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HIGH COURT

[1957.

[HIGH COURT OF AUSTRALIA.]

H.P.M. INDUSTRIES PROPRIETARY LIMITED PLAINTIFF;

AND

GERARD INDUSTRIES LIMITED . . . DEFENDANT.

H. C. OF A. *Patent—Suit for infringement—Counterclaim for revocation—Validity—Inventive-
1957. ness—Novelty—Subject matter—Obviousness—Public general knowledge—
 Common general knowledge—Mosaic of prior publications—Patents Act 1952-*
Sydney, 1954, ss. 100-105, 113.

SYDNEY,
June 11, 12 ;
July 5.
—
Williams J.

H. sued G. for infringement of its letters patent—priority date 10th October 1952—for improvements for or relating to switch cover plates. G. denied the infringement, pleaded that the invention, so far as claimed in any claim, was not novel and was obvious and did not involve any inventive step having regard to what was known or used in Australia on or before 10th October 1952, and counterclaimed for revocation of the letters patent. H. first commenced to market switch cover plates manufactured in accordance with its claims in February 1953 and they were an immediate commercial success. G. soon followed suit, and contended that a certain small feature therein was sufficient distinction to save G.'s articles from being an infringement of H.'s patent. G. relied on the information revealed by the prior user of a number of switch cover plates mostly manufactured and sold by itself, and contended that the sales were so extensive that that information had become not merely part of public general knowledge but also part of common general knowledge prior to 10th October 1952.

Held that G.'s cover plate infringed both claims of H.'s specification but in the light of the information tendered in evidence, and which, for many years, was available to any craftsman coming fresh to the problem, whether it had become part of common general knowledge prior to 10th October 1952 or not the invention claimed by H. was obvious and did not involve any inventive step within the meaning of par. (e) of s. 100 of the *Patents Act* 1952-1954, therefore H.'s suit failed and must be dismissed and G.'s counterclaim succeeded and the letters patent must be revoked.

However precise the definition of an integer in a combination claim may be, it is still possible for the claim to be infringed where some mere mechanical equivalent is substituted for the mechanism described in that integer.

Paragraph (e) of s. 100 of the *Patents Act* 1952-1954 appears to have widened the law relating to want of subject matter. It requires the Court to have regard to what is known or used in Australia before the priority date of the claim, and the words "known or used" appear to embrace more than what had become commonly known or used or in other words more than the common general knowledge of a skilled craftsman in the particular art on that date.

In deciding what was obvious, it is necessary to consider what would have been obvious to the hypothetical skilled craftsman in the state of knowledge in the particular art existing at the priority date of the patent and that this knowledge consists of everything disclosed by literature on the subject (including prior specifications), and revealed by the articles then in use and of the common general knowledge.

Allmanna Svenska Elektriska A/B v. Burntisland Shipbuilding Co. Ltd. (1952) 69 R.P.C. 63, at pp. 68-70 and *Martin & Biro Swan Ltd. v. H. Millwood Ltd.* (1956) R.P.C. 125, at pp. 133, 134, referred to.

A person seeking to invalidate a patent for want of novelty is, in law, prevented from making a mosaic of the information contained in a number of prior paper publications or revealed by the use of a number of articles or from a combination of these sources, where that information has not become part of common general knowledge.

ACTION.

An action for the infringement of a patent was brought in the original jurisdiction of the High Court of Australia, pursuant to s. 113 of the *Patents Act* 1952-1954, by H.P.M. Industries Pty. Ltd. against Gerard Industries Ltd., a company incorporated in South Australia.

The statement of claim, as amended, was substantially as follows:

(2) The plaintiff was the registered legal owner and proprietor under the provisions of the *Patents Acts* in force in the Commonwealth of letters patent for an electric switch cover plate dated 10th October 1952 and numbered 161893 for the exclusive enjoyment profit and advantage within the Commonwealth, during the period of sixteen years from that date, of the invention mentioned therein and described in the specification.

(3) Omitting formal parts the specification was as follows: (a) A switch cover plate formed by moulding thermo-setting plastic material in which the width of the plate is substantially less than its length and having apertures in the plate spaced one above the other through which the tumblers of switches attached to the rear of the plate may project a hole near each end of the plate whereby the plate may be screwed to a wall, architrave or other surface a plurality of bosses moulded integrally with the plate, one immediately below and one immediately above each of the apertures there being a

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blind internally threaded hole in each boss whereby switches may be screwed to the rear of the plate by means of screws not visible from the front thereof; and (b) a switch cover plate substantially as shown in and as described with reference to certain accompanying drawings. (6) and (7) The plaintiff stated that the infringing by the defendant of the letters patent and the intention to continue to so infringe had caused and would continue to cause the plaintiff great loss and damage. (8) Particulars of the breaches complained of were furnished in pursuance of the Rules of Court and were substantially as follows:—

1. Prior to the issue of the writ and subsequent to the publication of the complete specification of the letters patent the defendant had infringed those letters patent by the manufacture, use, sale, offer for sale, and/or supply in the Commonwealth of electric switch cover plates constructed in accordance with the invention described in the complete specification and claimed in claims (a) and (b): 2. In particular the plaintiff complained of: (a) the manufacture by the defendant at its factory in South Australia between January 1955 and the date of the issue of the writ herein of electric switch cover plates constructed as aforesaid; (b) the offer for sale by the defendant of a trade magazine entitled “Electrical and Radio World” dated 20th July 1955 and in a trade magazine entitled “Electrical Welding” dated 3rd June 1955 of electrical switch cover plates so constructed; (c) the sale and/or supply to four named firms carrying on business in Sydney and other firms carrying on business in Australia between the said dates of electric switch cover plates so constructed; and (d) the supply to a Sydney firm and other distributors on behalf of the defendant between the said dates of similar plates so constructed. 3. The plaintiff said the precise number and dates of the defendant’s infringements were unknown to it but it would claim to recover damages or an account of profits in respect of all such infringements.

