[HIGH COURT OF AUSTRALIA.]

PEACOCK . . . . . APPELLANT;
PLAINTIFF,

AND

D. M. OSBORNE & CO. AND ANOTHER . RESPONDENTS.
DEFENDANTS,

ON APPEAL FROM THE SUPREME COURT OF VICTORIA.

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MELBOURNE, *March* 18, 19, 20, 21, 22, 25, 27.

Griffith C.J., Barton, O'Connor and Higgins JJ.

Patent — Infringement — Validity of patent — Combination — Prior publication — Patents Act 1890 (*Vict.*), (*No.* 1123), *sec.* 56.

Where a patent is sought for a combination of several parts, it is not necessary in the specification to distinguish between those parts which are old and those which are new.

Sec. 56 of the *Patents Act* 1890 operates to protect a patent the specification of which contains several claims, one of which is identical with one of several claims in a specification for a prior patent granted out of Victoria, and is not limited to cases where there is absolute identity between the invention sought to be patented in Victoria and that in respect of which a patent has been granted out of Victoria.

A patent was granted in Victoria for rotary disc ploughs, and the specification contained several claims, each of them being for a combination. In an action by the patentee for an infringement:

Held, on the evidence, that each of the claims was new, was good subject-matter for a patent, and was useful, and that the patent was valid.

Decision of the Supreme Court: *Peacock* v. *D. M. Osborne & Co.*, (1906) V.L.R., 375; 27 A.L.T., 207, reversed.

APPEAL from the Supreme Court of Victoria.

Walter Chamberlain Peacock, who was the legal and beneficial owner of letters patent, dated 31st August 1896, and numbered 13,446 of Victoria, for rotary disc ploughs, brought an action

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for infringement of his patent against D. M. Osborne & Company and the International Harvester Company of America. By their defence the defendants alleged that the invention was not new, was not useful, and was not the proper subject-matter for a patent. As particulars of the allegation that the invention was not new, the defendants said that the invention was published in Victoria prior to the date of the plaintiff's letters patent by the publication within Victoria of certain specifications or notes with drawings, which were set out.

The specifications of the plaintiff's patent, which was granted to George Spalding and John Steele Robbins, stated that "this invention relates to improvements in ploughs and more particularly to rotary disc ploughs." After stating in detail, with the aid of drawings, the nature of the invention, and in what manner it was to be performed, the following claims were set out:—

"1. In a rotary plough a triangular shaped frame, the one side being set at an angle to the line of draught and provided with flanges extending lengthwise the said side, in combination with brackets for the cutting discs adapted to be attached to the said side between the said flanges substantially as described.

"2. In a rotary plough, the combination with a frame having two sides, the one extended parallel to the line of draught and the other at an angle thereto, each side having a flange set out from the face thereof, a land wheel mounted on the side parallel with the line of draught in a bracket, and brackets for cutting discs mounted on the side at an angle to the line of draught and engaging the said flange, substantially as described.

"3. In a rotary plough, the combination with a frame having two sides, the one extended parallel to the line of draught and the other at an angle thereto, of two carrying wheels the one mounted stationarily on one of the said sides of the frame and the other adapted to be adjusted lengthwise of the other side of the frame substantially as described.

"4. In a rotary plough, the combination with a frame having two sides, the one extended in the line of draught and the other at an angle thereto, of rotary cutting discs mounted on the latter of the said sides and adapted to be adjusted laterally thereon, a furrow wheel mounted on the side of the frame carrying the

disc, and a land wheel mounted on the opposite side of the frame and adapted to be adjusted forward and back to form the pivot on which the plough will turn substantially as described.

"5. In a rotary plough, the combination of a frame carrying rotary cutting discs, set at an angle to the line of draught, with a guide wheel mounted on an arm extended to the rear of the frame and pivotally mounted therein, and a flexible connection between the frame and arm to control the limit of the swing of the said arm in one direction substantially as described.

"7. In a rotary plough, the combination with a furrow or land wheel, of supplemental filling weights adapted to fit within the hollow of the said wheel, and fastenings to hold the said weights in position, substantially as described."

One of the specified prior publications was by drawings and notes of an invention of George Spalding and John Steele Robbins, of the United States, relating to rotary disc ploughs dated 7th July 1896, and published in Victoria on or about 21st August 1896. That referred to a patent granted to Spalding & Robbins in the United States, the specifications of which contained three claims, one of which was as follows:—"In a rotary disc plough the combination of a traction wheel the face of which is recessed, with supplemental weights adapted to fit in said recessed face, and suitable fastenings for maintaining the said weights in place, substantially as described."

