

[PRIVY COUNCIL.]

MARTIN APPELLANT ;

AND

SCRIBAL PROPRIETARY LIMITED . . . RESPONDENT.

ON APPEAL FROM THE HIGH COURT OF AUSTRALIA.

Patents—Specification—Amendments in Patents Office—Effect to claim different invention—Whether a lawful ground of objection to grant—Acceptance by commissioner—Conclusiveness—Disconformity—Availability as ground of defence to alleged infringer—As ground of revocation of patent—Patents Act 1903-1950 (No. 21 of 1903—No. 80 of 1950), ss. 46, 86 (3).

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April 26, 30 ;
May 1, 2, 3,
7, 8 ;
June 18.
—
Viscount
Simonds,
Lords Morton
of Henryton,
Cohen, Keith
of Avonholm
and Somervell
of Harrow.

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.

Held, that the grant of a patent for an invention different from the invention described and claimed in the specification lodged with the application is not permitted and consequently there was a lawful ground of objection within the meaning of s. 46 at the time of acceptance of the application.

Held, further that it was open to the defendant in an action for infringement brought by the patentee to take the objection of disconformity notwithstanding acceptance of the specification by the commissioner.

Section 86 (3) of the *Patents Act 1903-1950* provides that every ground on which a patent might at common law be repealed by *scire facias* shall be available as a ground of revocation.

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Held, that disconformity between the specification lodged with the application for a patent and the accepted specification is such a ground.

Decision of the High Court of Australia: *Martin v. Scribal Pty. Ltd.* (1954) 92 C.L.R. 17, affirmed.

APPEAL from the High Court of Australia.

Henry George Martin appealed by special leave to the Privy Council from a decision of the High Court of Australia (*Dixon C.J., Fullagar and Taylor JJ.*) (1) affirming a decision of the Supreme Court of Victoria (*Sholl J.*).

The facts and relevant statutory provisions sufficiently appear in the judgment hereunder.

K. E. Shelley Q.C., Kenneth Johnston Q.C., Sir Garfield Barwick Q.C., and John Whitford, for the appellant.

D. I. Menzies Q.C. and Guy Aldous, for the respondent.

Their Lordships took time to consider the advice which they would tender to Her Majesty.

June 18.

LORD MORTON OF HENRYTON delivered the judgment of their Lordships as follows:—

The appellant is the grantee and registered owner of Australian Letters Patent No. 133163 in respect of “Improvements in writing instruments”. By his statement of claim in the present action he alleged that his patent had been infringed by the manufacture and sale by the respondents of a pen known as the Scribal Secretary Pen, and claimed the usual relief against them in respect of such infringement. It will be convenient hereafter to refer to the appellant as “the plaintiff” and to the respondents as “the defendants”. By their defence the defendants denied infringement and alleged that the patent in suit was invalid for a number of reasons. *Sholl J.* held that the patent was invalid for ambiguity and was not infringed and dismissed the action. The High Court held that the patent was infringed and was not ambiguous, but dismissed the action on the ground that the plaintiff at the time of his application “was not in possession of the invention described and claimed in the specification No. 133163”. The defendants do not now deny that this patent was infringed by them. They still seek to support the decision of *Sholl J.* that the patent is invalid for ambiguity, but they place in the forefront of their argument a contention

which can only be appreciated after the facts have been briefly set out.

The application which led to the grant of the patent in suit was made by the plaintiff on 31st December 1943. In his application the plaintiff declared that he was the assignee of Laszlo Jozsef Biro the actual inventor of an invention entitled "Improvements in writing instruments".

The relevant statute for the purpose of the present action is the *Patents Act* 1903-1950 of the Commonwealth of Australia (hereafter referred to as "the Act"). Section 33 (1) of the Act provides that an application for a patent shall be for one invention only . . . and must be accompanied by a provisional specification or a complete specification. The plaintiff elected to lodge a complete specification and their Lordships will hereafter refer to that specification as "the original specification".

The complete specification of United Kingdom Letters Patent No. 573747 dated 21st February 1944, became available for public inspection at the Patents Office Library, Canberra, on 29th May 1946. This patent was granted to the plaintiff. It is the second of the two patents which *Harman J.* held to be valid in *Martin v. Selsdon Fountain Pen Co. Ltd.* (1).

