpreting the claim, he held that the patent was infringed by the article described above.

(1) (1949) 66 R.P.C., at p. 206. (2) (1949) 66 R.P.C., at p. 212.

As I have said, the claims in the specification of Australian No. 133 were widely different from the claims in the specification of English No. 573, which *Harman* J. had to consider. The plaintiff in the second Victorian action alleged infringement of claims 1, 2, 5 and 8 in the specification of No. 133, but only claim 1 need be considered. Claim 1 is in the following terms:—"An instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball, and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being (*sic*) less than that of the reservoir." The article alleged to infringe is that which has been described above.

The defendant's article does, in my opinion, infringe claim 1 of No. 133. All the elements mentioned in claim 1 are present in combination. *Sholl* J. held that there was no infringement, but on what seems to me, speaking with all respect, to be a curious and somewhat unrealistic ground. It turned on the reference in the claim to a tube " in which, when charged with viscous ink, a continuous liquid vein is maintained extending from the ball ". It may be said, as the witness Hopper in effect said, that these words really describe the result which is achieved by the other factors mentioned. But, be this as it may, the maintenance of the continuous liquid vein depends, of course, on gravity. If, therefore, an attempt is made to write with the defendant's pen upside down or with the ball-point substantially lower than the top of the pen, the liquid vein will not be maintained, and the pen either will not write at all, or will write only for a short time, the time depending on the size of the angle at which the pen is held relatively to the plane of the material to be written on. Therefore, it was argued, it could not be said of the defendant's pen that, when charged with viscous ink, it would maintain a continuous liquid vein extending from the ball. It was conceded that the words in the specification must be read as referring only to normal uses of the instrument. *Sholl* J. put out of consideration the possible case of an eccentric poet who might wish to write immortal verse on the ceiling of his bedroom, but he considered that normal uses of the pen would include its use for the purpose of writing on a vertical surface—for example, on a paper affixed to a notice-board in a club inviting entries for a sporting competition. It may be admitted that such a use is a normal use, but the pen would only be employed for such a purpose for a very short period at a time, and even in a completely inverted position the vein will be maintained for a brief period—

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more than long enough to write one's name. If a person really wishes for some outlandish reason to write on a vertical surface for any length of time, there is no difficulty in holding the pen at such an angle that the vein of ink will be maintained indefinitely. The words in the specification must be read in a commonsense way and in the light of normal human needs and normal intelligence. I think that the defendant's pen maintains a continuous vein of ink within any fair and reasonable reading of claim 1, and that it infringes claim 1.

It remains to consider the question of the validity of claim 1 of No. 133. Here again I am unable to accept the view of the learned trial judge. His Honour held the patent invalid on the ground of ambiguity in claim 1 of the specification. The ambiguity was held to lie in the description of the feed duct, leading from the reservoir to the ball, as a duct " the cross-sectional area of which, particularly that portion adjacent to the ball, is less than that of the reservoir ". It was held that the words " particularly that portion adjacent to the ball " lacked any precise meaning. It is true, of course, that the words in question cover a number of possible constructions, but what the inventor wishes to convey, and does convey, seems to me to be clear enough. He means that the feed duct *may* throughout its length be of less cross-sectional area than the reservoir, or it *may* be of varying cross-sectional area, but the portion which immediately communicates with the ball housing *must* be of less cross-sectional area than the reservoir. On the one hand, the length of the feed duct within limits does not matter: it may be left to be determined by purely economic considerations. On the other hand, he may have feared that to describe the feed duct *merely* as being of less cross-sectional area than the reservoir might be to open the door to infringement, because it might be said that the claim covered only a feed duct which was of smaller cross-sectional area throughout its length. It is no real objection to this reading to say that he could have expressed himself more briefly and more clearly, and *might* perhaps even have got what he wanted if he had omitted the words " particularly that portion ". The patent is not, in my opinion, invalid for ambiguity in the specification.

It remains, however, to deal with certain other attacks made on the validity of No. 133. Mr. *Menzies* said that No. 133 was anticipated by the specification of No. 122. He also said that the process of so-called " amendment " in the Patents Office, by which the specification reached its present form before acceptance, was not authorized by, or permissible under, the *Patents Act* 1903-1950, and

that in the result the grant was void. It was the pleading of this objection that really led to the two interlocutory orders, which have been mentioned above, and which are now the subject of the cross-appeal to this Court. In the view which I take, it is not necessary to state the nature of those orders or the process of reasoning which led *Sholl* J. ultimately to reject the argument. One cannot, however, help observing that the procedure adopted, by which the argument now in question was more or less isolated from the rest of the case, while doubtless adopted with the best of intentions, appears to have been most unfortunate and to have led to unnecessary complexity, if not to actual confusion. Mr. *Menzies* lastly said that the patentee, at the date of his application for the patent granted as No. 133, was not in possession of the invention covered by the specification of No. 133 as it now appears.

Mr. *Menzies*' attack on the patent raises three distinct and separate arguments, only one of which depends directly on the course of the progress through the Patents Office of the application which ultimately led to the grant of No. 133. All of them, however, can be most conveniently considered after a brief examination of what happened in the office. An order was made under s. 51 of the Act for the production of the reports of the examiners, and these and other documents from the Patents Office were admitted subject to objection. No importance, I think, attaches to the examiners' reports as such, though they serve to make what happened much clearer than it would have been without them. I set out hereunder in chronological order what appear to be the material events.

1. On 8th December 1943 the application which led to the grant of No. 122 was lodged, with a complete specification, in the Patents Office.

2. On 31st December 1943 the application which led to the grant of No. 133 was lodged, with a complete specification, in the Patents Office. The specification is a long document, and it will suffice to quote the introductory part of it, to mention one or two other passages, and then to refer to the claims. Where italics occur, they are, of course, mine. The introductory part is as follows :— "This invention relates to fountain pens and refers more particularly to fountain pens of the kind which comprise an ink reservoir formed by an extension of the channel for supplying the writing point with ink, a system which by itself has yielded convenient results, although under certain conditions of arrangement only . . . In fact, the extension of the feed channel constituting the reservoir by means of a duct of small section allows of establishing

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a fluid vein of constant position, after the manner of an automatically replaceable lead rod in a pencil, but, in the provision of a duct of a certain length adapted to be fed with a relatively ample amount, several difficulties are encountered, *owing to the necessity of arranging the duct in a winding or meandering form*, or of otherwise arranging the same in such a way that it will occupy to the largest possible extent the capacity of the holder of the instrument . . . For this purpose, *a feed channel consisting of several sections* is provided, so arranged that the whole of the sections will form a *series or group of duct sections*, conveniently fitted in the body of the holder, thereby using the space to the best advantage. To this end, the duct sections, which form the ink reservoir, are connected together and communicate in series by means of passages leading from one section into the other, and, as said sections are longitudinal and preferably parallel to the axis of the pen, the whole of the sections will be of a length several times that of the holder." The applicant goes on to say that " the duct consisting of a plurality of sections " may be constructed in several ways, including that of a " capillary tube folded into several lengths." A further object of the invention, he says, is to have " a reservoir in the shape of a vein of great length with a minimum number of bends and occupying most of the body part of the holder of the pen ". He then refers to the accompanying drawings. The drawings comprise eight figures, every one of which shows a reservoir consisting of a tube or duct longitudinally folded so as to form a " series or group of tubular sections " communicating with each other, the whole forming a continuous but winding passage from an air inlet to a feed duct which leads to the writing point. The "*features which constitute the basis of the invention*" are thus described with reference to the drawings :—" In fact, said reservoir *b* is formed by a linear duct, *constituted by a plurality of lengths or duct sections* 5, preferably arranged as a whole and parallel to the body of the holder *a*, thus forming a series or group of duct sections which together occupy the greater part of the body *a* ; said sections 5 are connected together and communicate in series, one in continuation of the other, so as to form, as a whole, one single channel commencing at the inlet or air intake 6 and ending at the feed duct 4 of the sphere 3." After a description of the drawings comes this passage :—" From the foregoing description, it will be seen that *the invention substantially consists* in the provision of *sectional ducts, arranged as a whole to form a series or group*, by means of bends or passages, said duct sections communicating in series, one in continuation of another, so that the whole of duct sections will form one single duct, commencing at an inlet hole and