The action was heard before *à Beckett* J., who found, as to claims 1, 2 and 5, that the mode of attaching the brackets for the cutting discs, and the flexible connection were not proper subject-matters for a patent, and that the other parts of these claims were not new; and, as to claim 7, that there had been prior publication, but that sec. 56 of the *Patents Act* 1890 protected the plaintiff. He therefore gave judgment for the defendants: *Peacock* v. *D. M. Osborne & Co.* (1).

The plaintiff now appealed to the High Court.

Coldham and *Mann*, for the appellant. The only question here is whether the Judge below was right in finding that there was no subject-matter for a patent. That is a question of fact. An

(1) (1906) V.L.R., 375; 27 A.L.T., 207.

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invention which consists of old elements and which performs an old operation in a better way, is patentable: *Edison-Bell Phonograph Corporation Ltd.* v. *Smith* (1); *Anti-Vibration Incandescent Lighting Co. Ltd.* v. *Crossley* (2); *Arnot* v. *Dunlop Pneumatic Tyre Co. Ltd.* (3); *Hayward* v. *Hamilton* (4). The question is whether the inventive faculty has been exercised in putting the things together.

They also referred to *Willmann* v. *Petersen* (5); *Penn* v. *Bibby* (6); *Perry* v. *Societé des Lunetiers* (7); *Patent Exploitation Ltd.* v. *Siemens Brothers & Co. Ltd.* (8).

Mitchell K.C. and *Irvine* K.C., for the respondents. The patent is void because as to each of the claims (1), (2) and (5) it is not a proper subject-matter of a patent, it is not new, and the specification does not sufficiently distinguish between what is new and what is old. As to claim (7) there was a prior paper publication, and it is not useful, and it is not a proper subject-matter of a patent. There has been no exercise of the inventive faculty: *Longbottom* v. *Shaw* (9); *Harwood* v. *Great Northern Railway Co.* (10); *Kynoch & Co. Ltd.* v. *Webb* (11); *Clark* v. *Adie* (12); *Murray* v. *Clayton* (13); *Frost on Patents*, 3rd ed., p. 73; *Horton* v. *Mabon* (14). The substitution for a well known element in a well known combination of a well known mechanical equivalent does not give a patentable thing. The flexible connection in claim (5) is obviously a mechanical equivalent for the fixed stop. See also *Moore* v. *Bennett* (15); *Leggott* v. *McGeoch* (16). As to the prior publication, sec. 56 of the *Patents Act* 1890 is not an answer. In order to claim the protection of that section the inventions must be substantially identical. The section does not extend to protect a Victorian patent, one claim in which is identical with a claim in a previous foreign patent: *Frost on Patents*, 3rd ed., vol. II., pp. 22, 23; *L'Oiseau and Pierrard's Patent* (17); *Siddell* v. *Vickers* (18); *Patents Act* 1890, secs. 54, 55.

(1) 11 R.P.C., 389
(2) 22 R.P.C., 441.
(3) 22 R.P.C., 105, at p. 108.
(4) Griffin's Pat. Cas., 115.
(5) 2 C.L.R., 1.
(6) L.R. 2 Ch., 127.
(7) 13 R.P.C., 664.
(8) 21 R.P.C., 541.
(9) 8 R.P.C., 333, at p. 335.
(10) 11 H.L.C., 654, at p. 680.
(11) 17 R.P.C., 100, at p. 110.
(12) 2 App. Cas., 315, at p. 320.
(13) L.R. 7 Ch., 570.
(14) 12 C.B.N.S., 437.
(15) 1 R.P.C., 129, at p. 143.
(16) 10 R.P.C., 429.
(17) Griffin's Ab. Pat. Cas., 36.
(18) 39 Ch. D., 92.

Coldham, in reply, referred to *Von Heyden* v. *Neustadt* (1); *Terrell on Patents*, pp. 102, 498; *Harrison* v. *Anderston Foundry Co.* (2); *Moser* v. *Marsden* (3).

Cur. adv. vult.