The plaintiff claimed: (a) an injunction to restrain the defendant from infringing the said letters patent by itself, its servants or agents; (b) an inquiry as to the damages sustained by the plaintiff, or (c) alternatively, an account of the profits derived by the defendant by reason of such infringements, and an order for the payment by the defendant to the plaintiff of any sum found to be due on such inquiry or on taking such account; and (d) an order for the delivery up or destruction upon oath of all articles in the possession, power, or control of the defendant made in infringement of the said letters patent.

In its defence and counterclaim the defendant (1) admitted the facts alleged in pars (1) to (5) both inclusive of the statement of claim; (2) denied (i) the infringements or intention to infringe as alleged and (ii) that any loss or damage had been or would be caused to the plaintiff as alleged in par. 7; (3) said that the letters patent were and had at all times material been invalid for the reasons appearing in the defendant's particulars of objection; and (4) said that the alleged infringement was not novel at the date of the letters patent.

The defendant repeated par. (3) of its defence and counterclaimed for revocation of the plaintiff's letters patent.

The plaintiff joined issue with the defendant upon the defence and as to the counterclaim denied the invalidity of the letters patent.

The defendant gave notice that at the trial of the action it would rely on certain objections to the validity of the letters patent, *inter alia*, that the complete specification did not comply with the requirements of s. 40 of the *Patents Act*; that the plaintiff did not sufficiently distinguish and point out in the specification which of the matters and things therein mentioned it claimed to have invented and which it did not claim to have invented or admitted to be old; that the invention so far as claimed in any claim was not an invention within the meaning of the *Patents Act*; and that the invention so far as claimed in any claim was not novel in Australia on 10th October 1952.

During the taking of evidence the following exhibits were tendered on behalf of the defendant:—

Exhibit 1: A switch cover designed by an architect, who had practised as such in Adelaide since the year 1910, and who had used it in his own house which was erected to his own design and under his supervision in 1935, and who gave evidence to that effect. The cover was made of metal, measured 2" by 6½" and was designed to be screwed to an architrave. In each corner there was a hole to screw to the architrave itself, there being four screws for the architrave, and two larger holes for the tumblers of switches to come through. The cover plate was designed to have switches attached to it by a screw. There were holes above and below each of the tumbler holes. When the plate and the two switches were assembled there would be a plate with two switches attached to it, a hole in the architrave to accommodate the switches, and one would merely screw the switch cover on to the architrave.

Exhibit 2. Switch cover plates of brass or other material having apertures in the place spaced one above the other through which

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the tumblers of switches attached to the rear of the plate by a threaded boss screwing into the plate projected with holes whereby the cover plates and switches could be screwed to the wall architrave or other surface, were manufactured and sold by Gerard and Goodman Ltd., with switches attached, to divers persons in or about the years 1928 to 1935. Specific instances of use were shown as at (i) Walkerville for twenty years or more, and (ii) Kent Town about 1920.

Exhibits 3 and 4. Switch cover plates formed by moulding thermo-setting plastic material in which the width of the plate is less than its length and having one aperture in the plate through which the tumbler of a switch (attached to the rear of the plate by screwing the switch into a recess cast on the plate) projected with holes whereby the cover plate and switch could be screwed to the wall architrave or other surface were manufactured and sold in large numbers by the defendant (then named Gerard Electric Mfrs. Ltd.) during the years 1939 to 1941. The switch cover plates described in this paragraph were illustrated and described in the defendant's catalogues Nos. 310, 315 and 416 which were widely distributed in Australia during the last-mentioned years.

Exhibits 5 and 6. Switch cover plates formed by moulding thermosetting plastic material in which the width of the plate is less than its length and having one aperture in the plate through which the tumbler of a switch attached to the rear of the plate may project a hole near each end of the plate whereby the plate may be screwed to a wall architrave or other surface two bosses moulded integrally with the plate one immediately above and one below the aperture there being a blind internally threaded hole in each boss whereby a switch may be screwed to the rear of the plate by means of screws not visible from the front thereof, were manufactured and sold in Australia by the defendant (then named Gerard Electric Mfrs. Ltd.) in large numbers during the years 1939 to 1941 inclusive. The switch cover plates described in this paragraph were illustrated and described in the defendant's catalogues Nos. 330, 331, 335 and 431 which were widely distributed in Australia during those years.