ending at a feed duct, connected to the mounting of the sphere, said duct constituting the reservoir *b*, to be filled with a dense or semi-fluid ink and to form therewith an uninterrupted liquid vein, extending to the mounting of the sphere." Then follow the claims. Claim 1 is for : " Fountain pen, of the type in which the ink reservoir is an extension duct of the feed channel for the stylographic point, *characterized by the fact* that the duct which forms the ink reservoir consists of a *series or group of duct sections*, provided with means for communicating in series one section with another, so as to form one single linear duct or channel, extending from an inlet open to the air, to the feed channel of said stylographic point." It is unnecessary to quote the other ten claims. It is sufficient to say that every one of them is for some specific form of a " series or group of duct sections ", connected together so as to form a continuous line of communication from an air inlet to a stylographic point. General comment on this specification may be postponed, but it is to be observed at this stage that the defendant's pen could not possibly be said to infringe any claim contained in it.

3. On 29th May 1946 a copy of the complete specification of English No. 573 was made available for inspection in the library of the Patents Office at Canberra. This means, of course, that that specification was published in Australia on that day. It is set out, so far as material, in the report of the English action (1). After stating that the invention relates to writing instruments of the ball-point type, it proceeds :—"An object of the present invention is to improve the construction of instruments of the aforesaid type. According to this invention an instrument of the said type is provided in which the ink reservoir for the ball is *constituted by a capillary tube*. The said tube is preferably open at one end to atmosphere and at the other end communicates with the rotatably mounted ball. It is preferably in the form of a series of limbs, each substantially parallel to the longitudinal axis of the instrument so that a comparatively long length of continuous tube can be accommodated in a comparatively small compass such as the usual type of fountain pen casing. The end of the tube remote from that end which is open to atmosphere conveniently communicates with the ball by way of a duct which is of the same diameter or cross-sectional area as the internal diameter or cross-sectional area of the tube or is smaller. The term tube as used herein, where the context so permits, includes a tube-like duct formed in a body " (2). Then follow references to the accompanying drawings, which are substantially identical with those which accompanied the Australian application

(1) (1949) 66 R.P.C. 193.

(2) (1949) 66 R.P.C., at pp. 199 et seq.

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lodged on 31st December 1943. Claim 1 (to which reference has already been made) is for "An instrument of the said type in which the ink reservoir is constituted by a capillary tube." Claim 4 is for "An instrument . . . in which the tube is formed into limbs substantially parallel with the longitudinal axis of the instrument."

4. On 5th September 1946 acceptance of the complete specification of No. 122 was advertised under s. 50.

5. On 18th December 1946, certain objections having been taken by the examiners to the form and substance of the specification lodged with the application of 31st December 1943, the patent attorneys of the applicant wrote to the Commissioner of Patents a letter in which, after dealing with the formal objections taken by the examiners, they said :—"As to the other matters raised by the examiner, it is proposed to remove them by a fresh description, statement of claim, and new drawings, all of which are submitted herewith." The document forwarded with the letter was a specification identical with that of English No. 573, the material parts of which have been set out above. This document, as has been seen, had been published in Australia on 29th May 1946, and contained a claim for a monopoly in respect of all pens "in which the ink reservoir is constituted by a capillary tube".

6. On 19th February 1948 *the original* specification lodged with the application of 31st December 1943 was notified as open for inspection under s. 38A. Under that section this amounted to publication.

7. Further "amendments" of the specification lodged on 18th December 1946 (English No. 573) were submitted on 28th January 1948, 16th November 1948, 10th March 1949, and 16th May 1949, with the result that the specification assumed the final form in respect of which patent No. 133 was granted. I will refer briefly to these later. It may be noted, however, at this stage that the examiner's objections to the specification lodged on 18th December 1946 included an objection that claims 1-3 of the specification of No. 122 (the grant of which had by this time been sealed) were in fact "claims to an instrument of the type in question in which the ink reservoir is constituted by a capillary tube." The answer made by the applicant's patent attorneys to this objection was that it was a feature of No. 122 that the conduit or conduits should follow an extended path, which feature was absent from the invention under consideration. This, of course, was true of the specification of English No. 573, but it was *not* true of the specification lodged with the original application.

8. The complete specification in its final form was accepted on 14th June 1949, and the acceptance was advertised on 30th June 1949. The date of the actual sealing of the patent does not, I think, appear.

From this recital the fact on which Mr. *Menzies*' arguments depend seems to emerge clearly enough. That fact is that claim 1 of the specification accepted by the commissioner is really for a different invention from that claimed by claim 1 of the specification lodged with the application. The truth is, in my opinion, that, when the patent attorneys forwarded with their letter of 18th December what they described as a " fresh description and statement of claim ", they were submitting a claim for something much larger than, and different in substance from, what had been claimed by the original application lodged three years before. The essence of the position will appear from a brief analysis.

To begin with, in No. 122 the inventor had conceived a reservoir with an air inlet which followed an extended or winding path and was of so small a cross-section that a suitable ink could not escape under the influence of gravity. There are, I think, two possibilities. He may have thought that both the small cross-section and the extended path were essential to success. Or he may have thought that the vital thing was the very small cross-section, and that the winding path was practically necessary in order to provide a reservoir of reasonable capacity. I am much disposed to think that the former is the correct view. In any case, of course, in order to apply successfully the meniscus principle, the essential thing was that his reservoir tube should be of larger cross-section at the top than at the end communicating with the ball housing. But, for all that appears, he was completely innocent of any attempt to apply any such principle. I would not agree, with respect, with a suggestion, which seems implicit in the judgments of both *Harman* J. and *Sholl* J., that he had discovered a principle without realizing it, or cleverly conceived an application of that principle without quite understanding why that conception worked. The truth is, I think, that nothing was more remote from his mind than the idea that a capillary tube, wider at one end than at the other, would solve the problem of the ball-point pen.

That such an idea was not less remote from his mind when he made the application which led to the grant of No. 133 seems to me to be made very clear by the complete specification lodged with that application. He refers to pens (i.e. such pens as are covered by No. 122) " of the kind which comprise an ink reservoir formed by an extension of the channel for supplying the writing point with

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ink." Some such arrangements, he says, have " yielded convenient results ". But difficulty has arisen from the " necessity of arranging the duct in a winding or meandering form or of otherwise arranging the same in such a way that it will occupy to the largest possible extent the capacity of the holder." Clearly the problem which he purports to be about to solve is the problem of *arranging* a duct of small section within the holder in such a way as to provide a " relatively ample " amount of ink in the reservoir. There is a degree of confusion in the language. But the problem faced is purely and simply a problem of *arranging* a reservoir tube within a holder, and that problem is solved by providing a " series or group of duct sections ". " The invention ", says the inventor himself, " *substantially consists* in the provision of sectional ducts " arranged in a particular way. He is concerned, of course, throughout with " a duct of small section ", such as he was concerned with when he applied for the patent granted as No. 122. But there is nothing from beginning to end to suggest that he has discovered or invented an application of the meniscus principle. The claims are all, without exception, for some specific form of a " series or group of duct sections ". If No. 133 had been granted on this original specification, it would have been idle to suggest that the defendant's pen was an infringement.

