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on business in breach of covenant between the making of the said order, viz., the 18th April 1935 and this date, and that the joint receivers be discharged without any further account unless on application made within one month by either party a Justice of this Court otherwise orders. In case of disagreement as to the fixation of remuneration or of costs, charges and expenses liberty to apply to a Justice of this Court.

Solicitor for the appellant, *E. W. Doust*, Guyra, by *C. A. Morgan & Stevens*.
Solicitors for the respondent, *Mackenzie & Biddulph*, Guyra, by *Biddulph & Salenger*.

J. B.

Cons <i>Underwood v Toby Construction Products Pty Ltd</i> 13 IPR 140	Appl <i>Re applications by Gould Inc</i> 13 IPR 644	Foll Indoor <i>Cricket Arenas v Aust Indoor Cricket Federation</i> 9 IPR 273	Cons <i>Dupps Co v Stord Bartz A/S</i> 18 IPR 499	Foll <i>Coopers Animal Health Aust v Western Stock Distributors</i> 6 IPR 545	Appl <i>Leonardis v St Alban (1992)</i> 24 IPR 351	Dist <i>McNeilab Inc v Sterling Pharmaceu- ticals (1992)</i> 24 IPR 297	Foll <i>Beckett, Re (1995)</i> 33 IPR 383
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[HIGH COURT OF AUSTRALIA.]

TATE APPELLANT ;
APPLICANT,

AND

HASKINS RESPONDENT.
OPPONENT,

H. C. OF A. *Patent—Opposition—Specifications—Disconformity—Not open to Commissioner after acceptance—Discretion of Commissioner—When exercisable—Patents Act 1903-1933 (No. 21 of 1903—No. 57 of 1933), secs. 42, 65, 86.*
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SYDNEY,
*April 9, 10 ;
June 11.*
Rich, Starke,
Dixon, Evatt
and McTiernan
JJ.

The provisions of sec. 65 of the *Patents Act* 1903-1933 prevail against the provisions of sec. 86 of that Act, and, as in infringement actions, so in revocation proceedings, disconformity between the complete and provisional specifications is not a ground for holding a patent invalid.
Unless there be an amendment after acceptance, disconformity is a matter which is closed by acceptance. The discretionary power conferred upon the Commissioner by sec. 42 of the *Patents Act* 1903-1933 should be exercised, if at all, before acceptance of the complete specification.

APPEAL from the Commissioner of Patents.

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On 27th July 1931 William Taren Tate lodged with the Commissioner of Patents an application for letters patent for an invention entitled "Improved apparatus for lining pipes with cementitious material." In the provisional specification which accompanied the application it was stated that the invention had been devised to provide a cheap and simple apparatus for lining pipes and tubes and the like with cement and especially for lining pipes of small bore, and it was particularly useful for lining pipe bends, assuring an even lining irrespective of the radius of the bend ; that this improved apparatus for lining pipes with cement in its simplest form was constituted of a rod made of a number of short lengths universally knuckled together and each having a plurality of radial arms thereon having bifurcated ends forming bearings for rubber-tyred rollers ; the fore end of the rod had an eye or other device for shackling to a hauling cable and the rear end of the rod had affixed thereto a frustro-conical distributor or spreader having a plurality of radial guides protruding from the base ; rearwardly of the spreader and affixed thereto or to the rod was a frustro-conical lining finisher whose end radii approached nearer equality than the radii of the spreader and the small end of which was entered into the base of the spreader ; the rollers on the radial arms neatly fitted the bore of an unlined pipe while the base of each spreader and the finisher was the diameter desired of the lined pipe ; that a cable for drawing the apparatus through the pipe had a plurality of guide shoes thereon spaced at equal distances therealong to keep the cable and the apparatus centrally in the pipe, the guide shoes being constituted of a boss having a plurality of spokes set at an angle to constitute a conical frame the outer edges of which formed rubbing and guiding surfaces ; that the pipe was lined from the flange end and had a hopper affixed thereto having a delivery chute the same bore as the pipe and having a feeding chute and devices, e.g., a ram, to force cement into the pipe ; at the spigot end of the pipe a finishing guide tube was affixed to ensure centralized drawing of the pipe liner and a flush and even lining of cement at the end of the pipe ; that when the cement was forced into the pipe the liner was drawn through ; the spreader ensured an even application of cement to

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the wall of the pipe, at the same time imparting the requisite pressure to make it adhere to the pipe, while the finisher smoothed the cement so deposited ; and that in a modified construction the rollers were replaced by slippers or guide shoes. The application and the provisional specification were accepted on 11th August 1931. The invention was described in greater detail in a complete specification which, accompanied by drawings, was lodged in March 1932. Details given therein of the spreader were that it was more or less bell-shaped, preferably of metal, having a conical or “ bull ” nose from which it was stepped or tapered to a trailing skirt which “ has a multiplicity of small dehydrator holes through the periphery thereof ” ; that the spreader could be in one or in a plurality of parts, either shackled together, universally or otherwise, or directly and rigidly attached to each other, and in all cases, whether the spreader was of single or of multiple construction, the foremost portion functioned as a plastic concrete distributor and the rearmost portion as a lining compressor and smoother ; that a float could be incorporated with the spreader to follow it through the pipe and was especially useful with spreaders having dehydration orifices therein to amalgamate cementitious drippings therefrom with the lining ; and that should a spreader having dehydration orifices therein be employed—its use was governed to a very considerable extent by the concrete mixture—a float as described was preferably coupled behind to smooth out and amalgamate with the lining the small amount of cementitious drippings passing through the dehydration orifices, or the orificed spreader was provided with an end cap as described. The object of the dehydration holes or orifices was to provide an escape for water or cement drippings pressed out of the cement mixture by the spreader as it was pulled through a pipe and thus avoid the slumping of the cement lining in the pipe. In two of his twenty claiming clauses Tate included the dehydration orifices among the elements which he associated as the features of his invention. The application and specifications were referred to an examiner, who submitted a report. After amendment had been made in some immaterial particulars the complete specification was, on 30th June 1932, accepted, and seven days later the application was advertised. On 3rd November 1932 Gerald Haskins, the