Exhibit 7. Switch cover plates substantially as described in exh. (5) and exh. (6) but much narrower and smaller so as to accommodate a small micro switch suitable only for alternating current were manufactured and sold in Australia in large numbers by the plaintiff and the defendant and by a specified company in Victoria in the years 1953 and 1954.

Exhibit 8. Switch cover plates substantially as described in exh. (5) and exh. (6) but being narrower so as to be mounted in a narrow architrave were manufactured and sold in Australia in large numbers by the defendant in the years 1951 and 1952 and were illustrated and described in the defendant's catalogue No. 333 which was widely distributed in Australia in the year 1952; and

Exhibit 9. Switch cover plates substantially as described in exh. (5) and exh. (6) were made and sold in Australia by the plaintiff in and about the year 1938.

A witness stated that the switch covers being exh. (1) and exh. (2) respectively had been taken by him from the buildings respectively mentioned, and that exh.'s (3) to (8) inclusive were produced and sold by the defendant prior to the year 1952.

An expert witness, with several qualifications, called by the plaintiff, said that the points of difference and similarity between (a) exh. (1) and the plaintiff's samples J and K were that it resembled J and K in respect of exh. (1) in that there were two or more switches mounted vertically above each other; it was similar in that the complete unit held to the wall by screws passing through the cover; it was dissimilar because there were four screws holding that cover to the wall and not two; it was different because the switch mechanisms were supported by screws passing through the front of the cover and not tapped into bosses on the back of the cover, and that the screws engage in blind holes in bosses—the distinction being that certain of the samples do attach to the rear of the cover but are held there by screw threads formed in the switch mechanism itself and not by individual screws; the ratio of length to width was similar to the plaintiff's sample; and exh. (1) is different from the plaintiff's sample because it is made of metal and not of thermo-setting plastic material.

(b) Exhibit 2 and the plaintiff's sample were that they were substantially similar except that one had a switch screwed to it, and one being bevelled and the other one not; that the defendant's sample was similar to the plaintiff's in that two or more switches were mounted vertically above each other although they could be mounted side by side; they were similar in that the unit was held to the wall by screws passing through the cover; it was different from the plaintiff's sample in that there were four screws to each cover plate and not two and, the same as the plaintiff's sample, from the back of the cover; exh. (2) is also different from the plaintiff's sample, (i) the screw portion of the body of the switch mechanism being used to fasten the switch and not the individual screws; (ii) the ratio of width to length is less than one is to three;

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and (iii) the cover plates are made of metal and not of thermo-setting plastic material.

(c) Exhibit 3 and the plaintiff's samples; it differs from those samples there being only one switch and not a gang of two or three; it is similar in that it could be held to the wall by screws passing through the cover, the number of switches is the same and the switch mechanism is supported from the back of the cover; it is different because the switch mechanism is attached to the cover plate by means of a screw thread which is part and parcel of the screw mechanism and the attachment is not by separate screws; the ratio of length to width is less than three to one; and it is similar being made of thermo-setting material. It would not teach a person skilled in the art much or anything.

(d) Exhibit 4. It is different from the plaintiff's sample in that (i) there is only one switch unit and not two or more, and (ii) there are four holding screws and only two; it is similar in that (i) the unit is held to the wall by screws passing through the covers; (ii) the switch mechanism is supported from the back of the cover; (iii) because that mechanism is attached to the back of the cover by screws which engage in blind holes and bosses, and (iv) it is apparently made of thermo-setting plastic material; and it is different, further, because the length of the cover plate is not three times its width. A craftsman would not learn much or anything from it.

(e) Exhibit 5. This exhibit is different in that (i) it is only a single switch and not a gang of several mounted vertically above each other, (ii) the attachment of the switch to the back of the cover is not by screws but by, apparently, cut-down studs which pass through holes in the mechanism to the cover plate, and (iii) the length of the cover plate is much less than three times its width; it is similar in that (i) the unit is held to the wall by screws passing through the cover, (ii) there are two screws, (iii) the switch mechanism is supported from the back of the cover, and (iv) it is made, apparently, of thermo-setting plastic material. It would not teach anything to a person skilled in the art.

(f) Exhibit 6. This exhibit is different in that it is a single plate and not one to accommodate a number of switches and the length is only one and one-half times its width; it is similar in that (i) the unit is held to the wall by screws passing through the cover, (ii) the number of screws is two, (iii) the switch mechanism is supported from the back of the cover, (iv) the screws do engage in blind holes in bosses, and (v) it is made of thermo-setting plastic material. A person skilled in the art would not be taught anything.

(g) Exhibit 7. This exhibit is different in that it is only a single unit as opposed to two or three and the length is barely twice the width; it is similar in that (i) the unit is held to the wall by screws passing through the cover, (ii) the number of screws is two, (iii) the switch mechanism is supported from the back of the cover, (iv) the screws engage in blind holes and bosses, and (v) it appears to be made of thermo-setting plastic material. It would not teach anything to a person skilled in the art.

(h) Exhibit 8. This exhibit is different from the plaintiff's sample because it is only a single switch unit and not a gang of two or three, and the length of the cover is scarcely twice the width; it is similar in that (i) the unit is held to the wall by screws passing through the cover, (ii) the number of screws is two, (iii) the switch is supported from the back of the cover, (iv) the attachment to the switch is by screws engaged in blind holes in bosses on the back of the cover, and (v) the cover plate appears to be made of thermo-setting plastic material. A craftsman would not be taught anything.