GRIFFITH C.J. This is an action for infringement of a patent for a rotary disc plough. The defendants pleaded, amongst other defences, that the invention was not useful, that it was not new, and that it was not proper subject-matter for a patent, and they also alleged prior publication. The infringement by the defendants was not in controversy before us, but the learned Judge before whom the case was tried was satisfied that the defendants had infringed the plaintiff's patent, if it was valid. The learned Judge, however, was of opinion that the plaintiff's patent was invalid for certain reasons. The patentee's claim was in respect of several distinct matters, reduced by disclaimer to six, of which four have been called in question on this appeal. It is admitted that, if any one of these claims is bad, either on the ground of want of novelty, or want of subject-matter, or want of utility, the action would fail. It is necessary, therefore, to consider each of them separately, and the objections to them differ. The invention relates "to improvements in rotary disc ploughs." The principle of a rotary disc plough is using for turning up the earth, in place of the ordinary plough-share, a heavy concave circular disc, with sharp edges, revolving on an axle, and set on a frame at an angle to the line of draught. The plane of the disc itself is also at an angle to the line of draught, and also at an angle to the perpendicular, the object being that, as the structure is drawn along over the ground, the weight of the disc may bite into the earth, and throw the earth upward and outward. That being the nature of the structure, it is obvious that it cannot be taken in any desired direction in a straight line without very powerful guiding apparatus, because the tendency of the discs striking the ground in that way would naturally be to cause the whole machine to go in the same direction as the plane of the discs. It is obvious also that, when the guiding apparatus is introduced,

(1) 50 L.J. Ch., 126, at p. 128. (2) 1 App. Cas., 574.
(3) 10 R.P.C., 350, at pp. 353, 359.

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there will be a very severe strain upon the connecting parts; there will be a strain coming from various directions upon the discs, a torsional strain, a strain tending to force them aside, and a strain tending to force them upwards, and it is obvious that the mode of attachment, in order to keep the implement rigid must be very carefully devised. Again, in the construction of a plough of that sort it is desirable to have it as light as possible, consistently with strength, and the importance of finding the best way to combine the elements of lightness, strength, and convenience in use is obvious. Again, it is necessary, bearing in mind the importance of the qualities of strength and lightness, to have the machine sufficiently heavy to compel the cutting edges of the disc to bite the ground, and not, as they naturally otherwise would do, run over it. All these things have to be considered in making the plough. I do not suggest that the first person who built rotary disc ploughs thought of all these things. They were not known at first, but have been discovered in the course of time, although it may be conceded that, *à priori*, these were elements to be considered. That being the nature of the invention, the plaintiff in his patent describes the rotary disc plough, and he specifies the particular claims that he makes. It will be convenient to read the claims. The first claim is—[His Honor read the first claim, and continued:] That is a claim for a combination of a triangular-shaped frame of a particular construction, having flanges extending lengthwise along one side with brackets for the discs attached between the flanges. That is that combination. The second claim is—[His Honor read the second claim, and continued:] This is a combination of three elements, a particular kind of frame, a land wheel parallel to the line of draught, and brackets attached in a particular manner. The fifth claim is a combination again of three elements. [His Honor read the fifth claim, and continued:] The seventh claim, which is the claim in respect of which the infringement was proved, is as follows:—[His Honor read the seventh claim, and continued.] It will be observed that all these claims are for combinations. Each of the claims was attacked on grounds stated briefly by Mr. Mitchell thus:—Claims 1, 2 and 5, because they are not subject-matter for a patent and are not new; and, further,

because the specification does not distinguish the new from the old in the combination. The seventh claim is objected to on the ground of want of utility, want of subject-matter, and also on the ground of prior publication, that is, paper publication.

With respect to the objection that the specification does not distinguish the new from the old in the combination, I refer to the case of *Harrison* v. *Anderston Foundry Co.* (1), in which the law on that subject is distinctly laid down. Lord *Cairns* L.C., referring to the first claim on which the question of construction arose, said :—"It is, as I read it, a claim for a combination ; that is to say, a combination of all the movements going to make up the whole of the mechanism described. It must, for the present at least, be assumed that this combination, as a combination, is novel ; that it is, to use the words of the Lord President, a new combination of old parts to produce a new result, or to produce a known result in a more useful and beneficial way. It is not doubted that a combination of which this may be said is the subject of a patent." Then he referred to the case of *Foxwell* v. *Bostock* (2), in which it was suggested that Lord *Westbury* L.C. had determined that, where there is a patent for a combination, there must be an explanation of the novelty, and the specification must show what is the novelty, and what is the merit of the invention. But Lord *Cairns* went on to say :—"I cannot think that, as applied to a patent for a combination, this is, or was meant to be the effect of the decision in *Foxwell* v. *Bostock* (2). If there is a patent for a combination, the combination itself is, *ex necessitate*, the novelty; and the combination is also the merit, if it be a merit, which remains to be proved by evidence. So also with regard to the discrimination between what is new and what is old. If it is clear that the claim is for a combination, and nothing but a combination, there is no infringement unless the whole combination is used, and it is in that way immaterial whether any or which of the parts are new. If, indeed, it were left open on the specification to the patentee to claim, not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such

(1) 1 App. Cas., 574, at p. 577. (2) 4 De G. J. & S., 298.