When the original specification for No. 133 was lodged with the application of 31st December 1943, the major objection of substance taken by the examiner was that the invention was already covered by the specification of No. 122, which had already been lodged. There is obviously a great deal to be said for this view : indeed I think it is correct. The objection was ultimately met by the *substitution* of the specification of English No. 573. Claim 1 of this specification claimed, in effect, a " capillary tube " reservoir *simpliciter*. The folded or sectional tube is now referred to merely as a " preferable " form of construction. The amendment appears in fact to have been treated as if it were a fresh application. One objection taken by the examiner was that the capillary tube as such had already been claimed in the application for No. 122. To this objection of the office the reply was on 28th January 1948 that under No. 122 the conduit followed an extended path, " whereas, according to the present invention, it would be in order to apply an appropriate conduit or tube of, say, 6 mm. in length and this could not be said to fall within the definition of an ' extended path ' ". What is meant by this is far from clear, but it may have been intended to refer to a conduit following a " straight " path. At any

rate the examiner disagreed with it. He said :—" Such an interpretation is nowhere obtainable from the original specification, whereas the contrary is plainly stated throughout that document." This statement appears to me to be perfectly true. To a new claim 1 submitted (which need not be set out) the objection was very properly taken that it was " directed to an instrument characterized by a specific result."

Further amendments submitted on 16th November 1948 included a new claim 1, which was identical with claim 1 as ultimately accepted except that it did not include the words " particularly that portion adjacent the ball ". Corresponding alterations were made in the body of the specification. Here, with the express reference to a restricted feed duct, we do get for the first time what is really an application of the meniscus principle. The objections taken by the office to the new claim included what seems to be the perfectly sound objection that a " restricted feed duct " had not been claimed in the original specification. The answer made on 10th March 1949 was that the restricted feed duct was indicated in the drawings. (A legitimate replication to this might have been that this feature was also shown in the drawings relative to No. 122). It was also proposed to amend claim 1 so as to include the words " particularly that portion adjacent the ball ". After this the only substantial objection taken by the office was that fig. 1 of the drawings did not " include a restricted feed duct—*the essential feature of the invention* ". This was, of course, easily remedied, an amendment of the drawing being lodged on 16th May 1949, and the specification was shortly afterwards accepted in the form in which it now appears.

In this way it seems to me clear enough that a patent, bearing the date of the original application, came to be granted for an invention quite different from that described in the specification accompanying that application. The substance of what was done when the specification of English No. 573 was lodged on 18th December 1946 (three years after the original application) was that a new application for protection for a different invention was being made. If, of course, such a new application had actually been made on 18th December 1946, it would have been met at once by the fact that the invention had been published in Australia some seven months before. The real position was, I think, disguised by the fact that substantially the same drawings accompanied the No. 573 specification as had accompanied the specification lodged with the original application, coupled with the statement in the body of the specification that the tube was " *preferably* " in the form of

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a series of limbs folded longitudinally. The truth is that the series of limbs folded longitudinally was the essence of the invention described in the original specification. The truth is also that the specification ultimately accepted described an invention for the purposes of which it was *not* preferable to have a tube composed of a series of limbs. On the contrary, when once the meniscus principle was applied by the provision of a tube wider at the top than at the ball, both the "winding path" and the "longitudinal folding" became not merely unnecessary but practically useless, for a straight tube would be just as efficient and obviously much easier and cheaper to manufacture. The drawings and the false statement about a "preferable" construction tended to conceal the nature of what was really being done.

To arrive at a correct understanding of what really happened in this case has been a long and tedious process. But, when once the position is understood, it is possible to deal quite shortly with the three arguments which I have understood to be submitted by Mr. *Menzies*.

One argument was that No. 133 was anticipated by No. 122. I think that this would have been a sound ground of attack if No. 133 had been granted on the specification lodged with the original application. But the specification accepted by the commissioner is not, in my opinion, open to attack on this ground.

It is next said that the process of metamorphosis, by which the specification originally lodged became the specification finally accepted, was not a process of amendment such as is authorized by ss. 42 et seq. of the *Patents Act* 1903-1950. The result is said to be that the grant is void. I have indicated my opinion that the accepted specification claimed a different invention from that claimed by the specification originally lodged, and I think that the substitution of the specification of English No. 573 for the specification as it stood before represented a departure from anything really contemplated either by s. 42 or by s. 45. And it is not an impossible view that a valid grant based on that substitution could not be made. On the whole, however, I am of opinion that it does not follow that the grant of No. 133 is void. Such a conclusion might follow if it could be said that that substitution was not really an "amendment" at all, and that it was actually unlawful for the commissioner to allow it. But I do not think that this can be said. I am unable to avoid the conclusion that the effect of s. 46 is to give to the commissioner a discretion, and to place his acceptance of the specification beyond challenge as such. Considerable difficulty attaches to reading Div. 4 of Pt. IV of the Act with those provisions

of Div. 1 of Pt. IV which authorize the amendment of a complete specification. But s. 45—unlike s. 71—does not impose on the making of any amendment the condition, imposed by s. 78, that the amendment shall not have the effect of claiming an invention "substantially larger than or substantially different from" the invention for which protection was originally claimed. That it does claim such an invention may very well be a good ground for a refusal to accept a specification amended under s. 45. But I do not think that an acceptance under s. 46 can be challenged as such. And to say that the patent is void by reason of what happened in the Patents Office between application and acceptance is, in effect, to challenge the acceptance as such.

Clearly, however—and this brings us to the final argument for the respondent—acceptance does not preclude an attack on the patent on any ground on which a patent may be held to be invalid. Prior grant, prior publication, prior user, want of subject matter, and all other grounds of attack, remain open to an applicant for revocation or to a defendant in an action for infringement. In particular, it is open to such a defendant to attack the patent on the ground that the patentee was not, at the date of his application, in possession of the invention protected by the grant. This is a good and sufficient objection to the validity of the patent. If it were otherwise, a valid patent could be granted on a false suggestion, and a monopoly could be obtained as from a particular date for something which the patentee had simply not invented at that date.

In the present case, on the material before the Court, the only proper conclusion, in my opinion, is that the patentee was not on 31st December 1943 in possession of the invention ostensibly protected by patent No. 133. An inventor cannot complain if we judge what he has invented by looking at what he says he has invented. Looking at the complete specification of No. 133 as it has existed from time to time, one can only say that the invention (if any) of which he was in possession on 31st December 1943 was an invention of a different character from that described in the specification which was ultimately accepted by the commissioner. The former was an invention much narrower and of much less utility than the latter.