Further facts and relevant statutory provisions appear in the judgment hereunder.

N. H. Bowen Q.C. (with him *R. J. Ellicott*), for the plaintiff. Where one is looking at prior user in order to upset a patent the thing which is relied on as having been used must be the article itself or such as would constitute an infringement of the claim or claims in the specification. On this issue the quantity used would appear to be a very material factor, the question being whether these articles became a question of common knowledge. The general rule as stated in *Blanco White on Patents for Inventions*, 2nd ed. (1955), pp. 84, 85, is that "the test for lack of novelty is essentially the same as the test for infringement; that is to say, a prior use will invalidate a claim."

[WILLIAMS J. referred to *Terrell and Shelley on Patents*, 9th ed. (1951), pp. 108, 110, 112.]

Prior user should go to the extent mentioned.

[WILLIAMS J. referred to *Harwood v. Great Northern Railway Co.* (1).]

None of the exhibits tendered has all the features of common general knowledge. On the question whether they would teach someone how to make the plaintiff's claim no one of them taken separately would do so. On the matter of prior user, the question ought to be whether a particular article would contain sufficient features to constitute an infringement if it were made. The test

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in the alternative is: Does the prior user coming into the field of public knowledge teach sufficiently the skilled person how to do what the patent does? On either basis the individual instances here tendered do not amount to prior user, that is not prior in the sense of destroying the novelty of the letters patent. It is not permissible to make a mosaic of prior publications. On the issue of prior user the extent of that user does not appear to be material if they were used at all. [He dealt in detail with exhibits (1) and (9).]

As to the question of common general knowledge: see *Blanco White on Patents for Inventions*, 2nd ed. (1955), pp. 106, 107. When one comes to see whether there was an inventive step or whether it was obvious, in the light of what was common knowledge at the time, the first point must be to determine whose common knowledge is taken. One should find a workman skilled in the art. If, however, contrary to that submission, the art in this field ought to be taken to be what is known to the executives of the manufacturing companies then even there the common knowledge would not embrace exhs. (3) to (8) inclusive, or possibly including exh. (9). On the question of the approach in regard to obviousness, see *Non-Drip Measure Co. Ltd. v. Stranger's Ltd.* (1). In the case now before the Court the evidence shows that there had been, for years, a need for a switch cover such as this one, yet it was not produced until the plaintiff produced it. The matter is one of fact for the Court. In what does the invention consist was dealt with in *Halsbury's Laws of England*, 2nd ed. vol. 24, p. 590, par. 1122. The definition of the problem is to find a means of overcoming by a single means all the various difficulties. If it were the test in *Halsbury's Laws of England*, 2nd ed. vol. 24, p. 590, one has to find the principle used which, it is submitted, was the use of vertical multiple switch cover plates. The means was a cover plate which embodied all the features which are set out in the first claim.

[WILLIAMS J. referred to *Pugh v. Riley Cycle Co. Ltd.* (2).]

There is not any evidence that exh. (1) solved any particular problem at all, except, possibly, that of appearance. When one gives value to the different aspects of the thing as it presented itself in 1952, although there may have been old integers adopted there could be a subject matter for a patent unless it was so obvious that anyone skilled in the art would have been able to make it. As to there being an inventive step there was that necessary degree of advancement, of invention in it, which is necessary. When it was produced it was at once commercially successful and it is new and useful.

D. I. Menzies Q.C. (with him *K. A. Aickin*), for the defendant. The two or three pairs of bosses is an essential part of the invention and where an article is manufactured without the two or three pairs of bosses, as the case may be, then that article is not an infringement. The patent is invalid for lack of subject matter and for lack of novelty. There is a distinction between the defence of lack of subject matter and that of lack of novelty. Novelty itself is not enough unless it is accompanied by an inventive step. The substantial question for the Court on this branch of the case is whether or not there is subject matter in the patent. It was common general knowledge at the relevant date, 10th October 1952, that there could be a switch cover plate that would take two or more switches attached to it vertically. It is immaterial whether the switch cover plate be horizontal or vertical. In view of the evidence of the manufacture and use of cover plates in a vertical position with switches attached to them, it is idle to say that it is not part of the common general knowledge of the particular trade. In October 1952 cover plates could be made from thermo-setting material, and at that date it was also common general knowledge that switches could be mounted on the rear of cover plates by means of bosses with blind threads, instances going back to about 1934. The next element of common general knowledge that existed was that a switch cover plate could be three times as long as its width, an instance thereof being provided by *exh. 1*. There is nothing in the dimensions here that has anything to do with any invention. This invention is not confined to architraves. Another element of common general knowledge is that a cover plate can be attached to an architrave or to a wall by screw, one at either end of the cover plate. The only question that really faces the Court having regard to all these elements of common general knowledge is: Is there any invention in putting them together? It is submitted that there is not. Merely to double something is not to make an invention. If there is anything new here at all the only new thing is in bringing together a number of well-known features. The bringing together of all these features does not constitute novelty for the purposes of patent law, and it certainly does not constitute invention. This is not a combination patent, it is merely an aggregation of matters of common knowledge. In law there is a difference between such an aggregation and a combination which is entitled to the protection of letters patent (*Palmer v. Dunlop Perdriau Rubber Co. Ltd.* (1)). This is not a claim for a combination, it is a claim for an aggregation. The matter was

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(1) (1937) 59 C.L.R. 30, at pp. 67, 74.