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subordinate and subsidiary parts are new and material, as it was held a patentee might do in *Lister* v. *Leather* (1), then it might be necessary to see that the patentee had carefully distinguished those subordinate and subsidiary parts, and had not left *in dubio* what claim to parts, in addition to the claim for combination, he meant to assert." In the same case Lord *Hatherley* said (2), after referring to the case of *Foxwell* v. *Bostock* (3), speaking of a man who had invented a new kind of clock:—" But if he says : 'I take all these well-known parts, and I adjust them in a manner totally different from that in which they have ever before been adjusted ; I have found out just what it is that has made these parts, though they may have been used in machinery, fail to produce their proper effect, and it is this, that they have not been properly arranged ; I have therefore reconsidered the whole matter, and put all these several parts together in a mode in which they never were before arranged, and have produced an improved effect by so doing,'—I apprehend it is competent to that man so to do, and that it would be perfectly impossible for him to say what is new and what is old, because *ex concessis* it is all old, nobody ever before used it in the manner in which he has used it. That, my Lords, I apprehend, is the principle of a patent for a combination. It seems to me that that is just what this gentlemen claims to have done. Whether or not he has really done it will remain to be seen." That disposes of the objection that the specification does not sufficiently distinguish between what is new and what is old. The idea of a combination is that it is all old, and if some of it is new, that cannot make it any worse.

As to the objection that these claims are not the proper subject-matter for a patent, I will only refer to the rule this Court laid down in *Willmann* v. *Petersen* (4). In delivering the judgment of my learned brother *Barton* and myself, I said :—" These cases in our opinion establish the following proposition (which when enunciated from the bench during the argument, was assented to by counsel on both sides)—A combination of two or more known mechanical appliances the result of which is to effect a new

(1) 8 El. & Bl., 1004.
(2) 1 App. Cas., 574, at p. 584.
(3) 4 De G. J. & S., 298.
(4) 2 C.L.R., 1, at p. 21.

purpose, or to effect an old purpose with greater efficiency or economy, may be the subject-matter of a patent, if it involves some substantial exercise of the inventive faculty."

Bearing those rules in mind, let us examine the nature of these claims. I will take them in numerical order. The first claim is for a combination, as I have said, of a triangular-shaped frame of a particular construction, with brackets fastened on in a particular manner. The frame as described in the specification and the drawings consists of what is called the disc beam, that is, the side beam which carries the discs of iron, which is made either of what is called " H " iron or " C " iron (which is like double angle iron, that is, iron with one side perpendicular, called the " web," and the other two sides extending along horizontally at top and bottom), and the method of fastening the discs to the beam described in the specification is by fixing a bracket containing the axle on which the disc runs in between these two flanges, securing in that way a perfectly rigid connection. It is impossible that there could be any upward thrust around the bolts ; or rather it is impossible that the bracket can revolve on the bolt by which it is affixed to the beam, because it is squared top and bottom, and brought into contact with the flanges above and below, so that this strain is effectually resisted. Another way, and in fact the only other way in which it is suggested that these brackets had been fixed to the beam before, would be by fastening them on to the top of a beam of "T" iron by bolts or screws. In that case, obviously, there would be a great shearing strain, which might tend to cut through those bolts, and disable the implement. It is suggested, however, that, although this mode necessarily produces the strongest possible way of fixing the brackets to the frame so as to avoid the various thrusts and tensions, it was not new, and the reason given is that in Victoria, some years before, a Mr. Furphy had invented an implement which carried rotary discs, really in the nature of a harrow. The discs were all fastened one after another on a long pole. The mode of fastening was on the top of a beam in the shape of what is called " T " iron. The difference between this mode of fixing and the other mode of fixing is obvious, as I pointed out. But it is said, that being so, there is nothing novel in it ; there is no

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inventive genius in that, because everybody knew that if you wanted to fix a square-ended thing in what is called "H" iron, or "C" iron, the obvious thing was to put the square end into it. True, everybody knew that, but it does not appear to have occurred to anybody to make use of that idea for the purpose of forming a light and strong frame for a rotary disc plough, and the use of such a thing in a building or in a floor is not so obviously a use analogous to its use in an agricultural implement that it can be said that there is no exercise of inventive faculty in so applying the idea. I think, therefore, that the objection to the first claim, that it is not the proper subject-matter of a patent, and is not new, fails, and there is no evidence that it has been anticipated. Of its utility there can be no doubt—at least no reasons are suggested on the evidence. I think every objection to that claim fails.