The view indicated above would be decisive of the case, and would lead to a dismissal of the appeal in action No. 58 of 1951. The question, however, arises whether the patentee ought not to be given an opportunity to place before the Supreme Court, if he can, further material bearing on the question whether he was in possession of the relevant invention on the relevant date. That question

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is essentially a question of fact. The position which has arisen is peculiar. Largely because of the unfortunate course which the proceedings took in the Supreme Court, what I regard as the real and ultimate question in the case became to some extent lost to sight, and it did not receive the attention which, to my mind, it deserved. It is perhaps not very likely that the plaintiff will be able to better his case. But it is not impossible, and, having regard to all the circumstances, I think on the whole that he ought to have an opportunity of doing so. Accordingly I agree with the order proposed by the Chief Justice.

TAYLOR J. In these appeals the appellant seeks to set aside orders made by the Supreme Court of Victoria in two suits in each of which the appellant was the plaintiff and the respondent was the defendant. In each suit the appellant sought an injunction restraining the respondent from infringing letters patent of the Commonwealth and claimed damages for past infringements. The suits were heard together by *Sholl* J. who, after considering the matter at length, ordered that judgment in each suit should be entered for the defendant.

The letters patent, the subject of the first suit, related to " Improvements in writing instruments ". They were letters patent No. 122073 and they have throughout the hearing of the suit and this appeal been referred to as No. 122. Those the subject of the second suit—No. 133163—also relate to improvements in writing instruments and have been referred to as No. 133.

The defendant denied the infringements alleged by the plaintiff in each suit and, further, claimed, on several grounds, that the letters patent were invalid in whole or in part. Some of the issues originally raised by the pleadings, however, ceased to be of importance in the suits and were not debated on this appeal, whilst other issues arose before the trial as the result of preliminary discussions upon questions of law which were said to arise upon the pleadings. It is impossible to appreciate the issues which ultimately arose for decision and which are in question in this appeal without at least a brief reference to the specifications of the inventions the subject of each patent.

No. 122 : As has already been said this invention purports to relate to " Improvements in writing instruments ". More particularly the specification declares that the invention " relates to improvements in fountain pens of the ball-tip type, and particularly to means for providing a regular ink feed to the ball constituting the active or writing element of said instrument ". The most

suitable ink for pens of this type is said to be " so-called ' dense ' ink, which is very adhesive ", and the ball, it is said, will, in rotating, " transfer to the exterior a regular and sufficient quantity to make neat and normal strokes ". One of the objects of the invention is described by reference to a difficulty experienced in the use of " barrel-shaped reservoirs " in such writing instruments. The specification states that in the case of such a reservoir " the mass of ink will change its position as the instrument is moved about, so that when the tip of the pen is raised contact between the ink and the ball is lost, with the result that normal working of the instrument may be interrupted or impaired ; another object of the invention is to overcome this difficulty ". A further object is declared to be " to provide an ink reservoir wherein gravity does not alter the position of the ink and wherein the charge is kept in a satisfactory condition and forms a continuous vein of liquid to provide a continuous feed as and when required without delay or interruption ". Thereafter the specification declares "According to the present invention an instrument of the ball-tip type is provided in which the ink reservoir is formed by one or more conduits starting at an air intake, *and after following an extended path*, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intakes under the effect of gravity. According to one method of carrying the invention into effect the ink reservoir is constituted by one or more conduits arranged in the form of a helical coil." The specification then proceeds to indicate that the above and other objects and advantages of the invention will become apparent from the ensuing descriptive matter when read in conjunction with the attached drawings which purport to illustrate by way of example some of the preferred embodiments of the invention.

The italics in the above extracted matter are mine and merely serve to indicate at this stage a passage in the specifications concerning which considerable discussion took place on the appeal. I should add that the italicized expression is repeated in the first claim made by the patentee in the specification. This claim is in the following terms :—" Improvements in writing instruments of the ball-tip type, wherein the ink reservoir of said instrument is formed by one or more conduits starting at an air intake and, after following an extended path, communicating with the recess for said ball, the said conduit or conduits being of so small a cross-section that a suitable ink cannot escape from the air intake under the effect of gravity ".

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It is, of course, impossible to appreciate fully the descriptive matter concerning the " preferred embodiments " without recourse to the drawings or diagrams accompanying the specification but it is not without significance that the ink reservoirs shown in the drawings are constituted in the form of helical coils or channels or inter-connected annular convolutions.

The article manufactured and sold by the respondent is a ball-pointed writing instrument constituted by an outer casing which contains a reservoir in the form of a very narrow gauge or capillary tube with an air intake at the end remote from that adjacent to the ball. In many respects it is similar to that described and for which claims are made in the specification of No. 122. The tube is of such small cross-section that " a suitable ink cannot escape from the air intake under the effect of gravity " and " gravity does not alter the position of the ink " which " forms a continuous vein of liquid to provide a continuous feed as and when required without delay or interruption ". The reservoir feeds, as in the invention described in the specification, to a rotatable ball which, in rotating, transfers a sufficient quantity of ink to the exterior of the ball to enable the user to write. The distinguishing feature of the instrument which is said to infringe the appellant's patent—if, indeed it be a distinguishing feature—is that the reservoir is constituted by a straight capillary tube. The evidence shows that if what is called a capillary tube is used as a reservoir in association with ball-pointed instruments of this type the column or vein of ink contained in a fully charged reservoir will not be displaced by the force of gravity when the pen is moved or even inverted and that it is unnecessary in order to obtain this result that the tube should take the form of a spiral or should in any way diverge from a straight course within the holder. The case of the respondent was that this feature of its instrument clearly distinguished it from the appellant's invention. It was, it was contended, of the essence of that invention that the reservoir of the instrument described and disclosed should consist of a helical coil or annular convolutions or take some other form of " extended path ". Whilst conceding that the drawings of the " preferred embodiments " disclosed in each instance reservoirs of that type counsel for the appellant contended that there was nothing in the description of these embodiments—which were only *preferred* embodiments—to suggest that a bent tube was essential to or of the essence of the invention. Helical or spiral tubes might have been preferred, it was said, but they were not considered to be essential. *Sholl* J., however, was of the contrary opinion though no doubt he was greatly influenced in coming to his conclusion by the decision

of *Harman J.* in *Martin* v. *Selsdon Fountain Pen Co. Ltd.* (1) when he was called upon to consider precisely the problem which arises on this aspect of the appeal. The terms of the specifications of United Kingdom patent No. 571698, which were then under consideration, are identical with those of No. 122 and on this point *Harman* J. said :—" Now like canons of construction apply to specifications as to any other written instrument. (See Lord *Esher's* speech in *Nobel's Explosives Coy.* v. *Anderson* (2)). Plain language must be given its plain meaning, and clear words in a claim must not be tortured into an unnatural meaning by importing passages from the body of the specification. (See Lord *Russell's* speech in *Electrical & Musical Industries, Ltd.* v. *Lissen, Ltd.* (3)). The claims also must be construed without an eye on the alleged infringer's acts. (So said *Greene* L.J. in *R.C.A. Photophone Ltd.* v. *Gaumont British Picture Corporation* (4)). On the other hand, it is right to construe a claim with an eye benevolent to the inventor and with a view to making the invention work—this is an application of the old doctrine *ut res magis valeat quam pereat*—and it is illustrated in *Nobel's Case* (5); and, where the language of a claim is obscure or doubtful, the doubt may sometimes be resolved by referring to words in the body of the document to explain it. This is known as the dictionary principle. (See Lord *Haldane's* speech in *British Thomson-Houston Coy., Ltd.* v. *Corona Lamp Works, Ltd.* (6)). All these observations are indeed truisms. Turning then to 571, the argument on construction concerned chiefly the words in Claim 1, repeated by reference in Claim 9, ' after following an extended path '. It is said by the Plaintiffs that these merely mean that the path which the vein of ink follows constitutes the extension of the feed channel from its start at the ball till it reaches the air intake, and they point to the words at 1. 126 on p. 2 which I have already read and which speak of an extension of the feed channel. The Defendants, on the other hand, say that, in order to give these words any, or any adequate, meaning, they must be a reference to the fact that in all the embodiments of the invention the conduits are shown as either coiled or helical or twisted in some spiral, and that the meaning of these words is that the conduits must not be straight, but must follow a path longer than that which they would take if they passed direct from the ball to the air intake. They point to the fact that at 1.30 on p. 3 the reservoir is described in so many words as being ' a coil of small section ' and argue that on a