On or about 18th December 1946, the plaintiff lodged in the Patents Office a document which purported to be an amended complete specification. This specification differed to a remarkable degree from the original specification, both in the description of the invention and in the claims, though the drawings accompanying each specification were the same. The amended specification described and claimed the invention described and claimed in the United Kingdom Patent No. 573747, and was identical with the latter document.

The defendants contend that as a result of the amendments so made, together with subsequent amendments accepted by the Commissioner of Patents, the plaintiff obtained the patent in suit for an invention which was not the invention described and claimed in the original specification. In other words, to use a well-known phrase, that there was disconformity between the original specification and the specification on which a patent was granted.

On 19th February 1948, the original specification was notified as open to public inspection under and pursuant to s. 38A (1) of the Act. This section was inserted in the Act in 1946 and it is to be noted that by sub-s. (2) "when a complete specification has become

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open to public inspection in pursuance of the last preceding subsection it shall be deemed to have been published ”.

This sub-section should be read in conjunction with s. 54 which provides : “ After the publication of a complete specification and until the date of sealing a patent in respect thereof or the expiration of the time for sealing the applicant shall have 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 : Provided that an applicant shall not be entitled to institute any proceedings for an infringement unless and until a patent for the invention has been granted to him.” The provisions are of some importance in the present case, and their Lordships will later return to them.

On 14th June 1949, the commissioner accepted the application and the complete specification as amended. The acceptance was advertised on 30th June 1949, and the patent in suit was sealed, and was dated as of the date of the application, 31st December 1943, in accordance with s. 69 of the Act.

Before considering whether there is disconformity between the original specification and the accepted specification, and if so, whether such disconformity affords a defence to the action, their Lordships must consider an argument put forward on behalf of the plaintiff ; namely that the decision of the Commissioner of Patents to accept the specification as amended (which was not the subject of an appeal under s. 47 of the Act) has become final and conclusive, and it was not open to the defendants to challenge the validity of the patent on the ground just mentioned. In support of this argument counsel for the plaintiff relied upon ss. 39 to 46 inclusive, which deal with examinations of the specification in the Patents Office and amendments made as a result of reports thereon, and in particular upon s. 46 which is as follows :—“ 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) accept the application and specification on condition that a reference to such prior specifications as he thinks fit be made thereon by way of notice to the public ; or (b) refuse to accept the application and specification.”

Counsel for the plaintiff contended that the commissioner is given an absolute discretion to allow or refuse any amendments of the specification, and if he is “ satisfied ” of the matters mentioned in

s. 46 his decision to accept an amended specification cannot be questioned. In their Lordships' opinion this contention fails to give due weight to the words "in the absence of any other lawful ground of objection." These words are not governed by the preceding words "if the Commissioner is satisfied", and if a lawful ground of objection in fact exists the commissioner has wrongly accepted the specification. It cannot be doubted that it would be open to any alleged infringer thereafter to allege that the patent was invalid on the ground, for example, of ambiguity, and if disconformity between the original and accepted specification is a lawful objection, it is, in their Lordships' view, equally open to the defendants in the present action to allege that such disconformity exists.

Next counsel for the plaintiff sought to rely on s. 65 which provides that "it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that . . . the complete specification is not in conformity with the provisional." They concede, as indeed they must, that this provision does not apply in terms to the present case, but they contend that the whole scheme of the Act is designed to preclude any objection on the ground of disconformity of any kind once the application and specification has been accepted. Their Lordships have carefully considered the Act as a whole, and they can find no good reason for writing into s. 65 words which are not there.

For these reasons their Lordships hold, in agreement with *Sholl J.*, that it is open to the defendants to take the objection now under discussion. It should be added that the amendments made in the present case were under Pt. IV, Div. 1 of the Act and it is common ground that the provisions of Pt. IV, Div. 4 do not apply to these amendments. Thus the plaintiff cannot rely upon s. 79.

It must next be considered whether there is in fact disconformity between the original and the accepted specification. For this purpose it is necessary to ascertain what is the invention described and claimed in the original specification, and then to consider whether the same or a different invention is described and claimed in the accepted specification. Their Lordships use the word "invention" with the meaning assigned to it by the definition in s. 4 of the Act "Invention means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies . . . and includes an alleged invention."