In the next claim there are three elements. The first is a frame of two sides, one parallel to the line of draught and the other at an angle, each side having a flange set out from its face. The second element is a land wheel mounted on the side parallel with the line of draught in a bracket, and the third consists of brackets fixed substantially in the same way as in the first claim. It is claimed for this combination that, although there is only one flange to the beam, so that the rigidity of connection is not quite so great as if there were a flange both above and below, nevertheless the advantage is considerable, because the revolution of the bracket on the axis formed by the bolt is prevented to a great extent, though perhaps not quite so great an extent. The second element of a land wheel attached to the side parallel with the line of draught in a bracket, was, so far as we know, a novel idea. The third element of the beam extended at an angle to the line of draught may be taken to be not new. But it is not suggested that the whole combination is not new, and, for the same reasons that lead me to hold that the first claim is good, I think that there is novelty and utility in the subject-matter of this claim. The mounting of the land wheel on the side parallel to the line of draught in a bracket may or may not produce great advantages. On previous implements the land wheel had been set at the extremity of an axle, at a considerable distance from

the frame itself. The fixing of the frame by a bracket was a novelty, and the utility of the invention the subject-matter of this claim was not seriously impugned. It is suggested, however, that it has been anticipated by a drawing and a claim in respect of an American patent published and obtainable in the Patents Office Library at Melbourne. But that did not indicate any way in which the brackets were to be fixed, nor did it indicate a land wheel fixed to the land beam, so that the objection based on that alleged anticipation fails; and, for the reasons I have given in respect of the first claim, I think the other objections fail also.

The fifth claim, which was attacked perhaps more seriously, was for a combination consisting of, first, the frame carrying rotary discs set at an angle to the line of draught; secondly, a guide wheel mounted on a movable arm extended to the rear of the frame, and swinging on a pivot; and thirdly, a flexible connection between the frame and arm to control the limit of the swing of the arm. As I said before, in a structure of this sort, the tendency of the whole machine would be to travel in a direction parallel to the plane of the cutting discs, and this tendency must be controlled by some guiding apparatus. The mode adopted for guiding is what the inventor calls a "guide wheel," which is applied so as to run in the furrow nearest to the land wheel, and to press against it, so that, just as a tram rail in the street, if it is raised above the ground, will afford considerable resistance to a vehicle trying to cross it obliquely, so there will be a continual pressure exerted on the guide wheel which tends to keep the whole machine from swerving. It is obvious that a wheel of that sort would have a very great strain upon it. It must be attached at the rear of the vehicle, and in order to get the necessary leverage, means must be adopted to prevent it from swinging too far, and a mode of attaching it so as to get the necessary strength, at the same time avoiding undue weight and unwieldiness, was a matter which seems to have attracted some attention. This particular combination was impeached on the ground both of anticipation and want of subject-matter. So far as the anticipation was concerned, it appears that, before this patent was taken out, descriptions, called "paper anticipations,"

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and plans of two inventions had been published in Victoria, from which it appeared that such a guide wheel had been previously used, but the mode adopted for securing strength and leverage was quite different. A guiding wheel of this sort must extend to the rear of the machine, like the rudder of a ship, and if no other precaution was taken, the strain would come upon the pintle or pivot. In both of those inventions, the strain was cast entirely on the upright rod or shaft to which the wheel is attached, which I may call the pintle. In one case the means for preventing the arm from swinging too far consisted of a projecting pin upon which the arm would press; but that pin was close to the axis on which the arm was working, so that the whole leverage of the length of the arm at the end of which the wheel was attached, came upon the pin, and either the pin might break or the arm itself might bend or break. That apparatus was self-acting. The other invention represented a very similar contrivance, which could be worked from the front of the plough by the use of a long lever, by which a stop could be affixed, so that the wheel could at will be allowed to swing freely, or prevented from swinging; but this was open to the same objection that the leverage of the whole length of the arm came upon the stop, with great danger of fracturing the arm. There was also the inconvenience of working it from the other end of the plough. Neither of these was the same thing as the present invention; they were both open to these obvious objections. The plaintiff's invention used a chain, which is called the "flexible connection," attached to the wheel at one end and the frame at the other, which prevents all the danger arising from the leverage of the length of the arm to which the wheel is attached, tending to break the arm. In consequence the appliance might be made much lighter, and at the same time a great deal stronger. The advantage of the avoidance of accidents in the field in implements of this sort is extremely great. If in either of the earlier inventions the arm or the stop were broken, the whole machine would be disabled, and the probability of fracture was not small. On the other hand the chain entirely avoids this risk, and, in addition, the implement can be made much lighter, and more easily managed. It is said there is no invention in sub-