respondent, gave notice of opposition to the grant of letters patent, on the grounds of want of novelty and prior publication and anticipation. On 8th December 1932 Tate sought leave to make further amendments in his complete specification. These amendments gave greater prominence in the body of the document to the dehydration orifices in the spreader and to the idea of pressing the moisture out of the cement lining material. The proposed amendments introduced this feature in three principal claims as part of the invention. The amendments were not opposed, and they were allowed on 6th March 1933. In the first claiming clause of the complete specification so amended Tate claimed an "improved apparatus for lining pipes with cementitious material constituted of a spreader having devices to cause dehydration of the lining material immediately prior to the final smoothing thereof a positionary guide for and attached to the said spreader and a cable attached to the said guide and hauling mechanism for said cable all for the purposes set forth substantially as herein described and explained." Up to this time the point had not been taken by anyone that in relying upon the dehydration orifices and the idea of pressing out the water the complete specification did not conform to the provisional specification. The hearing of the opposition to the grant of letters patent was then commenced. In support of his grounds of opposition Haskins drew the attention of the Acting Commissioner to the absence from the provisional specification of any reference to the dehydration orifices in the spreader. The Acting Commissioner ruled that an opponent cannot set up disconformity as a ground of opposition, but he considered that he himself was bound to take into account any objection to a specification which came to his notice before grant. He formed the opinion that the amended complete specification was in disconformity with the provisional specification for the reason stated by Haskins. But the Acting Commissioner regarded the specification as open to objection on the grounds also that it was indefinite and ambiguous. On 15th June 1934 he gave an interim decision to this effect and afforded Tate an opportunity again to amend his complete specification. A further application to this end was made by Tate on 23rd

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July 1934, but no amendments were sought in respect of the dehydration orifices. In view of the refusal to abandon this feature the Acting Commissioner did not proceed with the application for amendment, which, however, he did not regard as satisfactorily disposing of his other objections. Tate did not take any further action to amend the complete specification in the manner considered necessary by the Acting Commissioner. The latter, therefore, under sec. 57 of the *Patents Act* 1903-1933, refused to grant the application for a patent. He held that, excluding the feature relating to the dehydration orifices, the invention claimed by Tate lacked novelty, and that there was definite disconformity between the provisional specification and the complete specification as to dehydration devices.

From that decision Tate, in pursuance of sec. 58 of the Act, appealed to the High Court.

Further material facts appear in the judgments hereunder.

During argument the Court intimated its opinion that the complete specification, as amended in 1933, did exceed the limits of the provisional specification.

Weston K.C. (with him *May*), for the appellant. The whole matter has gone upon the issue of disconformity. If the Acting Commissioner was not at liberty to consider disconformity, his decision was wrong; if he was at liberty to consider disconformity and considered it a bar to the granting of a patent, then, the Commissioner, not having applied his mind to the curing of certain alleged imperfections, should be given an opportunity of considering the application to amend. On a general application the Commissioner is not required to examine the matter with that degree of strictness required in proceedings of another character, e.g., infringement proceedings. Disconformity must be clearly established (*Stamp v. W. J. Powell Pty. Ltd.* (1)). There is not any disconformity in this matter. The scope of a provisional specification is discussed in *Edmunds on Patents*, 2nd ed. (1897), pp. 142 et seq. The idea of the dehydration orifices which is included in the complete specification is a development fairly arising from, or a working out of, the provisional specification. It is admitted

that the orifices constitute a salient feature ; they are, however, a feature within the ambit of invention. The shackles also have not been anticipated. Subject to questions similar to those in *May v. Higgins* (1) which might arise, the matter is curable. The added feature does not alter the nature of the invention as claimed ; it is simply a development and improvement. In the early period of the patent system the basis of disconformity was deception of the Crown (*Croll v. Edge* (2) ; *Terrell on Patents*, 8th ed. (1934), pp. 114, 115).

[RICH J. referred to *Brunton v. Hawkes* (3).]

The development of this phase of patent law is shown in the English *Patent Law Amendment Act* 1852 and in *United Telephone Co. v. Harrison, Cox-Walker & Co.* (4). Although in *Nuttall v. Hargreaves* (5) it was held that disconformity between the complete specification and the provisional specification was an absolute bar, the law as there defined was displaced by sec. 42 of the English *Patents and Designs Act* 1907, to the extent to which that section goes in the particular type of disconformity. The parallel section in the *Patents Act* 1903-1933 is sec. 65, which is expressed in terms wider than those of sec. 42 of the English Act. Sec. 86 (3) of the *Patents Act* 1903-1933 is controlled by sec. 65 of that Act. Disconformity cannot be an objection to a patent after it has been granted ; that this was the intention of the Legislature is indicated by sec. 56 (d) of the *Patents Act*. Sec. 42 (b) of that Act is a protection to the public similar to that afforded to an opponent under sec. 56 (d). The power impliedly vested in the Commissioner is no more than a power to reject letters patent if they would be invalid. Any of the powers under sec. 56 is open to the Commissioner. The remarks of *Isaacs J.* and *Higgins J.* in *Dunlop v. Cooper* (6) are dicta only. The position would be met if the procedure indicated in sec. 42 (b) were adopted. There is a very material difference between proceedings prior to the acceptance of specifications and proceedings subsequent to acceptance. The

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(1) (1916) 21 C.L.R. 119.