In the course of the hearing each of the specifications was considered carefully and in detail as a whole, having regard to the description of the invention as well as to the claims, but their Lordships

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find it unnecessary to embark upon a detailed comparison of the specifications in this judgment, since they accept the careful analysis which is to be found in the judgments of the High Court, and they adopt the conclusion of *Fullagar J.*, which he expressed as follows :—“ 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 the 18th December 1946 (three years after the original application) was that a new application for protection for a different invention was being made ” (1). The facts of the present case afford a striking confirmation of this conclusion. It was held by the High Court, and it is not now disputed by the defendants, that their Scribal Secretary Pen infringes the patent ; but it is clear, in their Lordships’ view, that if a patent had been granted for the invention described and claimed in the original specification the same pen would not have been an infringement thereof.

The adoption of the conclusion already stated is, in their Lordships’ view, fatal to the validity of the patents in suit. For reasons which will now be stated they are of opinion that the grant of a patent for an invention, different from the invention described and claimed in the complete specification lodged with the application for a patent, is not permitted by the terms of the Act. Further, s. 86 (3) of the Act provides that every ground on which a patent might at common law be repealed by *scire facias* shall be available as a ground of revocation, and in their Lordships’ view disconformity of this kind between the original and the accepted specification is such a ground.

In considering the terms of the Act it must be borne in mind that the plaintiff has no right to a monopoly for his alleged invention unless the grant of a patent is justified by the terms of the statute on which he relies. Part IV, Div. I of the Act deals with “ Applications ” and their Lordships have already referred to the provisions in s. 33 that “ an application for a patent shall be for one invention only.” Sections 35 and 36 are as follows :—

“ 35. A provisional specification must fairly describe the nature of the invention.”

“ 36. A complete specification must fully describe and ascertain the invention and the manner in which it is to be performed, and must end with a distinct statement of the invention claimed.”

In these sections, and in the sections which follow them, the words "the invention" clearly refer to the "one invention" for which protection was sought by the application. For instance, s. 41 provides that "In the case of all complete specifications the examiner shall also—(a) ascertain and report whether to the best of his knowledge 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; (b) report whether to the best of his knowledge the invention is or is not novel."

Section 46 (already quoted) refers again to "the invention" and so too does s. 53: "After an application for a patent has been lodged the invention may be used and published without prejudice to the validity of any patent granted on the application." Section 54 has already been quoted. Finally s. 62 provides that "the effect of a patent shall be to grant to the patentee full power . . . during the term of the patent to make, use, exercise, and vend the invention within the Commonwealth in such manner as to him seems meet."

Nowhere in the Act is any power conferred for the grant of a patent for any invention other than the invention described and claimed in the original complete specification.

For these reasons their Lordships are of opinion that, apart altogether from the ground of revocation mentioned in s. 86 (3) there was, at the time when the commissioner accepted the application and the amended specification, a lawful ground of objection within s. 46 of the Act. The opposite conclusion would indeed lead to strange results, which are well exemplified in the present case, having regard to their Lordships' view already expressed, that the defendants' pen infringes the patent, but would not have infringed a patent granted on the original specification. Between the date of the plaintiff's application for a patent (31st December 1943) and 19th February 1948, when the original complete specification was notified as open for public inspection, the defendants were manufacturing and selling in Australia pens which were not an infringement of the claims of the original specification. An inspection of this specification would show the defendants that they were free to go on manufacturing and selling pens of the same type, and in fact they did so manufacture and sell. Then in 1949 the plaintiff was granted the patent in suit, dated back to 31st December 1943. He now alleges in his statement of claim that the defendants manufactured and sold such pens between 19th February 1948, and 24th January 1951, and that his patent was thereby infringed; and if his patent were valid he would undoubtedly be entitled to damages

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in respect of these acts as a result of ss. 38A (2) and 54 of the Act, already quoted.