stituting a chain for a rod. That is true, if that be all. If the only object is to prevent a thing from swinging in one direction beyond a given distance, it does not matter whether you have a chain or a rod ; but in this case the object was to attach a wheel of that kind to an implement of that kind by the lightest and most efficient means with least danger of fracture. The application of a chain for that purpose involved also the construction of the implement in such a form that a chain could be attached to it. That, also, was a matter requiring some consideration. The applicant applied his mind to these subjects, and it is quite impossible, applying the rules which I have stated, to say that no inventive faculty was involved in doing it. I think, therefore, the objection to that claim fails.

The objection to the seventh claim, which is for the combination with a furrow or land wheel of supplemental filling weights, is based on a somewhat different ground. The idea of the invention is that the wheels, the land wheel which runs on the unploughed land, and the wheel on the other side of the implement furthest away from it, should be so constructed that weights can be affixed to the wheels themselves. The principle of weighting a plough in order to give it a greater grip of the land was well known, for stones and all sorts of things were used as weights, and placed on various parts of the implement. It is said there are several advantages in having the wheels themselves weighted. In the first place, it is said, you need not have the weights on at all unless you like. That would apply also to movable weights. Next it was said that the idea is not merely to have removable weights—there is nothing new in that—but to have them affixed in particular parts of the plough where they can produce the greatest benefit. So far as the weights are affixed to the land wheel, of course, it is obvious that, by reason of the greater leverage, the weights would have more effect in keeping down the discs, provided the construction is rigid, than if you put them at any other places—much more than if you put the weights on the beam. Again, there might be advantages in having them fixed, instead of having them in a place where they might fall off. Again, it is said that, for the purpose of ordinary traction, when you are taking the implement to and from its

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work, the distribution of weight on the wheels themselves is an advantage, and that must be so to a slight extent. The learned Judge who tried the case thinks it is not so to a very great extent, but it was pointed out that, in a case of that sort, where an implement is running on the ground, the actual weight of wheel pressing on the top of the axle is only half the weight of the wheels, and the same consequence follows if the additional weight is affixed to the wheels, whereas, if the whole of the weight were on the frame it would be above the axle, and a slightly greater tractional power would be needed. The learned Judge thinks there is not much in that, but, on the whole, he comes to the conclusion that the application of weights in this way was an advantage. One of the matters to which he attached very great importance was that the defendants themselves thought it was an advantage, because they had adopted it. On the whole, he came to the conclusion that this was a useful invention, and was an invention capable of being patented. I see no reason to disagree with him.

That disposes of all objections to the patent except one, and that is that claim 7 had been previously published. Now, it is admitted that it had been previously published in Victoria, and on that ground the patent must fail, notwithstanding all its merits, unless the plaintiff can claim the benefit of sec. 56 of the *Patents Act* 1890, which provides that—"(1) Notwithstanding anything in any Act of Parliament contained, where any patent or like privilege for the monopoly or exclusive use or exercise in any parts of Victoria of any invention first invented in parts out of Victoria has been obtained, a patent may be granted for such invention at any time within one year from the date of the granting of the first of any such patents or privileges notwithstanding that such invention has been used or published in Victoria within such period of one year, and such patent when granted shall have the same force and effect as if such prior publication or use had not taken place." Now, the facts are that about a fortnight before the granting of the patent, a brief description had been published of a patent, also belonging to the plaintiff, granted in America. Sub-sec. (2) provides:—"(2) If such use or publication have been made in Victoria with the consent of the true and first inventor for the time being such inventor shall