(2) (1850) 9 C.B. 479, at pp. 491, 492 ;
137 E.R. 978, at p. 983.

(3) (1821) 4 B. & Ald. 541 ; 106 E.R.
1034.

(4) (1882) 21 Ch. D. 720, at pp. 743
et seq.

(5) (1892) 1 Ch. 23 ; 8 R.P.C. 450.

(6) (1908) 7 C.L.R. 146, at pp. 165,
166, and 176, 177.

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examiner did not report adversely on the ground of disconformity. Secs. 39 to 42 of the *Patents Act* indicate that the Commissioner is not bound to disallow an application on the ground of disconformity. Here he has regarded himself as so bound and has not applied his mind to the exercise of the discretionary power conferred by sec. 42. This is shown by his reference to *In re Lancaster's Application* (1). That decision, however, was not followed in *In re Hull's Application* (2).

Flannery K.C. (with him *Thomas*), for the respondent. The Acting Commissioner was right in refusing, on the ground of disconformity, a grant of letters patent, and in determining the matter in favour of the opponent. It is shown by sec. 66 of the *Patents Act* that the power of the Commissioner does not cease until the grant of the patent. In opposition proceedings the Commissioner has power to consider grounds other than those to which the opponent is limited (*In re Lancaster's Application* (1)). The position in law remains as stated in that decision (*In re Bamber and Cropper & Co.'s Application* (3)). The provision of sec. 42 of the English *Patents and Designs Act* 1907, as to invalidity, is by its terms confined to determination of invalidity after grant of the patent. The decision in *In re Hull's Application* (2) was founded upon that section. The Commissioner retains the power of enforcing the various provisions of the Act, including grounds not available to an opponent, until the final step in connection with the issue of the grant has been taken (*In re Metz Laboratories' Application* (4); *In re Johnson's Application* (5); *In re Hughes and Kennaugh's Application* (6); *In re Wadham's Application* (7)). The Commissioner is not estopped by his own previous acts or omissions. The acceptance of the complete specification does not operate to tie his hands. The matter remains open up to and beyond the commencement of opposition proceedings; any good ground of refusing the grant is open before the Commissioner acts either under sec. 46 of the *Patents Act* or under sec. 66 of that Act.

(1) (1902) 20 R.P.C. 366.

(2) (1930) 49 R.P.C. 433.

(3) (1924) 41 R.P.C. 417.

(4) (1933) 50 R.P.C. 355.

(5) (1930) 47 R.P.C. 519, at p. 525.

(6) (1910) 27 R.P.C. 281.

(7) (1909) 27 R.P.C. 172.

The Commissioner is concerned to see that the public interest is preserved (*In re Metz Laboratories' Application* (1)). This is achieved by an adherence to the provisions of the Act. The amendments are substantially different from the complete specification accepted. The defects, which were properly so found by the Commissioner, are not cured by the application to amend. That application is not before the Court and was not accepted. Upon an application to amend, the matter comes within sec. 78 of the Act. The appellant is not entitled to a grant on any ground (*In re Johnson's Application* (2)). The nature of disconformity may vary considerably, and discretion is given with regard to various matters of conformity. There is a discretionary power in the Commissioner to act under sec. 42 (a) or (b) or to refuse. Action under one does not constitute a refusal to act under the other, nor does it show that the Commissioner has not considered the matter.

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Dean, for the Commissioner of Patents, intervening by leave. The general power of the Commissioner to grant or reject a patent after acceptance of the specifications is discussed in *Terrell on Patents*, 8th ed. (1934), pp. 203, 204. The Commissioner is entitled to exercise the power in cases of disconformity (*Comptroller-General's Ruling A* (3)). The power has been exercised after acceptance on the following grounds: "Ambiguity" (*In re Francis' Application* (4); *In re Wadham's Application* (5)); "prior publication" (*Comptroller-General's Ruling E (Wainwright's Case)* (6)); "prior specifications" (*In re Hughes and Kennaugh's Application* (7); *In re Osterstrom and Wagner's Application* (8)). In *In re George Richards & Co. and Laidlar's Application* (9) the Court ordered the insertion of a specific reference other than that requested by the opponent. The paramount consideration is the "public interest" (*In re Thomas and Prevost's Application* (10); *In re Kempton and Mollan's Application* (11); *In re Johnson's Application* (2)). Amendments which introduce new features involving disconformity

(1) (1933) 50 R.P.C. 355.

(2) (1930) 47 R.P.C. 519.

(3) (1913) 30 R.P.C., Appendix 3,
p. ii.

(4) (1909) 27 R.P.C. 86.

(5) (1909) 27 R.P.C. 172.

(6) (1912) 29 R.P.C., Appendix 27,
p. xi.

(7) (1910) 27 R.P.C. 281.

(8) (1932) 49 R.P.C. 565.

(9) (1924) 41 R.P.C. 321.

(10) (1898) 15 R.P.C. 257.

(11) (1905) 22 R.P.C. 573.