(1) (1949) 66 R.P.C. 193.
(2) (1894) 11 R.P.C., at p. 523.
(3) (1939) 56 R.P.C., at p. 41, l. 34.
(4) (1936) 53 R.P.C., at p. 202, l. 16.
(5) (1894) 11 R.P.C., at p. 524.
(6) (1921) 39 R.P.C., at p. 67, l. 44.

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fair reading of the document it is clear that the inventor supposed, whether rightly or wrongly, that there was some virtue, beyond mere added area of the contents, in twisting the reservoir; for instance, that the force of gravity would have less effect upon it, and there would be more resistance to the shock caused to the column of ink by dropping the pen. I have carefully considered these rival views and have come to the conclusion that the Defendants' construction is the right one. The words are no doubt capable of either meaning and I am, in my judgment, entitled, in order to interpret them, to look at '571' before its amendment. In doing so, I find these passages at l. 60 of p. 1 and, again, at l. 72: 'According to the present invention an instrument of the said type is provided in which the ink reservoir is formed by one or more conduits starting at an air intake and, after following an extended path, leading into the feed channel or cavity for said ball'; and (l. 72) 'To this end, the conduit constituting the reservoir is of helical or other similar shape or arrangement following an extended path from a corresponding air intake to said feeder'. These have been struck out of the amended specification, but seem to me to show that the author used the words in the sense attributed to them by the Defendants. The words appear in the first and primary claim and seem to me to signify something more than an indication that the conduit begins at the ball and ends at the air intake. Whether the inventor was right or wrong in supposing that there was any virtue in twisting or turning the conduit seems to me to matter not at all. It is the direction he gave which matters and that, as it seems to me, is a direction to follow a twisting path of some sort, though not necessarily exactly as his various figures show" (1). As will be observed his Lordship's decision was influenced by the consideration of words which appeared in the specification before it assumed its final form and which at that time had been struck out. Whether or not this represented a permissible approach to the question of construction involved is in this case immaterial for the complete specification for No. 122 lodged on 8th December 1943 was accepted in its original form on 5th September 1946. Accordingly its true construction depends upon a consideration of its terms alone. Nevertheless unaided by the extraneous matter to which *Harman* J. thought it proper to refer I am of the opinion that the respondent's instrument is not within the relevant claim made in No. 122. Claim 1, which, it is alleged, the respondent's instrument infringes lays stress upon the feature that the reservoir follows an extended path "starting at an air intake and . . .

(1) (1949) 66 R.P.C., at p. 209-210.

communicating with the recess for the said ball". It was, of course, contended that an "extended path" need not follow a helical or spiral course and with this I entirely agree. There is no doubt that, in the abstract, extension may take place along a straight path; but the expression "extended" is a word of wide and elastic meaning and the sense in which it is used in any particular context must necessarily depend to some extent upon that context. In the present case it is used to describe the course which a narrow tube, with an air intake at one end, should pursue in its course inside a confined space to connect with the recess in which a rotatable ball is housed. In these circumstances if the word "extended" is to be given any significance at all surely it must be understood as an antonym of "direct" or "straight". The holder, though of undefined is yet of finite size and within it the tube is to pursue an extended path. In my view this expression must be taken to connote something other than direct and in my opinion this feature of the invention was described and claimed as vital. It may be, as *Sholl* J. observed, that in 1943 the applicant for these letters patent "initially did not fully comprehend the nature and application of the principle of capillary forces in relation to his instrument, but became more clearly aware thereof as time went on". But no claim was made founded simply upon the use or characteristics of a simple capillary tube. On the contrary the continuous vein of ink was to be maintained by a combination of features, i.e. a tube of small cross-section following an extended path within a fountain pen casing. If it be thought that the words of the first claim are equivocal—and I do not think they are—ample support for the view which I have expressed may be found in the description of the various preferred embodiments and on this point particular reference might be made to the passage in column 6 commencing at line 34 where it is said: "Inasmuch as the reservoir is formed by a *coil* of small section the instrument may be placed in any position and used in any manner without the vein of liquid being affected by gravity".

The view which I have expressed on this point is fatal to the appeal from the order in the first suit and accordingly I am of the opinion that it should be dismissed.

No. 133: A complete specification for this invention was lodged on 31st December 1943 and after a number of amendments the specification as finally amended was accepted on 14th June 1949. The defences raised in answer to the plaintiff's suit for infringement of these letters patent denied infringement and asserted that the

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letters patent were invalid for ambiguity, insufficiency and vagueness. These issues were resolved in favour of the respondent and the questions which arise on this appeal are concerned with those matters. The respondent also asserted by way of defence laches on the part of the appellant, invalidity of the letters patent on the ground of want of subject matter and that no inventive step was involved and also that the letters patent were void because of amendments permitted and made after the lodging of the complete specification and before acceptance of the specification in its finally amended form. These additional matters of defence were determined against the respondent and became the subject of an appeal by the latter. That appeal was heard immediately after the conclusion of the argument in the main appeals.

For the purpose of discussing the various points involved, it is convenient first of all to deal with the main appeal in respect of the suit leaving the matters which were debated on the respondent's appeal to be stated with more particularity at a later stage of these reasons.

The complete specification for letters patent No. 133 in the amended form in which it was ultimately accepted purported to relate to " writing instruments of the type in which a ball is mounted for rotation in a housing with part of the ball exposed and is supplied with ink from a suitable reservoir, the arrangement being such that as the ball is rotated such as by being moved relatively to and in contact with a writing surface the ball carries a quantity of ink through the housing, which ink is deposited on said surface and a trace is made." An object of the invention was said to be to improve the construction of instruments of that type. According to the applicant he provided " an instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink *a continuous liquid vein is maintained extending from the ball*, and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, *particularly that portion adjacent the ball*, being less than that of the reservoir ". The italics again are mine and draw attention to two expressions concerning which there was considerable discussion. The expression " vented tube of capillary size " is employed in the specification " in relation to the reservoir of a writing instrument of the type specified to mean a tube having an internal bore of between 1 and 4 mm. (subject to a manufacturing tolerance of the order of +, —, 5%) so that when charged with a viscous ink the meniscus formed at the end of the ink column remote from the ball (at the interface between the ink, the air and the interior surface