not be entitled to a grant of letters patent under the authority of this section." This publication was not made with the consent of the plaintiff, who was the true and first inventor, so that the plaintiff does not come within sub-sec. (2). The American patent contained three claims, one of which was for the weighted wheels. The Victorian patent contained at that time more than seven claims, one of which was for the weighted wheels, and it is said that the inventions are not identical, and therefore that the section does not apply. The object of the section evidently was to prevent a *bonâ fide* inventor from losing the benefit of an invention patentable in Victoria because somebody else, without his consent, had disclosed it to the public. Now, it is not disputed in the present case that, if the plaintiff's patent had been limited to the seventh claim, it would have been a good patent so far as subject-matter goes, apart from the objection of want of novelty. Supposing, then, the patent had only been for what is included in the seventh claim, would that have been vitiated by the fact that an American invention of that and something else had been granted during the year? Surely the object is to protect the invention, so far as it is new in Victoria, where it is new. The words of the section are:—"A patent may be granted for such invention," that is, an invention first invented in parts out of Victoria, and new in Victoria. The invention of these weights adjusted to the machine was an invention first invented beyond Victoria, and the Act says that the grant of a patent for such invention shall be valid, notwithstanding that such invention has been published in Victoria within the period of one year. In the very words of the section, the invention in question, the weighted wheels, had been invented abroad. It had been published in Victoria within one year, without the consent of the patentee, and that publication is declared to be irrelevant. It seems to me that the case falls within the exact terms of the section, and that the plaintiff is entitled to the benefit of it; otherwise, the singular consequence would happen that, in the case of an agricultural implement invented and patented in Victoria, and patented, say, in Canada, with improvements, and with a separate claim for the improvements, if the patentee desired to obtain a patent for the improvements in Australia, he could not do so, because the original

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machine was not novel. It would be a very singular thing, that merely because the state of knowledge in the two countries was different as to a particular part of the invention, this section should not apply with respect to those parts of the invention which were novel in both countries. I think, therefore, that the objection last referred to fails. I entirely agree with the learned Judge on this subject, and it follows that all the objections fail, and the plaintiff is entitled to judgment.

BARTON J. I entirely agree with His Honor in the conclusion at which he has arrived. It is not necessary for me to traverse the whole of the ground, and I will confine myself, first, to expressing my agreement with him in the construction of the section in the *Patents Act* 1890, and secondly, to mentioning one or two authorities which support me in my agreement. With respect to the question of subject-matter, the case of *Murray* v. *Clayton* (1) is useful. In that case the patent had been granted for a machine which had been shown to work more expeditiously, more economically, and produced a better result than any known machine of the same sort would do. *Bacon* V.C., had held that a patent was invalidated because the machine was formed by the mere arrangement of common elementary mechanical materials, producing results of the same nature as those previously accomplished by other mechanical arrangements and construction. It may be mentioned that the appliance was an improvement in machinery for making bricks, relating more particularly to the mechanical appliances for cutting the clay into bricks of the desired shape and dimensions. *Bacon* V.C., held that the patent was bad for want of subject-matter. The case went to the Court of Appeal in Chancery before *James* and *Mellish* L.JJ. *James* L.J., delivered the judgment, in which *Mellish* L.J., concurred. In the course of his judgment he said (2):—"Before proceeding to consider the last question, that of infringement, it is necessary to refer to the Vice-Chancellor's judgment. His Honor, after referring to the evidence of the witnesses who spoke of the plaintiff's machine in terms of unqualified commendation, and said that, according to their knowledge, it was a novelty and an

(1) L.R. 7 Ch., 570. (2) L.R. 7 Ch., 570, at p. 583.

improvement upon all brick-making machines with which they were acquainted, says: 'But, assuming all this to be true, I do not think that it can therefore be held that the plaintiff is entitled to the monopoly which the patent purports to grant. No doubt a combination of things, not in themselves new, but which combination is perfectly new in the form in which the inventor has cast it, and producing new and more beneficial results, may be the subject of a patent; but I am aware of no case in which it has been held that the mere arrangement of common elementary mechanical materials, and the construction, by means of such arrangement, of a machine which produces no other result than that which had been previously accomplished by other mechanical arrangements and construction, would support a patent. If it were so, there would be no protection to the public or to earlier patents against the ingenuity of any artisan who might have the skill to arrange the old mechanism in a new shape, and thereby to appropriate to himself the fruits of previous inventors, in the proper sense of that term, and so that the privilege and reward which the law only concedes to art, and wit, and invention, might be bestowed upon mere skill in handicraft.' I find it very difficult to reconcile this proposition with what has been said by many Judges in many cases, and more particularly in the case of *Crane* v. *Price* (1). Now, no doubt, *Crane* v. *Price* has been questioned, and if I may be permitted to say so, with all respect to the very powerful tribunal which decided that case, I have never been satisfied with the decision. That, however, was simply because I could not see how the word 'combination' could be properly applied to the introduction of a particular kind of fuel into a machine which had been patented for the use of every kind of fuel in the making of iron; and neither I nor, so far as I am aware, any other Judge has ever questioned the principles upon which that case was decided, and which are thus laid down in the judgment of the Court delivered by Chief Justice *Tindall* (2):— 'We are of opinion that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public, than that produced before by the old method, that such combination is an invention or manufacture intended

(1) 1 Webs. Pat. Cas., 393.

(2) 1 Webs. Pat. Cas., 393, at p. 409.