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with the specification will not be permitted (*In re Lancaster's Application* (1); *In re Bamber and Cropper & Co.'s Application* (2); see also *In re Barraclough's Application* (3)). It is shown in *In re Metz Laboratories' Application* (4) that the Commissioner retains this general power until the completion of the grant of letters patent. The power was available to the Commissioner in this case. In cases of opposition the Commissioner is entitled in the public interest to have regard to any consideration to which he might have had regard at an earlier stage and which would prevent the making of a grant which otherwise should not be made. In such a case an appeal would lie under sec. 58 of the *Patents Act*, and upon the appeal the applicant and any opponents might, under sec. 59, be heard by the Court. The Commissioner is not bound to grant a patent which he knows would be invalid; the proper course is either to withdraw the acceptance and recommit the matter for consideration under sec. 46, or, finding a lawful ground of objection, refuse to accept the second time, or refuse to proceed at all, in which case the applicant, if the Commissioner be wrong in fact or law, would have his remedy by mandamus (*Reid v. Commissioner of Patents* (5)). This is a proper case for the exercise of the power on the grounds of (a) disconformity, and (b) ambiguity. The patent was not refused solely on the ground of disconformity; the real objection is that the invention, as originally claimed, is not novel. The specification is ambiguous in that it does not fairly and fully describe and ascertain the invention as required by sec. 36. The meaning and effect of the words "substantially as described" is discussed in *Terrell on Patents*, 8th ed. (1934), pp. 135, 136. Even though the dehydration orifices constitute a new and novel feature the appellant is not thereby entitled to a patent in respect of the combination (*May v. Higgins* (6)).

Weston K.C., in reply. There are practical and technical objections to this Court's disposing finally of the matter. The appellant's application to amend has not been rejected by the Commissioner. His duty in this matter is as provided in secs. 72-83 of the Act.

(1) (1902) 20 R.P.C. 366.

(2) (1924) 41 R.P.C. 417.

(3) (1919) 37 R.P.C. 105.

(4) (1933) 50 R.P.C. 355.

(5) (1915) 20 C.L.R. 261.

(6) (1916) 21 C.L.R. 119.

The appellant has a statutory right to have his proposed amendments considered and to have the claims altered as may be proper and allowed. The appellant has a statutory right to remove the imperfections referred to by the Commissioner. Even assuming that the Commissioner's criticisms are justified, the appellant is, nevertheless, entitled to a patent in respect of the shackling, which, like the dehydration orifices, is a new and important feature. Disconformity is, within limits, permitted by sec. 78. That section permits an invention which is larger and different from that described in the provisional specification, provided that it be not substantially different. The Commissioner has not exercised his discretion. He has given a final decision and has never once adverted to discretion. The matter should be remitted to him on that ground. This is a combination in the true sense, but, if the Court should take the other view, the appellant should be given an opportunity to amend (*May v. Higgins* (1)).

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Cur. adv. vult.

The following written judgments were delivered :—

June 11.

RICH, DIXON, EVATT AND McTIERNAN JJ. This is an appeal under sec. 58 of the *Patents Act* 1903-1933 by an applicant for a patent from the refusal of a grant by the Acting Commissioner after opposition proceedings.

The invention for which a patent is sought is for a means of lining pipes of small bore with concrete and the like. It provides an apparatus by which cement concrete may be drawn through a pipe lying horizontally, leaving an internal skin firmly adhering to the inner surface. There is nothing new in such a method of lining pipes, which is chiefly practised upon old pipes already in the ground. The material for lining the pipe is forced through by a cone-shaped spreader of slightly smaller diameter than the pipe so that a film of the material is forced against the wall of the pipe and left adhering to it as the spreader passes through. The spreader is pulled from the other end of the pipe by a cable fastened to its nose or apex. It has been found desirable to use some means for maintaining the

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spreader in a completely central position as it passes through, and several guides have been devised. Two difficulties have been experienced in lining pipes in this manner. It has not been found easy to devise spreaders which will operate satisfactorily in curved and bent pipes. And it has not been found easy to use material which will be wet enough to form an even and smooth paste on the wall of the pipe but not so wet that it will fall off the upper part of the internal surface after the spreader passes. The applicant's invention, as it has been finally evolved, professes to overcome both these difficulties. The first is dealt with by the manner in which guides and spreader are arranged and coupled and by the nature of the guides supplied. The second is dealt with by perforating the wider part of the cylindrical cone so that it will allow a passage or escape for the water which, as it passes, it presses out of the concrete. In his provisional specification the applicant did not describe or disclose the latter device. It appears that he discovered the advantage of the orifices in the spreader in the course of experiments which he made after he obtained the protection which the filing of his provisional specification gave. He mentioned them, however, in the body of the complete specification which he filed and explained their purpose. In two of his twenty claiming clauses he included them among the elements which he associated as the features of his invention. After amendment in some immaterial particulars this specification was accepted. Then the respondent filed notice of opposition. After he had done so, the applicant sought leave to make further amendments in his complete specification. These amendments gave greater prominence in the body of the document to the holes in the spreader and to the idea of pressing the moisture out of the cement lining material. In three principal claims the proposed amendments introduced this feature as part of the invention. The amendments were not opposed and they were allowed. Neither the examiner nor anyone else up to this time took the point that, in relying upon the holes and the idea of pressing out the water, the complete specification did not conform to the provisional.

In the application for the amendment a clerical error occurred which was carried into the advertisement. Although the proposed

amendments were correctly shown upon a copy of the specification, the numerical reference to the lines of the columns was misstated. The error does not, in our opinion, operate either to misplace the amendment in the specification or to destroy its validity. The place and nature of the amendment allowed by the Commissioner are determined by the copy of the document in which they were actually made, and that was correct. Its validity cannot be impugned, because sec. 79 of the *Patents Act* makes leave to amend conclusive, in the absence of fraud, as to the right to make the amendment and provides that it shall in all Courts and for all purposes be deemed to form part of the specification.