Their Lordships are further of opinion that s. 86 (3) of the Act applies to the present case. No direct authority on the point was cited at the hearing, but in *Nuttall v. Hargreaves* (1) the Court of Appeal had to consider the effect of disconformity between the provisional and the complete specifications under the United Kingdom Act of 1883, and *Lindley* L.J. expressed himself as follows: "It is not necessary, as we know, in a provisional specification to describe how the invention is to be carried out, but it is necessary to comply with s. 5, sub-s. 3, of the Act of 1883, which says that 'A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required.' One point which we have to consider I will deal with at once, namely, what is the consequence now, under this Act of 1883, of not describing in the provisional specification the true nature of the invention, and what is the consequence of describing it for the first time in the complete specification? In order to answer that question we must look at further sections of the Act, and the important one, passing by s. 14 is s. 26, sub-s. 3. Section 26 relates to revocation, and it says '(1) the proceeding by *scire facias* to repeal a patent is hereby abolished; (2) revocation of a patent may be obtained on petition to the Court; (3) every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.' To give effect to that section, it is necessary to consider what was, before the Act, the effect of a patentee not stating in his provisional specification the real nature of his invention, so as to identify it with the invention which he described in his complete specification. The answer to that has been settled by authority, and the last case of any importance was *Bailey v. Roberton* (2), in the House of Lords. If the invention described in the two specifications is not the same the patent is bad. The patentee need not, as I have already pointed out, go into details in the provisional specification; it is sufficient to describe the nature of the invention, but the nature of the invention there described must be the nature of the same invention as that to which the complete specification relates. In the face, therefore, of that 26th section, it appears to me that if those two specifications properly construed are not for the same invention, the patent cannot be upheld, and that is the view taken by Lord *Halsbury* in the case of

(1) (1892) 1 Ch. 23.

(2) (1878) 3 App. Cas. 1055.

Vickers v. Siddell (1). The passage I will read is at p. 499. His Lordship says, 'It is suggested that the new machinery of the comptroller and the examiner has superseded the power of raising any objection to the conformity of the provisional and the complete specification. I am unable myself to take that view. I think it is an essential condition of a good patent that the invention described in the provisional should be the same as that in the complete specification, and I think the 3rd sub-section of s. 26 preserves this as a ground upon which an action for the infringement of a patent right may be defended, and a ground upon which a patent may be revoked'. That appears to me, I confess, to be the view which is most in accordance with the sections of the Act to which I have referred. It is a view in no way dissented from by the other learned Lords, although they abstain from expressing a positive opinion upon it. It is also quite consistent with the view taken by this Court in the same case when it was before the Court, because every member of the Court left that particular point of law open for further discussion'' (2).

In their Lordships' opinion disconformity of the kind which is established in the present case is an even stronger ground for invalidating a patent than the ground which the Court of Appeal had to consider in *Nuttall v. Hargreaves* (3).

It follows that their Lordships agree with the conclusion of *Sholl J.* and the High Court that the patent in suit is invalid and that judgment should be entered for the defendants. It thus becomes unnecessary to consider whether the patent in suit is invalid for ambiguity, but their Lordships see no reason to disagree with the view of the High Court that this defence was not made out. They feel bound, however, to observe that they cannot agree with the view expressed by the High Court that the plaintiff made a false statement in his application. The application was in the following terms, so far as material for the present purpose:—

"I, Henry George Martin, hereby apply that a patent may be granted to me for an invention entitled 'Improvements in writing instruments' and I do hereby declare that I am the assignee of Laszlo Jozsef Biro . . . actual inventor of the invention . . . and I further declare that I am in possession of the said invention."

The High Court thought that the words last quoted amounted to a representation that the plaintiff was, at the date of his application, in possession of the invention for which a patent was ultimately granted. To quote the words of *Dixon C.J.*:—" . . . however

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(1) (1890) 15 App. Cas. 496.

(2) (1892) 1 Ch., at pp. 28, 29.

(3) (1892) 1 Ch. 23.

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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 " (1).

Their Lordships cannot ascribe this effect to the representation made by the applicant. In their view the declaration already quoted applied only to the invention described in the complete specification lodged with the application, and cannot be construed as a statement that the plaintiff was then in possession of the different invention for which the patent in suit was ultimately granted.

For the reasons already stated their Lordships will humbly advise Her Majesty that this appeal should be dismissed with costs.

Appeal dismissed with costs.

Solicitors for the appellant, *Payne, Hicks Beach & Co.*

Solicitors for the respondent, *Hamilton-Hill & Partners.*

R. D. B.

(1) (1954) 92 C.L.R. 17, at p. 68.