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considered in *Moore and Hesketh v. Phillips* (1) and *Broken Hill South Silver Mining Co. No Liability v. N. Guthridge Ltd.* (2). Combinations of existing inventions to govern the operation of points was dealt with in *Saxby v. Gloucester Waggon Co.* (3). This action should fail because (i) there is no infringement, and (ii) the patent itself is invalid and should be revoked.

N. H. Bowen Q.C., in reply, referred to *Palmer v. Dunlop Per-driau Rubber Co. Ltd.* (4) and *British United Shoe Machinery Co. Ltd. v. A. Fussell & Sons Ltd.* (5).

Cur. adv. vult.

July 5.

WILLIAMS J. delivered the following written judgment:—

The plaintiff, a manufacturer of electrical appliances and accessories, is suing the defendant, a business competitor, for infringement of its Letters Patent (No. 161,893, priority date 10th October 1952) for improvements for or relating to switch cover plates. The defendant has denied infringement. It has pleaded that the invention so far as claimed in any claim was not novel and was obvious and did not involve any inventive step having regard to what was known or used in Australia on or before 10th October 1952. It has counter-claimed for revocation of the letters patent. The specification of the invention is short and concise and contains only two claims. It states that: "The present invention relates to switch cover plates such as are used to cover the switches commonly used in domestic lighting circuits where such switches are mounted below the surface of a wall or architrave. The object of the present invention is to provide a cover plate which is of particular value where it is desired to mount a plurality of switches close together one above the other on an architrave, in such a manner that the work involved is reduced to a minimum and a neat appearance is produced. The invention consists of a switch cover plate formed by moulding thermo-setting plastic material in which the width of the plate is substantially less than its length and having apertures in the plate spaced one above the other through which the tumblers of switches attached to the rear of the plate may project, a hole near each end of the plate whereby the plate may be screwed to a wall, architrave or other surface, a plurality of bosses moulded integrally with the plate, one immediately below one immediately above each of the apertures there being a blind, internally threaded

(1) (1907) 4 C.L.R. 1411, at p. 1426.
(2) (1908) 8 C.L.R. 187, at p. 210.
(3) (1881) 7 Q.B.D. 305, at p. 312.

(4) (1937) 59 C.L.R., at pp. 73, 75.
(5) (1908) 25 R.P.C. 631, at pp. 657, 658.

hole in each boss whereby switches may be screwed to the rear of the plate by means of screws not visible from the front thereof. By the expression 'the width of the plate is substantially less than its length' it is meant that the length is at least three times as great as the width." After describing and illustrating a preferred embodiment of the invention it states that: "With the plate according to the invention it is possible to mount the two switches in a very short time as it is necessary to make only one hole. The necessity for lining the switches up one above the other, which is the case when separate switches are used, as is usual is avoided, as the lining up is performed automatically by the plate. Time is also saved owing to the fact that there is only one plate to be fixed. The appearance of the architrave is also improved by the use of the single plate for the two switches. Switch cover plates according to the invention may be made to accommodate three or more switches if desired and may be made in any suitable material." There are two claims, the text of which is as follows: "1. A switch cover plate formed by moulding thermo-setting plastic material in which the width of the plate is substantially less than its length and having apertures in the plate spaced one above the other through which the tumblers of switches attached to the rear of the plate may project, a hole near each end of the plate whereby the plate may be screwed to a wall, architrave or other surface, a plurality of bosses moulded integrally with the plate, one immediately below and one immediately above each of the apertures there being a blind, internally threaded hole in each boss whereby switches may be screwed to the rear of the plate by means of screws not visible from the front thereof. 2. A switch cover plate substantially as shown in and as described with reference to the accompanying drawings."

The plaintiff first commenced to market switch cover plates manufactured in accordance with these claims in February 1953. The articles took the form of cover plates at first for two and later for three switches mounted one above the other. The plates were an immediate commercial success. The defendant soon followed suit. About 1955 it commenced to market switch cover plates of a very similar manufacture to those of the plaintiff to cover two and three switches mounted one above the other. The only distinction is that the bosses containing the blind internally threaded holes described in the plaintiff's specifications are separate bosses one immediately below and one immediately above each aperture, whereas the bosses between the apertures in the defendant's articles are twin bosses joined together where they are moulded to the rear