The hearing of the opposition was entered upon after the amendments had been made. The grounds of opposition were lack of novelty, prior disclosure and anticipation. In support of these grounds the respondent drew the Commissioner's attention to the absence from the provisional specification of any reference to the holes in the spreader. The reason or pretext given for introducing into the opposition a matter so evidently going to disconformity was that the ambit of the provisional specification militated against the reliance which the applicant placed upon this feature of his invention as supplying novelty.

The Commissioner properly ruled that an opponent cannot set up disconformity as a ground of opposition. But he considered that he himself is bound to take into account any objection to a specification which comes to his notice before grant. He formed the opinion that the amended complete specification was in disconformity with the provisional because it introduced into the invention, as described and as claimed by some of the claiming clauses, the holes in the spreader as a device for the removal of water. If this feature was excluded the residue of the first claim would not, the Commissioner considered, disclose any invention, having regard to the restricted area left available by common knowledge and anticipations. Claims depending upon the applicant's attempt to devise and arrange parts so that his appliance would be better suited for lining curved and bent pipes might be enough to support the invention. But the Commissioner regarded the specification as open to objection in point of form in other respects as well as because

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it included what the provisional did not cover. He gave an interim decision to this effect and allowed the applicant an opportunity to apply for the amendments which his interim decision made necessary. The applicant did lodge a request for amendments to remove other objections made to his specification, but he retained and persisted in the claims for a monopoly of which the holes in the spreader would constitute an element. In view of the refusal to abandon this feature the Commissioner did not proceed with the application for amendment, which, however, he did not regard as satisfactory in other respects. But, as no amendment which left standing claims referring to the holes would affect the Commissioner's interim decision that the complete specification was in disconformity with the provisional, he refused the application for a patent. He held that, excluding the feature which in his opinion ought not to be there because it involved disconformity, the first claim in the amended specification must fail on the ground of want of novelty. He said that he therefore decided the case under sec. 57 by refusing to grant letters patent. This appears to us a refusal upon the ground of disconformity. If a claim possesses novelty, to decline to allow it because it has attained novelty at the expense of conformity, is to refuse it upon the ground that the complete specification is not in conformity with the provisional. Accordingly the question arises upon this appeal whether the Commissioner ought at that stage to have refused a grant upon such a ground.

The requirement that a complete specification shall conform to the provisional has its source in the history of English patent law. The specification took its origin in the introduction early in the eighteenth century into the letters patent of an express condition that the grant should be void if the grantee should not within six months particularly describe and ascertain the nature of his invention, and in what manner the same was to be performed, by an instrument in writing enrolled in Chancery. There was no provisional specification at that time. The grant itself was made upon a brief description of the invention which was incorporated in the letters patent. This description provided at once a foundation for the grant and a means of restricting the area of the monopoly. "The language in which the supposed invention is described in a patent of this nature is the

language of the patentee himself. He represents to the Crown, that he has invented this or that thing, and that he is the first and sole inventor thereof, etc. ; and the Crown yielding to his representation, and willing to give encouragement to all arts and inventions that may be for the public good, grants to the patentee the sole liberty and privilege of using his said invention, for a certain term, under the conditions before noticed. It is obvious, therefore, that if the patentee has not invented the matter or thing of which he represents himself to be the inventor, the consideration of the Royal grant fails, and the grant consequently becomes void. And this will not be the less true, if it should happen that the patentee has invented some other matter or thing, of which, upon a due representation thereof, he might have been entitled to a grant of the exclusive use The language of the patent may be explained and reduced to certainty by the specification ; but the patent must not represent the party to be the inventor of one thing, and the specification show him to be the inventor of another ; because, perhaps, if he had represented himself as the inventor of that other, it might have been well known that the thing was of no use, or was in common use, and he might not have obtained a grant as the inventor of it” (per *Abbott C.J.*, *R. v. Wheeler* (1)). The disconformity of the specification from the description contained in the grant might be caused by one or other of two causes of opposite characters. The patentee might at the time of the grant have been in possession of the invention he afterwards specified and so have been guilty of a failure to include it within the description. In representing to the Crown the nature of the invention he had discovered he would then give the Crown no notice that he claimed its exclusive use as part of the monopoly. (Cf., per *Maule J.*, *Croll v. Edge* (2).) On the other hand, the patentee may not have made the new or additional discovery which he included in his specification until after the grant. In that case he would be endeavouring to enlarge his monopoly beyond its true scope. Whichever was the cause for the departure of the specification from the description of the invention, it proved fatal to the validity of the patent. Those were days in which

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(1) (1819) 2 B. & Ald. 345, at pp. 349-351 ; 106 E.R. 392, at pp. 394, 395.

(2) (1850) 9 C.B., at p. 492 ; 137 E.R., at p. 983.

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Joseph Chitty Jun. could say : “ Few specifications have successfully stood the test of legal scrutiny : a consideration which proves the necessity of exercising the utmost circumspection and care, and of calling to the patentee’s aid the skill, the experience, and the unprejudiced judgment of others ” (*Prerogatives of the Crown* (1820), p. 183).