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by the Statute, and may well become the subject of a patent. Such an assumed state of facts falls clearly within the principle exemplified by *Abbott* C.J., where he is determining what is or what is not the subject of a patent, namely, it may, perhaps, extend to a new process to be carried on by known implements or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better or more useful kind. And it falls also within the doctrine laid down by Lord *Eldon*, that there may be a valid patent for a new combination of materials previously in use for the same purpose, or even for a new method of applying such materials. But the specification must clearly express that it is in respect of such new combination or application.' " That is as to subject-matter. As to the question of insufficiency of the specification, as not having properly distinguished the new from the old, I think the matter comes within the principle laid down in the case of *Moore* v. *Bennett* (1). That was a case in which the patentee of improvements in machines for cutting and trimming the hairs or bristles of brushes sued the defendant for using a machine which the plaintiff alleged was an infringement of his patent. The defences were that the plaintiff's patent was invalid because his specification was insufficient, that there was no infringement, and that there had been prior user. Judgment went for the plaintiff, and the defendant appealed. The Court of Appeal reversed that judgment and dismissed the action, with costs, on the grounds that the specification was insufficient in not pointing out what was novel in the combination constituting the plaintiff's patent, and that the defendant's machine was not an infringement. The plaintiff then appealed to the House of Lords, and it was held that the specification was sufficient, because, where the claim is for a new combination only, and not also for subordinate elements included in that combination, then, if the combination and the mode of working it are properly described, it is not necessary to specify which of the subordinate elements are new. In giving judgment to that effect, Lord *Herschell* L.C. said (2):—" But your Lordships will decide, consistently with what, I think, is the general rule in

(1) 1 R.P.C., 129.

(2) 1 R.P.C., 129, at p. 143.

these cases, by holding that where the claim is for a combination, and not for particular subordinate things included in that combination, if the combination is a new one in substance and in truth, and if the manner of arriving at it and working it, and the purpose for which it is useful, are all properly, sufficiently, and correctly described in the specification, so that any one acquainted with the subject will know in what respect it differs from the things which have gone before, then it would be contrary to the whole policy which allows such combinations, though no part of them is new, to be the subject of a patent, to say that, besides describing clearly and sufficiently the manner of doing it, in a way which would show everyone acquainted with the subject what was the novelty in the thing, you are to go on, and though you do not want to claim subordinate parts of the combination as distinct from the entire combination, nevertheless you must specify the subordinate parts of it as constituting new elements and a new thing." I think that case effectually supports the arguments of the appellant on this point. I am of opinion that the appeal must be allowed.

O'CONNOR J. I agree that the appeal must be allowed, and judgment entered for plaintiff for the reasons so fully elaborated by our brother the Chief Justice, to which I have nothing to add.

HIGGINS J. I am of the same opinion. The arguments before us have been principally addressed to the sufficiency of claims 1, 2 and 5 as the subject-matter of a patent. It is said that these do not show a sufficient display of the inventive faculty when we regard the rotary disc ploughs already used or published. It is assumed rightly or wrongly, even by the plaintiff, and, for the present purpose, I shall assume also, that whatever amounts to prior paper publication may be treated as a sufficient datum line from which to measure the extent of the inventive skill involved in a new invention. The question becomes a mere question of fact—a question as to degree in inventiveness—a question as to which experts of the highest standing differ, and we have to come to the best conclusion we can. The principles of law are perfectly clear and are fully recognized by the learned Judge as his major

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premiss. But, in my opinion, he has regarded too much the separate parts of the combination and their separate insignificance, instead of recognizing the collective effect and effectiveness of the combination.

As for sec. 56 of the *Patents Act* 1890, I agree with the judgment of the learned Judge. If the construction pressed upon us by counsel for the defendants be adopted, then, if a patent be taken out in the United States for three claims, and a copy of those claims be lodged in the Victorian Patents Office, there can be no protection for the patentee in Victoria if he limit his claim to one of the three. I think that, having regard to the definition of "invention" in sec. 3, and to the obvious object of the section, we are at liberty to disregard a construction which leads to such an absurdity.

Appeal allowed with costs. Judgment for plaintiff with costs except so far as they are increased by the first further particular of breach. Plaintiff to pay defendants' costs occasioned by that particular. Certify that validity of patent was in question, and that particulars delivered by plaintiff were reasonable. Cause remitted to Supreme Court for inquiry as to damages.

Solicitors, for appellant, *Waters & Crespin*, Melbourne.
Solicitors, for respondents, *Blake & Riggall*, Melbourne.

B. L.