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of the cover plate. But each boss contains two separate blind internally threaded holes. It was contended that the claims in the specification are so precise that no switch cover plates would be an infringement, however immaterial the variation, which did not exactly reproduce each integer of the combination. Accordingly the fact that the bosses on the defendant's articles between the apertures are twin bosses whereas those between the apertures in the plaintiff's claims are separate bosses was said to be a sufficient distinction to save the defendant's articles from being an infringement of the plaintiff's patent. I cannot accept this contention. However precise the definition of an integer in a combination claim may be, it is still possible for the claim to be infringed where some mere mechanical equivalent is substituted for the mechanism described in that integer. Here the twin bosses in the defendant's cover plates with their separate blind internally threaded holes fulfil exactly the same function as the separate bosses in the plaintiff's invention, that is to say, they supply two threaded holes between each aperture for affixing one end of a switch mounted behind the cover plate to the rear of the plate by means not visible from the front thereof. The defendant by using twin bosses has substituted a mere mechanical equivalent for the separate bosses described in the plaintiff's claims, if one can dignify such a trifling variation in manufacture by calling it a mechanical equivalent. It is not the number of separate bosses attached to the rear of the cover plate but the presence in the right position of blind internally threaded holes in the bosses, be they twin or separate, into which screws can be inserted to attach the switches to the rear of the cover plates that is important, and in this respect the defendant has plainly taken and adopted the substance of an essential feature of the plaintiff's invention. That is sufficient to constitute infringement: *Clark v. Adie* (1); *Consolidated Car Heating Co. v. Came* (2); *Birmingham Sound Reproducers Ltd. v. Collaro Ltd.* (3). The defendant's cover plates, in my opinion, infringe both the claims of the plaintiff's specification.

The crucial question is whether the patent is valid. I am aware that a scintilla of invention is sufficient to support the validity of a patent. I am also aware that I must guard against falling into the error of thinking that the effect of a "new combination, bringing with it new and important consequences in the shape of practical machines, is not an invention, because, when it has once been

(1) (1877) 2 App. Cas. 315, at pp. 320, 321.

(2) (1903) A.C. 509, at pp. 516, 517.

(3) (1956) R.P.C. 232, at pp. 242-244.

established, it is easy to show how it might be arrived at by starting from something known, and taking a series of apparently easy steps": *British Westinghouse Electric & Manufacturing Co. Ltd. v. Braulik* (1). As I said during the hearing there was to my mind, prior to the *Patents Act*, a distinction between want of novelty and want of subject matter although the two objections tended for practical purposes to dovetail somewhat into one another. The first objection related to the question whether the patent failed because in the light of what had become public general knowledge prior to its date the manufacture claimed was not a new manufacture. Whenever a document describing a method of manufacture, generally a specification of some other letters patent, was placed where the public had access to it and whenever an article was used in such circumstances, the whole of the information contained in the document or revealed by the use of the articles became part of public general knowledge: *Pugh v. Riley Cycle Co. Ltd.* (2); *George Mann & Co. Ltd. v. Furnival & Co. Ltd.* (3); *Acme Bedstead Co. Ltd. v. Newlands Bros. Ltd.* (4). If the disclosure were such that it would enable any person of ordinary skill in the particular art to solve the problem solved by the patentee, the alleged invention was not new but old and failed for want of novelty. If the invention were novel it would nevertheless fail for want of subject matter if in the light of what was common general knowledge in the particular art, it lacked inventive ingenuity because the solution would have been obvious to any person of ordinary skill in the art who set out to solve the problem.

Section 100 of the *Patents Act* 1952-1954 however provides that a patent may be revoked, either wholly or in so far as it relates to any claim of the complete specification, on one or more of the following grounds: "... (e) that the invention, so far as claimed in any claim, was obvious and did not involve an inventive step, having regard to what was known or used in Australia on or before the priority date of that claim; ... (g) that the invention, so far as claimed in any claim, was not novel in Australia on the priority date of that claim." Paragraph (g) appears to accept the law relating to want of novelty as it existed at the date of the *Patents Act*. But par. (e) appears to have widened the law relating to want of subject matter. It requires the Court to have regard to what is known or used in Australia before the priority date of the claim, and the words "known or used" appear to embrace more than what had become

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(1) (1910) 27 R.P.C. 209, at p. 230.
(2) (1914) 31 R.P.C. 266, at pp. 277,
278.

(3) (1914) 31 R.P.C. 349, at p. 360.
(4) (1937) 58 C.L.R. 689.

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commonly known or used or in other words more than the common general knowledge of a skilled craftsman in the particular art on that date. The meaning of this paragraph was discussed by the Court of Appeal in *Allmanna Svenska Elektriska A/B v. Burntisland Shipbuilding Co. Ltd.* (1) and by the House of Lords in *Martin & Biro Swan Ltd. v. H. Millwood Ltd.* (2). It is clear from these discussions that in deciding what was obvious, it is necessary to consider what would have been obvious to the hypothetical skilled craftsman in the state of knowledge in the particular art existing at the priority date of the patent and that this knowledge consists of everything disclosed by the literature on the subject (including prior specifications), and revealed by the articles then in use and of the common general knowledge. In the case in the Court of Appeal *Jenkins* L.J., delivering the judgment of the Court, said: "The matter of obviousness is to be judged by reference to the 'state of the art' in the light of all that was previously known by persons versed in that art derived from experience of what was practically employed, as well as from the contents of previous writings, specifications, textbooks and other documents" (3). In the case in the House of Lords Lord *Simonds* after refuting the idea that the court in considering obviousness was not entitled to have regard to the whole body of information publicly available at the relevant date but was somehow confined to a particular document, which, once read, must then be put out of mind before another document was looked at, said: "Your Lordships at least have the opportunity of affirming that the law on this matter is as stated by *Jenkins* L.J., in *Allmanna Svenska Elektriska A/B v. Burntisland Shipbuilding Co. Ltd.* (4)" (5). With this statement the rest of their Lordships appear to have agreed. Lord *Morton* expressly approved of the same passage from the judgment of *Jenkins* L.J., and Lord *Somervell* agreed with the opinion of Lord *Morton*. In the present case the defendant is counterclaiming for revocation and the plaintiff is suing for infringement. Section 105 of the *Patents Act* provides that every ground on which a patent may be revoked is available as a ground of defence in an action for infringement of a patent. It would seem the previous law which prevents a person seeking to invalidate a patent for want of novelty from making a mosaic of the information contained in a number of prior paper publications or revealed by the use of a number of articles or from a combination of these sources, where that information