In 1852 an innovation was made and the applicant was required to deposit a provisional specification describing the nature of his invention. If a law officer was satisfied that it did so, he might allow the same, and then for six months the invention would obtain the same protection as a patent would give it. In the meantime the complete specification might be filed. The relation of the two specifications and the purpose of the provisions were described by Lord *Chelmsford* in *Penn v. Bibby* (1) as follows :—“ The object of this protection evidently is, to enable the patentee to perfect his invention by experiments which, although open and known, will not be a user and publication to the prejudice of letters patent to be afterwards granted, so that he may be in a condition to describe in his complete specification, as the result of his experience, the best manner of performing the invention. It clearly appears, therefore, that the complete specification is, in a sense, supplemental to the provisional specification, not going beyond nor varying from it as to the nature of the invention, but conveying additional information, which may have been acquired during the currency of the provisional specification, as to the manner in which the invention is to be performed.” To this scheme the old rule appeared naturally to apply ; the provisional specification occupying the position of the description contained in the grant. At any rate the principle was accepted that the patent was void if the complete specification contained another and different invention from that described in the provisional. *Willes J.* said in *Thomas v. Welch* (2) that he did not think that the Legislature intended that the provisional specification should only be an additional pitfall. Pitfall or not, the provisional specification supplied an improved means of invalidating patents, and it long remained part of the routine in

(1) (1866) L.R. 2 Ch. 127, at p. 132.

(2) (1866) L.R. 1 C.P. 192, at p. 202.

the defence of infringement proceedings to scrutinize the two specifications to find a disconformity.

When in 1883 the procedure attending applications for patents was fundamentally altered and it was required that before grant both provisional and complete should be filed and examined and reported on by officers, it was thought by some that disconformity could no longer be a ground of invalidity. If an examiner reported that the invention described in the complete was not substantially the same as that described in the provisional, the Comptroller might refuse to accept the complete specification until it was amended to his satisfaction (46 & 47 Vict. c. 57, sec. 9). The Comptroller apparently had a discretionary power, disconformity was not included in the grounds of opposition, and no longer could it be supposed to work any deception upon the Crown. An argument was therefore advanced that disconformity had ceased to be a ground of invalidity. But the Courts rejected this contention (*Nuttall v. Hargreaves* (1), and per Lord *Halsbury* L.C. in *Vickers, Sons & Co. v. Siddell* (2)). The reason for rejecting it was contained in the provision that every ground on which a patent might at the commencement of the Act be repealed by scire facias should be available by way of defence to an action of infringement and should also be a ground of revocation (46 & 47 Vict. c. 57, sec. 26 (3)). Disconformity was at the commencement of the Act a ground for repealing a patent by scire facias.

This was the state of the law in England in 1903 when the Commonwealth Parliament passed the *Patents Act*. Sec. 86 of that statute enacts that every ground on which a patent might at common law be repealed by scire facias shall be available as a ground of revocation. But sec. 65 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. There is some appearance of inconsistency between these two sections, at any rate if the interpretation be followed which was given to the corresponding sec. 26 (3) of the English Act of 1883. But in our opinion the provisions of sec. 65

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(1) (1892) 1 Ch. 23; 8 R.P.C. 450.

(2) (1890) 15 App. Cas. 496, at p. 499.

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prevail, and, as in infringement actions so in revocation proceedings, disconformity is not a ground for holding a patent invalid.

If disconformity does not go to validity it can at most be a matter affecting the applicant's title to a grant from the Commissioner. The provisions which relate to it treat it as a matter going to the regularity of the applicant's proceedings, to the propriety of his having a grant for the added matter and to the time as from which the grant should take effect. Sec. 40 provides that the examiner shall ascertain and report whether the invention described in the complete is substantially the same as that described in the provisional specification. Sec. 42 provides that if he reports thereon adversely the Commissioner may require the applicant to amend under his directions or he may direct that the application shall date from some specified later time. The provision, in our opinion, confers a discretion upon the Commissioner. He may require an amendment or may post-date the application or may notwithstanding the examiner's report simply proceed to acceptance, and this although he is not satisfied that the examiner is wrong about disconformity. If he thinks that the departure from the provisional is not likely to prejudice anyone, he may disregard it. If he thinks that the invention as it appears from the complete ought to be protected and that all prejudice to others will be avoided by giving a later commencement to the monopoly, he may adopt that course unless he thinks it unfair to the applicant to do so. If he thinks that there is good reason for denying the applicant the liberty to go outside the ambit of his provisional which the first two courses might concede, he may require an amendment of the specification. Further, the Commissioner may deal with a case of disconformity by applying more than one of these powers. He may, for instance, insist on the exclusion of part only of the new matter and for the rest go on to accept the specification. If the Commissioner post-dates the application or directs an amendment, the applicant may appeal to a law officer (sec. 43). Under sec. 46, in the absence of any lawful ground of objection the Commissioner must accept the application and specification unconditionally. This section confers a right upon applicants. That right might be enforced by appeal under sec. 47.

Upon acceptance, which must be advertised, the application is exposed to opposition. But opposition is limited both in reference to grounds and to time. Disconformity in itself is excluded from the grounds of opposition. An applicant for another patent, however, may oppose if his application has been filed after the lodging of the provisional and before the complete specification: he may rely upon the ground that the complete describes or claims an invention other than that described in the provisional specification and that the invention so introduced is the subject of his application (sec. 56 (d)). This special provision appears to assume, if not to imply, that mere disconformity is no longer of concern after acceptance. Sec. 57 describes the opposition as a case which is to be heard and decided by the Commissioner: and from his decision an appeal to the Court is given by sec. 58 to any party aggrieved. Sec. 66 provides that, if there is no opposition, or in case of opposition the ultimate decision is in favour of the grant of a patent, the Commissioner shall cause the patent to be sealed.

These provisions would appear to give to an applicant whose application and complete specification have been accepted a right to a grant unless that right is intercepted by a successful opposition. But under the analogous provisions of the English legislation (secs. 9, 11 and 12 of 7 Edw. VII. c. 29) it has been generally considered that if at any time before sealing it appears to the Comptroller that the applicant is not entitled to the grant he may, and ought to, refuse it. With the full approval of many law officers expressed in their reported decisions a practice has grown up under which the Comptroller acts upon matters which are brought to his notice during opposition proceedings falling outside any allowable ground of opposition. The practice has been recognized by *Luxmoore J.*, sitting as the appeal tribunal (*In re Metz Laboratories' Application* (1); cf. per *Eve J.* in *In re Wingate's Patent* (2)).