of the tube) is stable and will not break under shocks to which the instrument is subjected in normal use." Claim 1, which it is alleged the respondent's instrument infringes, is in the following terms:—"An instrument of the type specified, having the ink reservoir constituted by a vented tube of capillary size in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball, and having a feed duct leading from the reservoir to the ball, the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir." The references which I have made to the specification are brief but they are sufficient, at least, to enable the two points made by the respondent concerning vagueness and ambiguity to be appreciated. In the first place it was said that the words of the claim " the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir " make it quite impossible to determine whether the claim was intended to cover any instrument in which the cross-sectional area of the feed duct or any part thereof is the same as or greater than that of the reservoir. Concerning this submission *Sholl* J. said:— " It was next said that the expression, ' the cross-sectional area of which duct, particularly that portion adjacent the ball, being less than that of the reservoir ', was ambiguous, in that it was impossible to be certain whether an instrument having the feed duct so constructed that the portion of it adjoining the reservoir was of the same cross-section as the reservoir, or of larger cross-section, while the portion of it adjacent to the ball was of smaller cross-section than the reservoir, did or did not infringe the claim. It was said by Mr. *Shelley* on the other hand that the word ' particularly ' merely provided emphasis, and that if any portion of the feed duct were of the same cross-section as or greater cross-section than the reservoir, there would be no infringement, except possibly in the case of a mere ' colorable departure ' within the doctrine of *Clark* v. *Adie* (1). In the end, I have come to the conclusion that there is here an invalidating ambiguity. I am rather disposed to think the draftsman of claim 1 wanted to have the best of both worlds, and that he may have thought he was saying, in effect,—' I claim a monopoly in all instruments in which, in addition to the other three characteristics earlier mentioned, there is a feed duct leading from the reservoir to the ball, and having a lesser cross-section than the reservoir ; but I go further than that, and I also claim all those with the same three previously mentioned characteristics, and a

(1) (1877) 2 App. Cas. 315.

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feed duct leading from the reservoir to the ball, if the portion of the feed duct adjacent to the ball has a lesser cross-section than the reservoir, whatever be the cross-section of the rest of the duct'. Now that is just the opposite of the construction which Mr. *Shelley* sought to give the claim, although, as a matter of literal interpretation, there is much to be said for his reading of it. I simply do not know with any reasonable certainty which meaning the draftsman really intended, and there is no evidence on which I can say that the ordinary person skilled in the art of making pens, to whom the specification is addressed, could be reasonably certain. The matter is perhaps made more rather than less difficult by the fact that, as Mr. *Shelley* stated early in the hearing, and as the technical evidence made clear, the element of the feed duct and its cross-sectional area is not technically essential at all to the operation of the capillary tube as a non-leaking reservoir, but is merely a convenient feature for the purpose of feeding an appropriately small amount of ink to the ball point of a practical pen. The patentee has chosen, for reasons associated (as will later appear) with the objections of the examiner, to claim a combination including this fifth element, but it cannot be said with certainty what the element is, and accordingly I think the first claim, and therefore all the claims, are invalid for ambiguity and uncertainty." I confess that I do not experience the same degree of difficulty which his Honour experienced. It is true, of course, that the language of the claim is by no means clear but this does not conclude the matter. Imperfections of expression constantly give rise to difficulties in construction but only occasionally is a court driven to the necessity of saying that no reasonable meaning can be found for the words used. In the present case it is clear that the reservoir, consisting of a vented capillary tube as described is not to exceed 4 mm. + 5% for manufacturing tolerance. From one end of this reservoir—if indeed no part of the feed duct itself should properly be regarded as part of the reservoir—a feed duct provides access for ink to the internal side of the rotatable ball. Now claim 1 stipulates that the cross-sectional area of the feed duct shall be less than that of the reservoir and if the language of the claim stopped there the present contention could not have been advanced. The difficulty, if there be one, arises from the interpolation of the words " particularly that portion adjacent the ball ". The interpolation of these words does not make for clarity and literally does not make sense. But while it is clear that " the function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers "

(per Lord *Russell of Killowen* in *Electrical & Musical Industries Ltd.* v. *Lissen Ltd.* (1)), it is equally clear that it is the duty of the court to endeavour to ascertain from the language used the true meaning of any claim or claims. It is not the function of the court lightly to discard the claims in a specification on the ground that the language used is vague and uncertain. Now, in the present case do the words used, bearing in mind the interpolation, bear any reasonable meaning? I think they do. It is clear that the cross-sectional area of the reservoir may vary from 1 mm. to 4 mm. so that in concerning oneself with the feed duct—if it be entirely separate and distinct from the reservoir—it is necessary to visualize a duct leading from a vented tube which may have a cross-sectional area of 1 mm. or 4 mm. or somewhere between those specifications. It would be quite foreign to the conception of a feed duct that the cross-sectional area of any part of it should exceed that of the reservoir from which it leads and the terms of claim 1 read without the interpolated words make it clear that no such thing was intended. Nor, in my opinion, is the effect of the interpolated words to indicate otherwise. Their purpose, it seems to me, is to indicate that particular attention must be devoted to that portion of the feed duct adjacent to the ball. The degree to which the cross-sectional area of the feed duct must be diminished below that of the reservoir will depend primarily upon the cross-sectional area of the latter. The ball is described as having a diameter " in the order of 1 mm." so that it is apparent that where the cross-sectional area of the reservoir is of the maximum specified the degree to which the cross-sectional area of the feed duct must ultimately be diminished may be relatively great. In other cases it may be very little. In my view the purpose of the expression " particularly that portion adjacent the ball " must be taken to have been used with this circumstance in mind, and it was intended to indicate that, notwithstanding some general narrowing of the feed duct at or after its junction with the reservoir, a particular diminution was required at the point adjacent to the ball. This being so, I am of the opinion that the respondent's first submission on this aspect of the case should be rejected.

The second objection to the specification on the ground of vagueness was based on the words of claim 1 " in which when charged with viscous ink a continuous liquid vein is maintained extending from the ball ". The objection was that it was impossible to ascertain whether the claim was that the vein of ink extending from the ball would be maintained *in all circumstances* or *at all times*

(1) (1939) 56 R.P.C. 23, at p. 39.

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during the normal use of the instrument. I have no doubt that the claim should not be read in the wider sense. The invention relates to writing instruments and it would be doing an injustice to the language of the claim to read it otherwise than as a claim that the vein of ink would be maintained in the position indicated during conditions prevailing in the course of its normal employment and use as a writing instrument.

The matter remaining for consideration on the main appeal is the question of infringement and this question is in a considerable measure related to the question of construction to which I have just referred. For the respondent contends that, even conceding the narrower construction of the relevant words of clause 1 to be correct, the pen which is alleged to infringe the appellant's letters patent is not a pen in which a vein of ink extending to the ball is maintained in the relevant circumstances. It was shown that such a vein was not maintained " when an attempt was made to write on a horizontal surface above the writer's head, or on a vertical or inclined surface in a position where the ball-point of the instrument . . . was raised substantially above the end remote from the ball." On this point *Sholl* J. said :—" Now I leave out of account altogether the case of attempting to write on a horizontal surface above one's head. There might be some extraordinary case in which someone might want to write on a ceiling or in some similar position, but it would certainly not be a normal method of use. But the question of writing on a vertical or inclined surface with the point above the opposite end is quite a different matter." After reviewing the evidence his Honour proceeded :—" Now can it be said that the defendant's pen is one in which ' when charged with viscous ink a continuous liquid vein is maintained extending from the ball ', in what I shall, for brevity, describe as all conditions of normal use ? I have come to the conclusion that it cannot. To begin with, Dr. Fehling, at p. 198, when considering whether any conditions of ' normal use ' could arise resulting in a risk of leakage, described one case by saying, ' The only condition I know *and the user of the ballpoint pen is familiar with,*—if I write upwards . . . ' But in the next place, I cannot say, viewing the matter as a jury would, and using my own general knowledge of everyday affairs and events, that it is not one perfectly normal method of using a writing instrument in general, or a fountain-pen or ballpoint pen in particular, to write on a vertical or inclined surface with the point of the instrument above the horizontal. Nor can I say, looking at exhibit 8, that it would be quite abnormal to seek to write in such a position more than there appears. Almost everyone, I suppose,