(1) (1952) 69 R.P.C. 63, at pp. 68-70.

(2) (1956) R.P.C. 125.

(3) (1952) 69 R.P.C., at p. 69.

(4) (1952) 69 R.P.C. 63.

(5) (1956) R.P.C., at pp. 133.

has not become part of common general knowledge, is still the law. But it is unnecessary to decide whether the plaintiff's patent fails for want of novelty because the defendant has rested its case primarily on the contention that on 10th October 1952 the invention was obvious and did not involve any inventive step having regard to what was then known or used. In support of this contention the defendant does not rely on any paper anticipations. It relies on the information revealed by the prior user of a number of switch cover plates mostly manufactured and sold by itself and contends that the sales were so extensive that this information had become not merely part of public general knowledge but also part of common general knowledge prior to October 1952. But it is clear from the above decisions that the whole of the information disclosed by the use of these switch cover plates prior to 10th October 1952 should be taken into account in deciding whether the alleged invention was then obvious or not even if it had not then become part of common general knowledge. As Lord *Evershed* M.R., said in *Benmax v. Austin Motor Co. Ltd.* (1): "In truth, as I think, it is necessary to regard the whole area of knowledge which the . . . previous uses had jointly disclosed" (2).

According to the evidence the principal manufacturers of switch cover plates are and were in October 1952 the plaintiff in Sydney, the defendant in Adelaide, and F. W. Cook and Williams Pty. Ltd. in Melbourne. The switch cover plates tendered in evidence by the defendant, all of which had been manufactured and sold to the public prior to 10th October 1952, consist of two brass cover plates exhibits (1) and (2) each manufactured so as to have attached behind them two switches one mounted above or alongside the other according to whether the switches were aligned vertically or horizontally, and a number of plastic switch cover plates each made by moulding thermo-setting plastic material to cover single switches and some of them, of which exh. (6) may be taken as an example, having one screw at the top and another at the bottom to attach them to an architrave or wall and two bosses behind them one above the aperture for the tumbler and the other below it containing blind internally threaded holes whereby the switch could be screwed to the rear of the plate by means of screws not visible from the front thereof. Every integer of the combination claimed in the plaintiff's specification, except possibly the requirement that the width of the plate should be substantially less than its length, had been disclosed prior to 10th October 1952. It was known that switch cover plates

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(1) (1953) 70 R.P.C. 284.

(2) (1953) 70 R.P.C., at p. 293.

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could be formed by moulding thermo-setting plastic material, that in the case of a brass plate there could be apertures placed one above the other for the tumblers of switches mounted in line behind the plate, that the plate could be screwed to the architrave or wall at each end, and that a switch could be attached to the rear of the plate by having bosses with blind internally threaded holes moulded integrally with the plate into which the screws needed to attach the switch to the plate could be inserted. The claims provide, as I have said, that the width of the plate shall be substantially less than its length and this has been defined to mean that the length of the plate shall be at least three times as great as its width. But there could be nothing inventive in this integer because a plate to which switches mounted one above the other could be attached would have to be a plate the length of which would be greater than its width and the comparative length of a plate to its width would necessarily have to increase according to the number of switches to be mounted one above the other.

The advantages to be derived from manufacturing a cover plate in accordance with the plaintiff's claims were said by one of its witnesses to be that with the narrower architraves that were coming into fashion it was desirable to get the width of a cover plate down to a minimum so that it could be screwed neatly and compactly into such an architrave, that the plaintiff's invention would allow of the easy fixing of a number of switches there being only two screws required to attach the cover plate to the architrave or wall, and that such a cover plate would provide for the inherent alignment of the switches one above the other and thereby provide a pleasing appearance. But it is impossible, in my opinion, to attribute to these advantages any inventive ingenuity. Suitable timber for building houses had become scarce soon after the outbreak of war and building costs were rising. This resulted prior to October 1952 in the manufacture of narrower architraves than heretofore and in the same period moulded plastic switch cover plates were replacing those made of brass and other materials. Moulded plastic cover plates for single switches were being used on architraves and walls. The plates were attached to the architraves and walls by a screw passing through the top and bottom of the plate, and the switches were attached to the back of the plates by screws inserted into blind internally threaded holes in bosses moulded behind the plates. This meant of course that separate holes would have to be made in the architrave or wall to house each switch. If one switch were mounted above the other, there would have to be a piece of wood