A refusal to seal a patent which when sealed would be invalid has a justification which does not extend to objections affecting only matters preliminary to grant. Notwithstanding that, under the procedure prescribed by the statute, an applicant has performed all the conditions upon which according to the terms of the statute

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(1) (1933) 50 R.P.C. 355.

(2) (1931) 2 Ch. 272, at p. 285.

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the Comptroller's duty to seal arises, the very fact that the patent would be void when sealed means that the duty is only apparent and not real. The instrument would be inefficacious because contrary to law. It cannot be the imperative duty of any officer to issue such an instrument. Mandamus would not go to compel him to do so. But a matter which goes only to discretion stands in a very different position. If the statute preserved to the Commissioner a discretion right up to the moment of sealing, nothing would remain but for him to exercise it. But upon the very terms of the statute conformity is a matter which, apart from amendment, falls to be dealt with prior to acceptance.

The present case well illustrates the consequence of deserting the plan of the statute. The applicant, when confronted with the Commissioner's objection that his complete did not describe the same invention as his provisional specification, requested the Commissioner to post-date the application, that is, to exercise a power given by sec. 42. The Commissioner, however, regarded that power as inapplicable to the proceedings. Yet, if the question of disconformity had been dealt with at the stage intended by the statute, it is under sec. 42 that the course to be taken must have been decided. Further, an appeal to the law officer might then have been taken under sec. 43. If, through non-compliance with a direction given under sec. 42, or because disconformity was considered a lawful ground of objection, the Commissioner refused to accept under sec. 46, an appeal would lie to the Court under sec. 47.

But, except for the circumstances that the Commissioner, erroneously, as we think, treated the question as one of want of novelty and thus brought it within the range of sec. 57, his refusal of the grant would not, or might not, have amounted to a decision from which the statute gives an appeal. Where the view acted upon is that the Commissioner is always concerned that grants are proper and on this ground may up to the last moment refuse to seal a patent, there is no logical reason for connecting his refusal with the decision of an opposition. Yet under sec. 58 an appeal lies only from such a decision.

Further, disconformity is no longer a ground upon which a patent is necessarily to be refused. It must be dealt with by the exercise of a discretionary judgment. When as a result of its exercise a direction to amend is given with which the applicant fails to comply, refusal will no doubt follow. In our opinion, unless there be an amendment after acceptance, disconformity is a matter which is closed by acceptance. If an application is made to amend, it of course enters into the question whether the amendment should be allowed. In the present case it might again have been considered when the applicant sought leave to amend. But when the amendment was allowed, that objection to its allowance, in common with every other objection, was shut out by sec. 79.

In our opinion disconformity was not a ground upon which at the stage of opposition the Commissioner could refuse the application, and his decision did amount to a refusal upon that ground.

The appeal should be allowed and the matter remitted to the Commissioner. The appellant's costs should be paid by the respondent, who should also pay the Commissioner's taxed costs of his appearance at the hearing of the appeal.

STARKE J. The appellant, in July of 1931, lodged an application for letters patent for an invention entitled "Improved apparatus for lining pipes with cementitious material," accompanied by a provisional specification. It was accepted in August of the same year. The apparatus described in this specification consisted of a rod made of a number of short lengths, knuckled together, a conical distributor or spreader affixed to the rear end of the rod, positioning guides, rollers, and a cable, with guide shoes for drawing the apparatus through the pipes. A complete specification was lodged in March of 1932; it described the invention in detail. But it added to the apparatus a multiplicity of small orifices in the periphery of the distributor or spreader or in a skirt stepped or trailing therefrom. The object of this addition was to provide an escape for water or cement drippings pressed out of the cement mixture by the spreader, as it is pulled through a pipe, and thus avoid the slumping of the cement lining in the pipe. A description of these orifices was introduced into the statement of the invention claimed by the applicant, and

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they are referred to in the complete specification as dehydrating orifices. The application and specifications were submitted to an examiner, who submitted a report. Some unimportant amendments were made, and on 30th June 1932 the complete specification was accepted, and on 7th July 1932 the application was advertised. On 3rd November 1932 the respondent gave notice of opposition to the grant of letters patent on the grounds of want of novelty and prior publication. On 8th December 1932 the applicant applied to amend his complete specification. This application was advertised and the amendment made. I pass by, as unimportant, some typographical errors in the application for the amendment and its advertisement. A hearing of the opposition to the grant of letters patent was then undertaken. The Acting Commissioner of Patents considered the complete specification indefinite and ambiguous, and gave the applicant an opportunity to amend. In July of 1934 a further application to amend the complete specification was accordingly lodged. The Acting Commissioner considered the proposed amendments, and came to the conclusion that they did not entirely dispose of his objections to the complete specification, and that the means or devices for causing dehydration of the lining material were definitely in disconformity with the provisional specification, and must be excluded from the invention as claimed in the complete specification. Finally, in October 1934, as no further amendment was made, the Acting Commissioner refused to grant letters patent. He was of opinion that, exclusive of the dehydration devices, the invention put forward by the applicant was wanting in subject matter; and that there was definite disconformity between the provisional and complete specifications as to the dehydration devices. An appeal is now brought to this Court from the Acting Commissioner's decision, pursuant to sec. 58 of the *Patents Act* 1903-1933.