has seen on the vertical notice-boards of social or other clubs, or of sporting bodies, documents on which persons are invited or expected to write names or other particulars, and on which it is usual or preferable to write in ink,—e.g., entries for tournaments, results of matches, subscriptions for donations, and the like. Many persons have seen in the headquarters or other establishments of the armed forces, or in the laboratories or control rooms of many kinds of technical establishments, charts, lists, maps, or other documents on vertical walls or boards, on which it is the practice manually to write in ink entries from time to time of all kinds of particulars. Tradesmen and carriers are frequently seen to write in such a position against a wall. Viewing the matter again as a judge of fact, I entirely disagree with Mr. *Phillips*' suggestion that in such cases people attempt to write with the point below the horizontal; that would be most unusual. It is hardly a matter on which one can expect evidence to establish any more than one's observation and commonsense tell one. Accordingly I am of opinion that the defendant's pen, exhibit E, and any similar pen relied on by the plaintiff as an infringement, has not been shown to infringe claim 1, nor, therefore, any other claim of the patent, if one construes claim 1 as I have construed it (and as the plaintiff's counsel construed it) in relation to the first four elements referred to in it, and assumes it not to be invalid for ambiguity as to the last element mentioned in that claim ".

In one sense it may, I think, be quite fairly stated that a pen is not normally used to write at a height on vertical surfaces. At all events pens ordinarily serve their purpose in less awkard circumstances. But, however, this may be there was abundant evidence which was not in dispute that both the patented instrument and the defendant's pen would for a short period write, not only when the end remote from the ball was some distance below the latter, but even when held vertically with the ball-point uppermost. It was only after use in this position for some short period that the possibility of air entering the ball-point end occurred and made possible the displacement of the otherwise constant vein of ink. There was evidence, apparently acceptable to his Honour, that the defendant's pen, and indeed other pens of the same type, will continue to write and that the vein of ink extending to the ball will otherwise be maintained indefinitely not only during the ordinary vicissitudes of the normal life of a pen, but also if used with the end remote from the ball poised below the level of the writing end to the extent of about one inch. It is only when the remote end if lowered further

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and the pen is used in that position for some little time that possibility of disturbance of the vein of ink occurs. Now, whatever may be thought of the learned trial judge's view of what may be considered to be the normal use of a pen, I am firmly of opinion that it is no part of the normal function of a pen and that a pen is not normally used to write for long periods upon highly placed vertical surfaces. Nor can I believe that the relevant words of the claim would be so understood by "a reader ordinarily intelligent and versed in the subject-matter" (per Lord *Shaw of Dunfermline* in *British Thomson-Houston Co. Ltd.* v. *Corona Lamp Works Ltd.* (1)). The use of a pen for the purposes indicated in the illustrations given by his Honour may be thought to constitute normal use, but none of such purposes require the use of a pen for long periods or, necessarily, in a position in which the infringing instrument or the patented instrument would not continue to function indefinitely. On the contrary, the evidence seems clear that the vein of ink would be maintained for considerably longer than it would take to complete entries or notations of the nature indicated by his Honour even if the pen were held in a vertical position with the writing end uppermost.

These reasons lead me to conclude that the first appeal should be dismissed and that the matters debated in the second appeal should be decided in favour of the appellant. Accordingly it becomes necessary to consider the matters which arise in the respondent's appeal.

I have already stated in a general way the defences unsuccessfully raised in the suit. Not all of these defences were, however, pursued in the appeal. Those which were are concerned, in some way or other, with events which occurred between the lodging of the complete specification for No. 133 on 31st December 1943, and the acceptance of the specification in its finally amended form on 14th June 1949, and it is material to refer to some of those events. The first event of any significance was that on 29th May 1946, there became available for inspection in the library of the Patents Office at Canberra the complete specification of what was referred to as United Kingdom letters patent No. 573. Thereafter, on 18th December 1946, the specification for No. 133 was amended. The result of this amendment was to make the specification identical in terms with that of the United Kingdom patent. The next event was that the specification, in its original form, was, pursuant to s. 38A of the *Patents Act* 1903-1946 (which came into force on 11th September 1946) published in the official journal on 19th February

(1) (1921) 39 R.P.C. 49, at p. 89.

1948. At later stages, namely on 28th January 1948, 16th November 1948, 10th March 1949 and 16th May 1949, further amendments were made. The complete specification, as so amended, was, as I have said, accepted on 14th June 1949 and such acceptance was duly advertised pursuant to s. 50 on 30th June 1949.

The first point which is made upon a comparison of the specification in its original form and the form in which it was accepted is that the invention ultimately claimed was not the invention described or claimed in the original specification. The immediate result of this, it is contended, is that the letters patent are invalid. Several steps are involved in this argument. First of all, it is said, it is a condition precedent to the right of the commissioner to seal letters patent that a complete specification of the invention shall have been lodged and accepted. In the present case, it is then said, no such specification was in existence at the relevant time. It is true, of course, that there was in existence a document which purported to be such a specification and that the commissioner purported to accept it as a specification, but this document came into existence by the amendment of the original specification and, it is argued, the power implicit in s. 45 of the Act to allow amendment does not authorize amendments which would result in claims for an invention not described or claimed in the original specification. Any amendment which purports to produce this result, it is contended, is without legal effect and since, it is further claimed, this was the purport of the amendments in this case the specification as finally amended is not a specification at all and is entirely without legal effect.

It is possible, however, to concede that the power to allow the amendment of a specification is not unlimited without producing the result contended for by the respondent. A mere perusal of the provisions of Div. 4 make it appear clearly that amendments should not be made in pursuance of that division which "would make the specification as amended claim an invention substantially larger than or substantially different from the invention claimed by the specification before amendment" (s. 78) but it appears equally clearly that "leave to amend shall, notwithstanding the last preceding section, be conclusive as to the right of the party to make the amendment allowed except in the case of fraud" (s. 79). Again, the question whether "all directions for amendment are complied with" under s. 44 is a matter for the consideration of the commissioner alone. It would be strange if, these matters having been left to the decision of the commissioner, the legislature, in enacting ss. 45 and 46, intended to pursue the entirely different

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course of allowing the question of the validity of a patent to depend upon a subsequent judicial inquiry whether some particular amendment to the specification as originally lodged should have been permitted under s. 45. During the discussion concerning this problem counsel for the respondent emphasized the difficulties created by s. 38A and s. 54 if the contrary view should be taken. After publication of a complete specification of an invention the applicant has, by virtue of the provisions of s. 54, " the like privileges and rights as if a patent for the invention had been sealed on the date of the publication of the complete specification ". But what happens if, after publication and before acceptance, the specification is amended in such a way as to claim a different invention ? Is the later invention protected as from the date of the publication of the original specification ? Or does protection for the invention as originally claimed exist until amendment and thereafter protection accrue to the new invention ? But these and other like questions which may be asked concerning the effect of s. 54 in such cases do not serve to indicate that it was intended that the question of the propriety of amendments under s. 45 should be removed from the bona fide discretion of the commissioner. At the most they go to show that it was not intended that the commissioner should permit amendments, so to speak, at large and that it was intended that the power should be exercised within limits not wider than those specified for the operation of Div. 4 by s. 78 thereof. Moreover, it should be noted, the difficulties—which to me seem rather apparent than real—may present themselves fairly and squarely in relation to amendments allowed in the discretion of the commissioner under that division.