in the architrave between the holes into which the screws at the top of one and the bottom of the other cover plate could be inserted. In this state of knowledge the conception of replacing two or more switch cover plates by a single cover plate behind which two or more switches could be mounted vertically in a line on an architrave must, I think, have been obvious to any skilled craftsman seeking to solve the problem solved by the patentee. If the architrave were narrow the cover plate would have to be sufficiently narrow to screw on to it. Yet this conception seems to be the only possible basis on which the plaintiff's patent could be supported. Once the idea of mounting switches one above the other behind a single switch cover plate had been conceived, it would not have given any skilled craftsman any difficulty to give effect to it. But not even this conception was new. It had been disclosed by the manufacture and use certainly of exh. (1) and also I think of exh. (2). The information disclosed by the use of these exhibits was part of the knowledge which the hypothetical skilled craftsman would have had available in seeking to solve the problem in October 1952. The brass plate of which exh. (2) is a sample was usually placed horizontally on an architrave or wall but it was also suitable for vertical attachment. It is clear from Mr. Milne's evidence that he did not consider the conception of mounting two switches one above the other behind the same cover plate required any ingenuity and that the firm of electrical manufacturers he commissioned to make the plates found no difficulty in manufacturing them.

The inventor has told us what the problem was. In the specification he says that the invention is of particular value where it is desired to mount a plurality of switches one above the other on an architrave in such a manner that the work is reduced to a minimum and a neat appearance is produced. I am satisfied that either exhibits (1) or (2) by themselves would have disclosed to a skilled craftsman and in particular to any manufacturer of switch cover plates sufficient information to have enabled him to have solved this problem by the exercise of his ordinary skill and knowledge. But the skilled craftsman would also have had available all the information disclosed not only by these exhibits but also by exhibits (3)-(9). I find that cover plates of which exhibits (2)-(9) are samples were manufactured and sold by the defendant in large quantities prior to October 1952 and that the information disclosed by their use had become part of the common general knowledge of those engaged in the particular art. In the light of all this information, which was available to any craftsman coming fresh to the

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problem, whether it had become part of common general knowledge prior to October 1952 or not, I am satisfied that the invention claimed was obvious and did not involve any inventive step within the meaning of par. (e) of s. 100 of the *Patents Act*. Perhaps I might, with respect, adopt the words of Sir Wilfred Greene M.R. in *Automatic Coil Winder & Electrical Equipment Co. Ltd. v. Taylor Electrical Instruments Ltd.* (1): "the alleged invention is neat and compact: that it is of considerable practical use I am prepared to assume; but these qualities are not sufficient to satisfy the test of inventiveness" (2). Mr. Bowen sought to rely on the principle that "when once it has been found . . . that the problem had waited solution for many years, and that the device is in fact novel and superior to what had gone before, and has been widely used, and used in preference to alternative devices, it is . . . practically impossible to say that there is not present that scintilla of invention necessary to support the Patent": *Samuel Parkes & Co. Ltd. v. Cocker Bros. Ltd.* (3); *Non-Drip Measure Co. Ltd. v. Stranger's Ltd.* (4); *Martin & Biro Swan Ltd. v. H. Millwood Ltd.* (5). But the initial question is whether the problem had awaited solution for many years and there is no evidence that it had, or that anyone had been seeking to solve it but had not succeeded. If the conversion of a brass cover plate into a plastic cover plate can be considered an advance, all the alleged inventor did was to adapt Mr. Milne's conception to thermo-setting plastic moulding. But that was a mere workshop improvement. The execution of the conception was considered by the inventor to be so much part of common general knowledge that one is not told in the specification how to carry out the moulding. Commercial success is not in itself conclusive proof of invention. It is at most powerful evidence where the necessary conditions are satisfied. If it were, every article which was new to the market and sold in large numbers would be the proper subject of a patent. Such success in itself may prove only that the invention was commercial and not mechanical: *Riekmann v. Thierry* (6); *Cooper & Co. (Birmingham) Ltd. v. Baedeker* (7); *Thermos Ltd. v. Isola Ltd.* (8).

For these reasons I am of opinion that the suit fails and must be dismissed and that the counterclaim succeeds and the letters patent must be revoked. The plaintiff must pay the costs of the suit and counterclaim.

(1) (1944) 61 R.P.C. 41.

(2) (1944) 61 R.P.C., at p. 44.

(3) (1929) 46 R.P.C. 241, at p. 248.

(4) (1943) 60 R.P.C. 135, at p. 143.

(5) (1956) R.P.C., at p. 139.

(6) (1896) 14 R.P.C. 105, at p. 121.

(7) (1900) 17 R.P.C. 209.

(8) (1910) 27 R.P.C. 388.

Suit dismissed. Counterclaim allowed. Order that Letters Patent No. 161,893 be revoked. Order the defendant to serve on the Commissioner of Patents an office copy of the order for the revocation of the Patent. Plaintiff to pay defendant's costs of the suit and counterclaim. Judgment to be entered accordingly.

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Solicitors for the plaintiff, *Stephen, Jaques & Stephen.*

Solicitors for the defendant, *Davies, Campbell & Piesse*, Melbourne, by *Rawlinson, Hamilton & Francis.*

J. B.