During argument, the Court intimated its opinion that the complete specification, as amended in 1933, did go outside the limits of the provisional specification; and this fault is called disconformity. Disconformity in English law rendered a patent void; the patentee had deceived the Crown. But after the English Act of 1883 was

passed, it was suggested that objections on the ground of disconformity were obsolete; a complete specification was lodged before the letters patent were granted and was subject to examination in the Comptroller's office, and if a patent were sealed after such an examination it was difficult to say that the Crown was deceived. But the Courts held otherwise, and disconformity remained a fatal objection to the validity of a patent (*Nuttall v. Hargreaves* (1); *Lane Fox v. Kensington and Knightsbridge Electric Lighting Co.* (2); *Gadd and Mason v. Mayor &c. of Manchester* (3)). In England, the matter is now governed by the *Patents and Designs Act* 1907-1932, secs. 6, 25 (2) (l), 42. In Australia, the *Patents Act* 1903-1933, sec. 65, provides that "it shall not be competent for any person . . . to take any objection to a patent on the ground that . . . the complete specification is not in conformity with the provisional." It is not therefore an objection which can be taken in any proceedings after the grant of letters patent, and further it cannot be taken by any party as a ground of opposition to the grant of letters patent other than as allowed by the Act, sec. 56 (d). But the Act directs the Commissioner to refer every application and specification to an examiner, and in case of a complete specification lodged after a provisional specification, it is the duty of an examiner to ascertain and report whether the invention described in the complete specification is substantially the same as the invention the nature of which is described in the provisional specification (Act, sec. 40). The Commissioner may then accept the application and specification, or, subject to appeal to a law officer, give directions for its amendment or that the application, instead of dating from the time when it was lodged, shall date from a later date, but not later than the compliance with the directions for amendment (Act, secs. 42 and 43). The provisions of secs. 46 and 47 of the Act are also important: the Commissioner may accept an application and specification on condition, or he may refuse to accept it, but his decision is subject to appeal to a Court of law. Upon acceptance of the application and specification, both are open to public inspection (sec. 50). Disconformity between the provisional and the complete specifications thus becomes, subject to the appeals given by secs. 43 and 47,

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(1) (1892) 1 Ch. 23; 8 R.P.C. 450. (2) (1892) 9 R.P.C. 221, 413.

(3) (1892) 9 R.P.C. 249, at p. 259.

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 1935. It is not of course an arbitrary discretion, but a discretion to be
 { exercised in the same manner as a judicial discretion, according to
 TATE reason and on lines fairly well settled. The scheme of the Act is
 v. that this discretion should be exercised before the acceptance of the
 HASKINS. application and specification; otherwise the right of appeal given
 Starke J. by secs. 43 and 47 would be destroyed, and a perfectly good invention
 disclosed in the complete specification might be invalidated by
 opening that specification to public inspection pursuant to sec. 50;
 the power to direct amendments under sec. 42 would be inapplicable,
 and the provisions contained in secs. 71-83 would not aid the
 patentee. But it is said that the Commissioner "in his capacity
 of a public officer administering a prerogative of the Crown" is
 "under the duty of determining whether it is in the public interest
 that . . . the grant of the patent should be refused." "For
 this purpose he is entitled to avail himself of any information which
 may be before him . . . and he may also consider matters not
 raised by the notice of opposition." "Disconformity between the
 provisional and complete specifications will be considered . . .
 so long as it is clear upon the face of the documents, or admitted,
 or some blunder has been made." (See *Terrell on Patents*, 8th ed.
 (1934), pp. 203, 204, and cases *ibid.*; *Comptroller-General's Ruling A*
 (1).) Mandamus would, I suppose, lie to compel the performance
 of this duty according to law. But the Courts could not control
 the exercise of such a power within the limits of the Commissioner's
 discretion. So we are brought back to the question: When does
 the *Patents Act* 1903-1933 require that the Commissioner should
 exercise his discretionary power of refusing to accept a complete
 specification on the ground of disconformity?

Every provision of the Act, as already indicated, contemplates
 that it should be exercised before acceptance of the complete
 specification, and justice and convenience point in the same direction.
 The English practice cannot, I think, be questioned in cases involving
 the validity of a patent: it is a desirable and even valuable practice
 in the interests of the public. But the provisions of the English
Patents and Designs Act are not quite the same as the provisions of the

Australian *Patents Act*. Disconformity, within limits, is still a ground of invalidity under the English *Patents and Designs Act* 1907-1932 (see secs. 6, 25 (2) (l), and 42), whereas in Australia the provisions of sec. 65 preclude any such objection to a patent. The case before us almost demonstrates the necessity of the view that the Commissioner should determine the question of disconformity before he accepts a complete specification. The Acting Commissioner accepted the specification in 1932, without any suggestion of disconformity; he allowed an amendment in 1933, again without any suggestion of disconformity, and it was only after hearing the opponent, who had no right to object on the ground of disconformity, that the question was raised. In my opinion, it was then too late for the Acting Commissioner to consider the question in relation to the specification as so amended; he already had or ought to have exercised his discretion.

The case should, therefore, go back to the Acting Commissioner, but this will not preclude him from considering the objections raised by the opposition, and also the question of the indefiniteness and ambiguity of the complete specification.

Appeal allowed with costs. Matter remitted to the Commissioner. Respondent to pay the Commissioner's taxed costs of his appearance at the hearing of the appeal.

Solicitors for the appellant, *Weaver & Allworth*.
Solicitor for the respondent, *T. J. Purcell*.
Solicitor for the Commissioner of Patents, *W. H. Sharwood*,
Crown Solicitor for the Commonwealth.

J. B.

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