The question whether the propriety of amendments under s. 45 is a matter for the bona fide discretion of the commissioner is, I think, best solved by an examination of that section and s. 46. Clearly s. 45 contemplates amendments to meet the adverse report of an examiner and the amendments contemplated are amendments to the specification of an invention already disclosed. This alone is sufficient to enable one to say that the section does not contemplate that by amendment the specification of one invention may become the specification of a new and different invention. But whether any proposed amendment would produce this result is, in my opinion, a matter for the commissioner to determine. Under s. 46 " *If the Commissioner is satisfied* that no objection exists to the specification on the ground that the invention is already patented in the Commonwealth or in any State or is already the subject of any prior application for a patent in the Commonwealth or in any

State he shall *in the absence of any other lawful ground of objection* accept the application and specification without any condition". The commissioner's opinion as to the particular matters specified is the condition upon which the application and specification may be accepted. But it is contended that the "absence of any other lawful ground of objection" refers to an existing state of fact and, further, that this state of fact does not exist when an amendment outside the scope and contemplation of s. 45 has been allowed. But what happens when the commissioner is not satisfied of some one or more of the matters referred to in the section? He may refuse to accept the application and specification or he may accept them "on condition that a reference to such prior specifications as he thinks fit be made thereon by way of notice to the public." Either course may be taken if he is not satisfied, not only of the particular matters specified in the section but also as to the absence of "any other lawful ground of objection." From his adverse decision on such a question an appeal lies to the High Court or the Supreme Court. But he can refuse to accept an application and specification only if he is not satisfied. Accordingly he is bound to accept them if he is satisfied not only of the particular matters specified but also of the absence of any other lawful ground of objection. Surely in these circumstances it may well be said that the condition precedent to such acceptance is not that amendments which have been made are within the scope of s. 45 but that the commissioner is satisfied that they are. There is in the present case no ground for any suggestion, and no suggestion is made, that the commissioner's discretion was not exercised bona fide and this being so it is unnecessary to consider whether our own view as to the prop iety of the amendments which were made coincides with that of the commissioner.

It appears to me that the solution of this problem must also assist materially in the solution of the remaining questions which were debated on the respondent's appeal. Based on the proposition that the invention claimed in the finally amended specification for No. 133 was substantially different from that described and claimed or described and disclosed in the specification as originally lodged, the respondent alleged that the appellant was not in possession of the former invention when the specification in its original form was lodged. In its particulars of objections the respondent by par. 6 alleged quite unequivocally that the appellant "as applicant for the grant of the said letters patent was not on 31st December 1943 in possession of the invention the subject matter of the letters patent ultimately granted as at that date and that by reason thereof

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the grant thereof . . . is and at all material times has been invalid void and of no effect." The question whether this allegation, among others, constituted a good defence in law was argued as a preliminary matter of law and by the order then made it was declared that par. 6, " so far as it depends exclusively upon the aforesaid allegations of fact (i.e. allegations appearing in par. 4 of the particulars) constitutes a good defence in law to the plaintiff's claim herein to the following extent and not otherwise, viz., so far as they allege that the effect of the amendments therein referred to or either of them was that the complete specification of the letters patent No. 133163 in its final form claimed an invention substantially different from the invention described and disclosed by the complete specification originally lodged with the application dated 31st December 1943." But par. 6 did not, and did not purport, to depend in any way at all upon allegations of fact previously made in the particulars of objection, nor did the allegations previously made, so far as, apparently, they were thought to be material, go further than allege that " on or about 18th December 1946 the plaintiff lodged in the Patent Office what purported to be but was not an amended complete specification as the complete specification accompanying the said application of 31st December 1943, but the said specification so lodged on or about 18th December 1946 described and claimed then as the invention something which was not the invention described and claimed in the complete specification lodged on 31st December 1943 as aforesaid but something substantially different therefrom." I fail to see how par. 6 of the particulars of objection depended substantially on this or any similar allegation for, if the truth of this objection be assumed all that can be taken as established is that the plaintiff first described one invention and at a later stage described another. These circumstances alone cannot give rise to the inference that the plaintiff was not in possession of the second invention when he described the first. Nevertheless, the matter proceeded to trial without any amendment of the pleadings or any further definition of this or any other issue.

In these circumstances the issue between the parties assumed a completely artificial aspect and, strictly speaking, the respondent could not succeed upon it unless it appeared that the specification in its finally amended form claimed then as the invention something which was substantially different from the invention described and disclosed by the specification originally lodged. On this view of the matter the primary allegation that the appellant was not, at the time when the original specification was lodged, in possession of the invention as finally described and disclosed would become

immaterial and the only matter of importance would be, in effect, whether the invention finally described and claimed was substantially different from that originally described and disclosed. A conclusion favourable to the respondent on this point would, of course, be precisely tantamount to holding that the amendments which resulted in the specification in its final form were improperly allowed by the commissioner and this conclusion, it seems to me, is, for the reasons already given, not open to us.

What the defendant really sought to establish on the trial, however, was that the plaintiff was not, *in fact*, in possession of the patented invention at the time when he made his original application and he sought to do this, in effect, by contending that the successive specifications described two different but related inventions and that a close examination of the terms of the original specification tended to show that at the time of the plaintiff's application he did not appreciate or understand the principle of the second invention. To my mind this represents a doubtful approach to the determination of the question of fact which the defendant sought to raise and an approach which, were it not for the contrary view held by the majority of the Court, I should be prepared to hold was precluded by the allowance of the amendments in question and the acceptance of the specification in its final form. The matter, however, is by no means free from doubt and I am not prepared to dissent from the orders proposed in the plaintiff's second appeal and the defendant's appeal. The plaintiff's first appeal must of course be dismissed.

Plaintiff's Appeal from the Judgment in Action No. 314 *of* 1947.

Appeal dismissed.

Plaintiff's Appeal from the Judgment in Action No. 58 *of* 1951.

Order that if within two months of the date on which this judgment is pronounced the plaintiff appellant notifies the defendant respondent and the Principal Registrar in writing that he desires that there be a further trial of the issues raised by the fifth and sixth particulars of objection dated 19*th July* 1951, *then set aside the judgment appealed from and direct that there be a further trial of the action limited to those issues, the other issues in the action being treated as determined in favour of the plaintiff and that the costs of the*

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action be disposed of by the judge at such further trial. If the plaintiff appellant do not so notify the defendant respondent and the Principal Registrar then dismiss the appeal.

Defendant's Appeal in respect of Action No. 58 *of* 1951.

Appeal from so much of the orders or judgments of 15*th June* 1953 *and of* 22*nd June* 1953 *as in the notice of appeal are referred to allowed. Discharge such orders.*

Reserve the question of the costs of all the appeals for the further order of this Court.

Solicitors for the plaintiff-appellant-respondent, Martin, *Moule, Hamilton & Derham.*

Solicitors for the defendant-respondent-appellant, Scribal Pty. Ltd., *J. T. Brock.*

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

R. D. B.